

# FEE TRANSMITTAL



Total Amount of Payment \$160.00

Complete if Known

Application No. 09/519,889  
 Filing Date March 6, 2000  
 First Named Inventor Rhonda S. Reisman  
 Group Art Unit 3765  
 Examiner Name Amy Falik  
 Atty. Docket Number R597.12-0003

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OCT 17 2001  
TECHNOLOGY CENTER R3700

## METHOD OF PAYMENT (Check One)

1. ☒ The Commissioner is hereby authorized to charge any additional fee required under 37 C.F.R. 1.16 and 1.17 and credit any over payments to Deposit Account No.11-0982. Deposit Account Name: Kinney & Lange, P.A.

2. ☒ Check Enclosed

## FEE CALCULATION

### 1. BASIC FILING FEE

Large Entity Fee Code	Large Entity Fee (\$)	Small Entity Fee Code	Small Entity Fee (\$)	Fee Description
101	740	201	370	[ ] Utility Filing Fee
106	330	206	165	[ ] Design Filing Fee
108	740	208	370	[ ] Reissue Filing Fee
114	160	214	80	[ ] Prov. Filing Fee

Subtotal (1) \$-0-

### 2. EXTRA CLAIM FEES

	Number Claims	Prior	Extra	Fee from Below	Fee Paid
Total	-	=	X	=	-
Indep.	-	=	X	=	-
Multiple Dependent Claims				=	-

Insert 3 and 20, or number previously paid if greater; Reissue see below

Large Entity Fee Code	Large Entity Fee (\$)	Small Entity Fee Code	Small Entity Fee (\$)	Description
103	18	203	9	Claims in excess of 20
102	84	202	42	Independent claims in excess of 3
104	280	204	140	Multiple Dependent Claim
109	84	209	42	Reissue Independent Claims Over Original Patent
110	18	210	9	Reissue claims in excess of 20 and over original patent

Subtotal (2) \$-0-

## FEE CALCULATION (Continued)

### 3. ADDITIONAL FEES

Large Entity Fee Code	Large Entity Fee (\$)	Small Entity Fee Code	Small Entity Fee (\$)	Fee Description	Fee paid
105	130	205	65	Surcharge - Late filing fee or oath	-
127	50	227	25	Surcharge - late provisional filing fee or cover sheet	-
139	130	139	130	Non-English specification	-
147	2,520	147	2,520	For Filing a Request for Reexamination	-
115	110	215	55	Extension for reply within first month	-
116	400	216	200	Extension for reply within second month	-
117	920	217	460	Extension for reply within third month	-
118	1,440	218	720	Extension for reply within fourth month	-
128	1,960	280	980	Extension for reply within fifth month	-
120	320	220	160	Filing a brief in support of an appeal	160
121	280	221	140	Request for oral hearing	-
148	110	248	55	Terminal Disclaimer Fee	-
140	110	240	55	Petition to revive - unavoidable	-
141	1,280	241	640	Petition to revive - unintentional	-
142	1,310	242	670	Utility/Reissue issue fee (inc. advance copies)	-
143	490	243	260	Design issue fee (inc. advance copies)	-
122	130	122	130	Petitions to the Commissioner	-
123	50	123	50	Petitions related to provisional applications	-
126	180	126	180	Submission of Information Disclosure Statement	-
581	40	581	40	Recording each patent assignment per property (times number of properties)	-
179	740	279	370	Request for Continued Examination (RCE)	-

Other fee (specify) \_\_\_\_\_

Subtotal (3) \$160.00

Signature J. Peter Sawicki  
 Date October 10, 2001

Reg. No. 30,214

Deposit Account No. 11-0982



10/12/01

AFI 3765

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①

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named  
Inventor : Rhonda S. Redman  
Appln. No. : 09/519,889  
Filed : March 6, 2000  
Title : HAND AND FOREARM PROTECTOR  
Docket No. : R597.12-0003

Appeal No.  
  
Group Art Unit: 37  
Examiner: Amy Falik

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OCT 17 2001  
TECHNOLOGY CENTER R3700

**BRIEF FOR APPELLANT**

Assistant Commissioner for Patents  
Washington, D.C. 20231

EXPRESS MAIL NO.:  
EL212538945US

Sir:

This is an appeal from an Office Action dated June 18, 2001, in which claims 1-6 were finally rejected.

**REAL PARTY IN INTEREST**

The real parties in interest is are Rhonda S. Redman and Ricky V. Redman, both of Fridley, Minnesota, who are the owners of the entire right, title and interest in the application.

**RELATED APPEALS AND INTERFERENCES**

There are no known related appeals or interferences involving the subject matter or issues in this appeal, and there are no known related appeals or interferences that will directly affect, be directly affected by, or have a bearing on the Board's decision in this appeal.

**STATUS OF THE CLAIMS**

**I. STATUS OF ALL THE CLAIMS**

- A. Claims canceled: 4. ✓
- B. Claims withdrawn but not canceled: none.
- C. Claims pending: 1-3, 5 and 6.
- D. Claims allowed: None.
- E. Claims rejected: 1-6.

**II. CLAIMS ON APPEAL**

- A. The claims on appeal are: 1(Twice Amended), 2, 3(Amended), 5 and 6. The claims on appeal are included in Appendix A.

### **STATUS OF AMENDMENTS**

A Reissue Application was submitted with new claims 1 through 6 which was entered. A first Amendment was submitted on May 3, 2001 and was entered. In response to a Final Office Action by the Examiner, an Amendment After Final was submitted on June 16, 2001, which will entered upon receipt of a Notice of Appeal and this Appeal Brief.

### **SUMMARY OF INVENTION**

Claim 1(Twice Amended) is an independent claim which defines the present invention as a hand and forearm protector comprising a sleeve for overlaying a forearm and a proximal hand portion of a wearer where a primary opening of the sleeve is at one end. Additionally, a single discrete digit opening is disposed at another end of the sleeve wherein all of the wearer's fingers extend through the discrete digit opening and the sleeve extends to a point adjacent a first set of knuckles of the wearer's fingers leaving the knuckles exposed. The sleeve also includes a discrete thumb opening disposed at the other end of the sleeve. The sleeve also includes a longitudinal opening extending adjacent from a point that overlies a juncture of the carpal bones and the radius and extending rearwardly towards the primary opening to proximately the end of the sleeve. The sleeve of the present invention also includes a zipper for closing the longitudinal opening to conform the sleeve to the forearm of the wearer, where the closure is disposed to overlie a forward side of the forearm.

Claim 2, which depends from independent claim 1(Twice Amended), further defines the protector as including a protective flap that extends between the edges of the opening which protects the wearer from being pinched by the zipper.

Claim 3(Amended), which depends from independent claim 1(Twice Amended), further defines the length of the sleeve as being selected to extend to approximately 1 to 1½ inches from the elbow of the wearer.

Claim 5, which depends from independent claim 1(Twice Amended), further defines the sleeve as extending to a first joint of the thumb, leaving the joint exposed.

Claim 6, which depends from independent claim 1 (Twice Amended), further defines the sleeve as extending to a point adjacent a first knuckle of the fingers and thumb, leaving the knuckles exposed.

#### **DESCRIPTION OF REFERENCES RELIED ON BY THE EXAMINER**

Applicant has overcome all rejections based upon the prior art. Therefore, there is no prior art which is pertinent to the issues on appeal and, as such, none has been described in this section.

#### **ISSUES**

I. Whether claims 1 (Twice Amended), 2, 3 (Amended), 5 and 6 are unpatentable under 35 U.S.C. § 251 under the recapture doctrine based upon an Amendment placing the claims of the parent application in allowable form when the subject matter of the Amendment was not supported in the specification, making the claims inoperable and invalid under 35 U.S.C. § 112, ¶ 1.

#### **GROUPING OF CLAIMS**

Claims 1 (Twice Amended), 2, 3 (Amended), 5 and 6 are grouped together and should be considered as a whole regarding the recapture rejection under 35 U.S.C. § 251.

#### **ARGUMENT**

##### **I. STANDARD FOR REISSUE OF DEFECTIVE PATENTS.**

A patent which is defective may be reissued to correct errors that were made without deceptive intent and are deemed wholly or partially inoperative or invalid by reason of defective specification or drawing, or by reason of the patentee claiming more or less than he had the right to claim under 35 U.S.C. § 251.

“Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the director shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent or the invention disclosed in the original patent, and in accordance with the new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.”  
(35 U.S.C. § 251, ¶ 1).

In enacting this statute, Congress provided a statutory basis for the correction of some errors in issued patents. The statute is remedial in nature, based on fundamental principles of equity and fairness, and should be construed liberally. *In re Weiler*, 790 F.2d 1576, 1579 (Fed. Cir. 1986).

35 U.S.C. § 251, ¶ 1 requires that the patentee base the application for reissue upon one of four specified grounds statutorily identified as correctable defects. *In re Amos*, 953 F.2d 613, 616 (Fed. Cir. 1991). First, an asserted defect may arise from an error in the specification. *Id.* Second, the patentee may correct a defective drawing. *Id.* The final two reasons for which a patentee may seek reissue concern original claims subsequently discovered to have been either too narrow or too broad. *In re Handel*, 312 F.2d 943, 948 (CCPA 1963) (purpose of statute is to permit limitations to be added to, or removed from, claims). The basis for seeking a narrowing reissue has generally been the related discovery of partially-invalidating prior art. *In re Harita*, 847 F.2d 801, 805 (Fed. Cir. 1988). Additionally, a broadening reissue has generally been founded upon post-issuance discovery of attorney error in understanding the scope of the invention. *In re Wilder*, 736 F.2d 1516, 1519 (Fed. Cir. 1984) (“attorneys’ failure to appreciate the full scope of the invention is one of the most common sources of defects”). The fact that the error could have been discovered at the time of the prosecution with a more thorough patentability search or with improved communications between the inventors and the attorney, does not by itself preclude a patent owner from correcting defects through reissue. *Id.*

## **II. A REISSUE PROCEEDING IS APPROPRIATE IN THIS CASE.**

This case fall under the fourth basis for granting a reissue application, Applicant’s attorney erred in understanding the scope of the invention. As stated in Applicant attorney’s declaration, Applicant’s attorney amended the only independent claim, claim 1, of the parent application without any deceptive intent to include subject matter which was not supported by the specification thereby making the claim 1 inoperable and invalid under 35 U.S.C. § 112, ¶ 1. A copy of the declaration is attached hereto as Exhibit A. Because the only independent claim is inoperable and invalid, the dependent claims 2, 3, 5 and 6 are also invalid and inoperable. Therefore, a reissue proceeding is available to correct the error.

**III. CLAIMS 1-6 OF THE ORIGINAL PATENT, WHICH WAS PLACED IN REISSUE, ARE INOPERATIVE AND INVALID DUE TO INADVERTENT ERROR AND WITHOUT ANY DECEPTIVE INTENT IN THE SUBMISSION OF AN AMENDMENT CLAIMING SUBJECT MATTER NOT SUPPORTED IN THE SPECIFICATION.**

The original claims included subject matter which was not supported by the specification and therefore was inoperable and invalid. The specification discloses the sleeve extending up to but not covering the knuckles of the digits. The specification also discloses the thumb opening extending up to but leaving exposed the first joint of the thumb which is also called the thumb knuckle. However, subject matter was inadvertently and erroneously claimed without any deceptive intent in an Amendment submitted on June 23, 1998, included the sleeve extending beyond the knuckles and extending up to the first set of phalanges of the wearer's fingers and thumb, the joints past the knuckles. A copy of the Amendment submitted on June 23, 1998 is attached hereto as Exhibit B. The amended claims were determined to be in allowable form and the application subsequently issued as U.S. Patent No. 5,878,435.

Upon learning of the error, Applicant promptly filed this reissue proceeding. During the prosecution of the reissue application, Applicant has overcome all of the prior art rejections. The only remaining rejection preventing allowance of the application and issuance into a patent is the issue of the alleged recapture of surrendered subject matter rejection from the amendment submitted on June 23, 1998.

The Examiner has based his entire argument for rejecting the reissue application on the fact that the Amendment submitted on June 23, 1998 allegedly surrendered subject matter which allowed the original application to issue into a patent. The Examiner erroneously alleged that since the Applicant has surrendered subject matter, Applicant cannot recapture the subject matter in this reissue proceeding.

Applicant respectfully urges the Board to consider this case about 35 U.S.C. § 112, ¶ 1 in that the claimed subject matter is not supported by the specification rather than a case about the recapture of surrendered subject matter. This case turns on the resolution of whether an Applicant can surrender subject matter that was not in the Applicant's possession.

In this case, subject matter was claimed that was not supported by the specification, namely the sleeve extending to the first joint of the phalanges of the digits and thumb when the specification only disclosed the sleeve extending adjacent to but not covering the knuckles of the digits and thumb. Specifically, the specification states: "The sleeve 12 of the hand and forearm protector extends up to each of the fingers first set of joints or knuckles 47, 49, 51 and 53. The first set of joints of the fingers 46, 48, 50 and 52 are defined as those joints or knuckles that are formed at the articulation of the metacarpal bone and the phalange of each finger. The sleeve 12 does not extend over the joints or knuckles 47, 49, 51 and 53 thereby exposing those knuckles as best illustrated in Fig. 1 wherein the edge 54 lies directly adjacent to the exposed knuckles 47, 49, 51 and 53." (Col. 3, lines 11-20). "Similarly, the thumb opening 18 has an edge 55 that is disposed to extend the sleeve to a position such that the first joint or knuckle of the thumb that is formed between the metacarpal bone and the phalange is exposed." (Col. 3, lines 21-25). Furthermore, a careful review of Figure 1 of the specification shows the sleeve extending up to but leaving exposed the knuckles of the digits and thumb. Therefore, the portion of the sleeve between the knuckles and the first joint of the phalanges was never in Applicant's possession and was erroneously claimed.

Applicant respectfully argues that one cannot surrender subject matter that one never possessed. Therefore, the amendment claiming the subject matter unsupported by the specification should have not have any bearing on this reissue proceeding.

Furthermore, the Examiner's emphasis on Applicant's remarks regarding the alleged criticality of the subject matter in issue because of the arguments made on pages 2 and 5 of the Amendment submitted on June 23, 1998 are not well founded. These arguments were made under the erroneous assumption that the application included the subject matter that was supported in the specification. Based upon the erroneous assumption, the arguments were made to use the subject matter not supported by the specification to distinguish over the prior art. Whether or not the subject matter was used to distinguish over the prior art is not of consequence in this reissue application because the claimed subject matter was never disclosed in the application and therefore was not available to be surrendered.

Additionally, Applicant's attorney has done an exhaustive review of the case law regarding the recapture doctrine and reissue proceeding and found no case to be on point, where the critical point is whether subject matter which is never in the inventor's possession can be surrendered and therefore incapable of being re-obtained under the recapture doctrine. The Examiner cited three cases, namely *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 U.S.P.Q. 289, 295 (Fed. Cir. 1984). In each of these cases, the facts of the cases, amendments were made where the claimed subject matter was supported by the specification. Therefore, the recapture doctrine was applicable because the Applicant was in possession of the surrendered subject matter. This is not the situation in the present case, where Applicant was never in possession of the erroneously claimed subject matter. As such, the recapture doctrine is not applicable.

**IV. 35 U.S.C. § 251 WAS ENACTED TO REMEDY THIS TYPE OF ERROR.**

35 U.S.C. § 251 was enacted and reissue proceedings were designed to correct the situation presented in this case. 35 U.S.C. § 251 was enacted to correct errors that were made without deceptive intent and which causes a patent to be deemed wholly or partially inoperative or invalid by reason of the patentee claiming more than he had the right to claim. 35 U.S.C. § 251 is remedial in nature, and based on fundamental principles of equity and fairness, and should be construed liberally. *In re Weiler*, 790 F.2d 1576, 1579 (Fed. Cir. 1986).

Applicant's attorney inadvertently erred without any deceptive intent in claiming subject matter which was not disclosed in the specification. Applicant's attorney, inadvertently and without any deceptive intent, claimed the subject matter of the sleeve extending beyond the knuckles of the digits and thumb and up to the joint of the phalanges which was not supported by the specification. The Examiner also did not determine that the claimed subject matter was not disclosed in the application. The specification only supports the sleeve extending up to the knuckles of the thumb and digits. If either the Examiner or Applicant's attorney had discovered the claim was not supported by the specification, the Amendment would not have been submitted or would



have been rejected under 35 U.S.C. § 112 ¶ 1 preventing issuance of an inoperative and invalid patent.

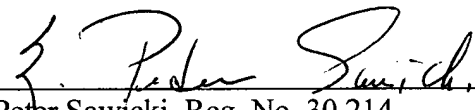
Because of Applicant's attorney's mistake, the Applicant obtained an inoperable and invalid patent. Furthermore, the Examiner could also have prevented this reissue proceeding by determining that the claim was not supported by the specification. The party suffering the consequences of these actions is the Applicant who obtained an inoperable and invalid patent. Therefore, the liberal interpretation and remedial nature of 35 U.S.C. § 251, based upon the fundamental principles of equity and fairness, dictate that the rejection based upon the recapture doctrine be overturned.

V. CONCLUSION

For the foregoing reasons Applicant respectfully request that the rejection of claims 1-3, 5 and 6 under the recapture doctrine be reversed.

Respectfully submitted,

KINNEY & LANGE, P.A.

By:   
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# DECLARATION

IN REISSUE APPLICATION

Attorney Docket No.

R597.12-0003

I declare that:

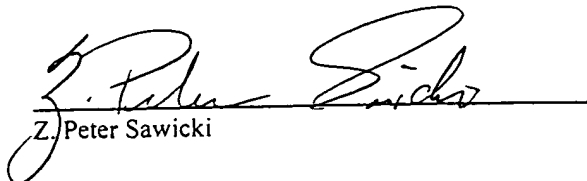
1. I am a patent attorney who conducted the patent prosecution of U.S. Patent No. 5,878,435.
2. I am a patent attorney who file U.S. Provisional Application No.60/046,481.
3. I inadvertently did not claim the priority date of U.S. Provisional Application No. 60/046,481 during the prosecution of U.S. Patent No. 5,878,435 thereby making U.S. Patent No. 5,878,435 partially inoperative.
4. I inadvertently drafted subject matter into the claims which was not supported by the specification thereby making U.S. Patent No. 5,878,435 partially inoperative.
5. I believe that my drafting subject matter into the claims which was not supported by the specification in U.S. Patent No. 5,878,435 arose without any deceptive intent on my part.
6. I believe that my failure in not claiming the priority date of U.S. Provisional Application No. 60/046,481 arose without any deceptive intent on my part.

All statements made herein of my own knowledge are true and all statements made on information and belief are believed to be true; and further, these statements were made with the knowledge that willful false statement and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of this application or any patent issuing thereon.

## DESIGNATION OF CORRESPONDENCE ADDRESS

Please address all correspondence and telephone calls to Z. Peter Sawicki in care of:

KINNEY & LANGE, P.A.  
312 South Third Street  
Minneapolis, Minnesota 55415-1659  
Phone: (612) 339-1863 Fax: (612) 339-6580

  
Z. Peter Sawicki

Date: March 6, 2000

EXHIBIT

A

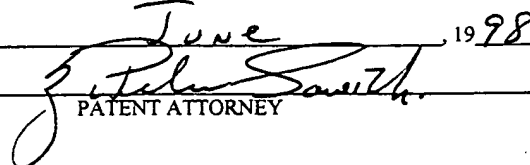
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named Inventor	: Rhonda S. Kast	
Appln. No.	: 08/968,977	
Filed	: November 12, 1997	Group Art Unit: 3741
Title	: HAND AND FOREARM PROTECTOR	Examiner: M. Neas
Docket No.	: R597.12-0002	

AMENDMENT

Box Non-Fee Amendment  
Assistant Commissioner for Patents  
Washington, D.C. 20231

I CERTIFY THAT THIS PAPER IS BEING SENT BY U.S. MAIL,  
FIRST CLASS, TO THE ASSISTANT COMMISSIONER FOR  
PATENTS, WASHINGTON, D.C. 20231, THIS 30th DAY OF

June, 1998.  
  
PATENT ATTORNEY

Sir:

This is in response to the Office Action mailed on March 31, 1998. Please amend claim 1 as follows:

IN THE CLAIMS

Please amend claim 1 and cancel claims 2, 5-7 as follows:

- ( 1. (Amended) A hand and forearm protector comprising:
- a sleeve for overlying a forearm and a proximal hand portion of a wearer;
  - a primary opening at one end of the sleeve;
  - a discrete digit opening [and a discrete thumb opening] disposed at another end of the sleeve wherein the sleeve extends past the set of joints of the metacarpals and the phalanges to a point adjacent a first set of joints of the phalanges which are adjacent to the set of joints of the metacarpals and the phalanges of the wearer's fingers, leaving the joints of the phalanges exposed;
  - a discrete thumb opening disposed at another end of the sleeve wherein the sleeve extends beyond the joint of the phalanges and first metacarpal and is adjacent to the joint of the phalanges, leaving the joint exposed;

EXHIBIT  
B

a longitudinal opening along the sleeve extending adjacent from a point that overlies a juncture of the carpal bones and the radius and extending rearwardly towards the primary opening to proximately the end of the sleeve; and a zipper [closure mechanism] for closing the longitudinal opening to conform the sleeve to the forearm of the wearer, the closure being disposed to overlie a forward side of the forearm.

#### REMARKS

This Amendment is responsive to an Office Action dated March 31, 1998. In the Office Action the Examiner rejected claims 1-8. In response to the Office Action, claim 1 has been amended and claims 2 and 5-7 have been canceled. Currently the application includes amended claim 1, claims 3-4 and claim 8.

The Examiner rejected claims 1, 4 and 5 as being anticipated by Elliott (U.S. Patent No. 2,904,792) hereinafter referred to as the '792 patent. The Examiner stated the '792 patent discloses a primary opening for receiving the forearm, discrete digit openings and a discrete thumb opening. Furthermore, the Examiner stated the '792 patent discloses a longitudinal opening which extends from a point that overlies the juncture of the carpal bones and radius towards the primary opening. Additionally, the Examiner states the '792 patent discloses that the sleeves extend to the joints closest to the fingertips exposed.

In response to the Examiner's rejection of claims 1, 4 and 5 as being anticipated by the '792 patent, claim 1 has been amended and claim 5 has been canceled. Amended claim 1 now includes a discrete thumb opening where the sleeve extends beyond the joint of the first metacarpal and phalanges up to but not covering the adjacent phalanges joint on the thumb.

In contrast, the '792 patent discloses a protective sleeve with an opening in the sleeve for the wearer's thumb. (col. 2, lines 8-10). The thumb opening in the protective sleeve disclosed in the '792 patent does not extend beyond the joint of the metacarpal and phalanges. The protective

sleeve disclosed in the '792 patent does not provide protection for the thumb beyond the joint of the metacarpal and phalanges.

The invention defined in amended claim 1 provides more protection for the thumb than the protective sleeve disclosed in the '792 patent. The invention defined in amended claim 1 provides a sleeve which extends past the joint of the metacarpal and phalanges of the thumb adjacent to but not covering the joint of the phalanges. In contrast, the '792 patent discloses a protective sleeve which provides protection of the thumb up to the joint of the metacarpal and phalanges. Therefore, the invention defined in amended claim 1 provides more protection for the thumb than the protective sleeve disclosed in the '792 patent because the invention defined in amended claim 1 provides protection for the thumb past the joint of the metacarpal and phalanges to a point adjacent to the joint of the phalanges. Because the invention defined in amended claim 1 provides more protection for the thumb than the protective sleeve disclosed in the '792 patent, the '792 patent does not anticipate the invention defined in amended claim 1.

Additionally, claim 1 has been amended to include a zipper for closing a longitudinal opening of the protector. The invention defined in amended claim 1 provides the longitudinal opening extends adjacent from a point that overlies a juncture of the carpal bones and the radius toward the primary opening of the protector. Furthermore, the invention defined in amended claim 1 provides the zipper to conforms the sleeve to the forearm.

In contrast, the '792 patent discloses a closing mechanism consisting of a row of apertures on opposite sides of the sleeve. (Col. 2, lines 14-17). The '792 patent further discloses that the apertures are aligned and a single cord which is secured to an aperture proximate to the end of the sleeve from which the hand extends. (Col. 2, lines 23-28). The cord is then woven through the aligned apertures. (Col. 2, lines 23-40). The '792 patent discloses that the cord is pulled tight to conform the sleeve to the forearm. (Col. 2, lines 28-38). The sleeve is secured in the tightened condition by winding the cord around an anchoring disk located near the forearm opening of the sleeve. (Col. 2, lines 57-63).

The closure mechanism disclosed in the invention defined in amended claim 1 is different than the closure mechanism for the protective sleeve disclosed in the '792 patent. Amended claim 1 defines a zipper for closing the longitudinal opening of the protector. In contrast, the '792 patent discloses a series of aligned apertures and a cord which is woven through the apertures and tightened as the closing mechanism. The '792 does not disclose nor mention providing a zipper as a closing mechanism. Furthermore, amended claim 1 does not define a closing mechanism consisting of a series of aligned apertures and a cord. Therefore, the closing mechanism defined in amended claim 1 is significantly different than the closing mechanism disclosed in the '792 patent.

Because the closing mechanism defined in amended claim 1 is different than the closing mechanism disclosed in the '792 patent and the invention defined in amended claim 1 provides more protection for the thumb than the protective sleeve disclosed in the '792 patent, amended claim 1 is not anticipated by the '792 patent. Amended claim 1 is in allowable form. Reconsideration and allowance of amended claim 1 are respectfully requested.

Because amended claim 1 is believed to be in allowable form, dependent claim 4 should also be in allowable form. Reconsideration and allowance of dependent claim 4 are respectfully requested.

Dependent claims 2 and 3 were rejected by the Examiner as being obvious over the '792 patent in view of the Bourdeau et al. patent (U.S. Patent No. 4,868,927). Claim 2 has been cancelled, and the primary element of claim 2, a zipper, has been added to amended claim 1. Since claim 3 depends from independent amended claim 1, which is in allowable form, claim 3 is also in allowable form. Reconsideration and allowance of claim 3 are respectfully requested.

Claim 8 was rejected as being obvious by the '792 patent. Claim 8 depends from independent amended claim 1. Because amended claim 1 is in allowable form, dependent claim 8 is also in allowable form. Reconsideration and allowance of dependent claim 8 are respectfully requested.

Additionally, the Examiner rejected claims 1-3 and 5-8 as being obvious over the Elliott patent (U.S. Patent No. 4,967,419), hereinafter the '419 patent, in view of the Bourdeau et al. patent (U.S. Patent No. 4,868,927). The Examiner stated the '419 patent discloses a sleeve

overlying a proximal hand portion and forearm with the primary opening and discrete digit openings, and a discrete thumb opening. The Bourdeau et al. patent, as stated by the Examiner, discloses an arm covering which includes a zipper closure mechanism. Furthermore, the Examiner stated that the Bourdeau et al. patent discloses a protective flap which prevents the wearer from being pinched by the zipper.

In response to the Examiner's rejection of claim 1 as being obvious over the '419 patent in view of the Bourdeau et al. patent, claim 1 has been amended. Amended claim 1 now includes a discrete thumb opening wherein the sleeve extends beyond the metacarpal and phalanges joint to a location adjacent to the joint of the phalanges leaving the joint exposed. Furthermore, claim 1 has been amended to include a discrete digit opening where the sleeve extends to a point adjacent to the first set of phalanges joint of the wearer's fingers which leaves the joint of the phalanges exposed.

In contrast, the '419 patent discloses a series of finger apertures. (Col. 2, lines 51-54). Unlike amended claim 1, which defines an invention with a single discrete digit opening with the sleeve extending to the first phalanges joint, the '419 patent discloses four individual digit apertures where the knuckles are exposed. Because the '419 patent discloses four individual digit apertures whereas the invention defined in claim 1 discloses one discrete opening, the disclosure of the '419 patent does not make amended claim 1 as being obvious.

Furthermore, amended claim 1 provides more protection to the digits than the protective sleeve disclosed in the '419 patent because the sleeve defined in amended claim 1 extends past the joint of the metacarpal and phalanges to the first phalanges joint. In contrast, the '419 patent discloses that the sleeve provides no protection for the knuckles or the four digits. Therefore, the invention defined in amended claim 1 provides more protection for the digits than the protective sleeve disclosed in the '419 patent.

Additionally, amended claim 1 defines an invention which provides protection for the thumb past the joint of the metacarpal and phalanges, up to the joint of the phalanges. In contrast, the '419 patent discloses a thumb opening where no protection is provided for the thumb past the joint of the metacarpal and phalanges. Therefore, amended claim 1 provides more protection to the

thumb than the protective sleeve disclosed in the '419 patent because the sleeve defined in amended claim 1 provides more coverage for the thumb.

Amended claim 1 defines an invention where the closure mechanism for the longitudinal opening in the protector is a zipper. Furthermore, invention defined in amended claim 1 provides that the longitudinal opening begins at the juncture of the carpal bones and the radius and extends toward the primary opening. The longitudinal opening provides access for the hand into the protector when the zipper is in the open position. Additionally, when the zipper is closed the protector conforms to the wearer's forearm. Additionally, locating the longitudinal opening rearwardly at the ball of the thumb is to provide a snug fit of the protector to the ball of the thumb.

In contrast, the Bourdeau et al. patent discloses a glove with a longitudinal opening which extends from the base of the index finger to the rear of the glove (Col. 7, lines 16-20). The Bourdeau et al. patent further discloses a zipper as a closure mechanism for the longitudinal opening. (Col. 7, lines 24-25). The Bourdeau et al. patent discloses one purpose of the zipper on the glove is to provide a substantially open access passage for the hand into the glove when the zipper is not engaged. (Col. 6, lines 45-48). The Bourdeau et al. patent discloses the purpose for closing the zipper is to apply the glove against the hand or forearm. (Col. 6, lines 48-53).

The location and purpose of the zipper in the invention defined amended claim 1 is different than the location and purpose of the zipper disclosed in the Bourdeau et al. patent. The invention in amended claim 1 locates one end of the longitudinal opening, and therefore the zipper, adjacent to the ball of the thumb. By locating the longitudinal opening and zipper adjacent to the ball of the thumb, a snug fit between the invention defined in amended claim 1 and the ball of the thumb is formed. A snug fit at the base of the thumb is required to keep the protector stationary on the hand. Without a snug fit between the protector and the ball of the thumb, the protector would have a tendency to slide around the hand because the digits cannot hold the protector in place because there is a single opening for the digits. Allowing the protector defined in amended claim 1 to slide would allow the protector to get out of position and not adequately protect the thumb or digits.

In contrast, the Bourdeau et al. patent discloses a longitudinal opening and zipper located from the base of the index finger toward the forearm. The purpose of the longitudinal



opening and zipper is to provide access for the hand into the glove when the zipper is open. Furthermore, the zipper is to apply the glove to the hand and forearm when zipper is closed. Because the Bourdeau et al. patent discloses a glove with individual apertures and coverings for each digit and thumb, the digits and thumb will prevent the glove from getting out of position on the hand. Therefore, the Bourdeau et al. patent only has to provide for a closure mechanism which forms the glove to the hand and forearm.

Therefore, the location of the longitudinal opening and zipper are not as important in the glove disclosed in the Bourdeau et al. patent as the location of the invention defined in amended claim 1. Consequently, the Bourdeau et al. patent does not make amended claim 1 obvious because the Bourdeau et al. patent does not disclose a longitudinal opening and zipper adjacent to the ball of the thumb which is required for the invention defined in amended claim 1.

Because the invention defined in amended claim 1 has one discrete digit opening, provides more protection to the digits and thumb than the protective sleeve disclosed in the '419 patent, and defines a location of the longitudinal opening and zipper not disclosed in the Bourdeau et al patent, amended claim 1 is not made obvious by the disclosure of the '419 patent in view of the Bourdeau et al. patent. Therefore, amended claim 1 is in allowable form. Reconsideration and allowance of amended claim 1 are respectfully requested.

Claims 3 and 8 depend from amended claim 1. Since amended claim 1 is in allowable form, claims 3 and 8 are also in allowable form. Reconsideration and allowance of claims 3 and 8 are respectfully requested.

The Examiner rejected claim 3 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention because "the zipper" in claim 3 lacks antecedent basis. In response to the allegation that the zipper in claim 3 lacks antecedent basis, attention to amended claim 1 is requested where the zipper in claim 3 is referred to as a zipper. Therefore, the zipper in claim 3 does not lack antecedent basis.

In view of the foregoing remarks, Applicant respectfully submits that currently rejected amended claim 1, claims 3-4 and claim 8 are in condition for allowance. Reconsideration and allowance are respectfully requested.

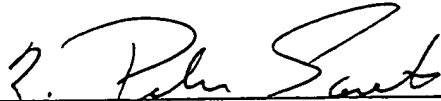
First Named Inventor: Rhonda S. Kast

Application No.: 08/968,977

-8-

Respectfully submitted,

KINNEY & LANGE, P.A.

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PJI/ZPS:jb

Appendix A  
[Claims]

1. (Twice Amended) A hand and forearm protector comprising:

- a sleeve for overlying a forearm and a proximal hand portion of a wearer;
- a primary opening at one end of the sleeve;
- a single discrete digit opening disposed at another end of the sleeve wherein all of the wearer's fingers extend therethrough, wherein the sleeve extends to a point adjacent a first set of knuckles of the wearer's fingers, leaving the knuckles exposed;
- a discrete thumb opening disposed at another end of the sleeve;
- a longitudinal opening along the sleeve extending adjacent from a point that overlies a juncture of the carpal bones and the radius and extending rearwardly towards the primary opening to proximally the end of the sleeve; and
- a zipper for closing the longitudinal opening to conform the sleeve to the forearm of the wearer, the closure being disposed to overlie a forward side of the forearm.

*where the sleeve extends to the joint of thumb do not to the finger leaving the joint exposed*

3. (Amended) The protector of claim 1 wherein the length of the sleeve is selected to extend to approximately 1 to 1½ inches from an elbow of the wearer.

4. The protector of claim 1 wherein the sleeve includes decorative indicia on an uninterrupted surface.

5. The protector of claim 1 wherein the sleeve extends to a first joint of the thumb, leaving the joint exposed.

6. The protector of claim 1 wherein the sleeve extends to a point adjacent a first knuckle of the fingers and thumb, leaving the knuckles exposed.

Appendix B

REFERENCES CITED (Copies are Attached)

U.S. Patent No. 5,878,435



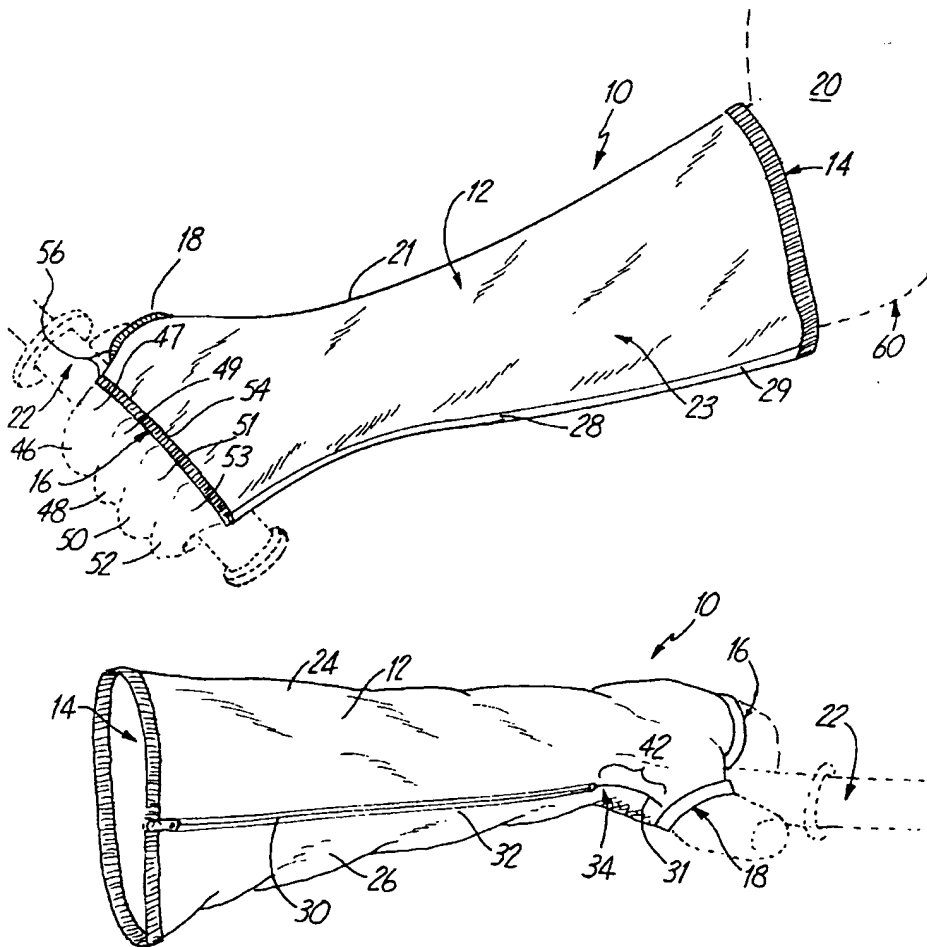
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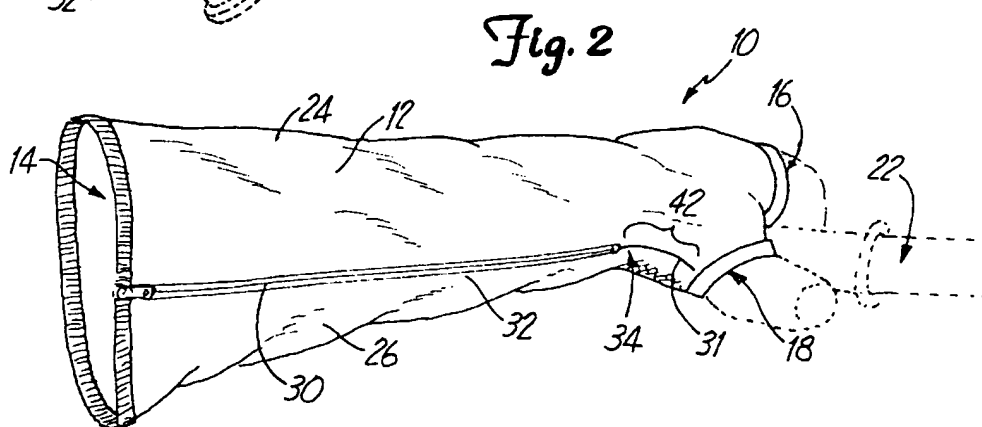
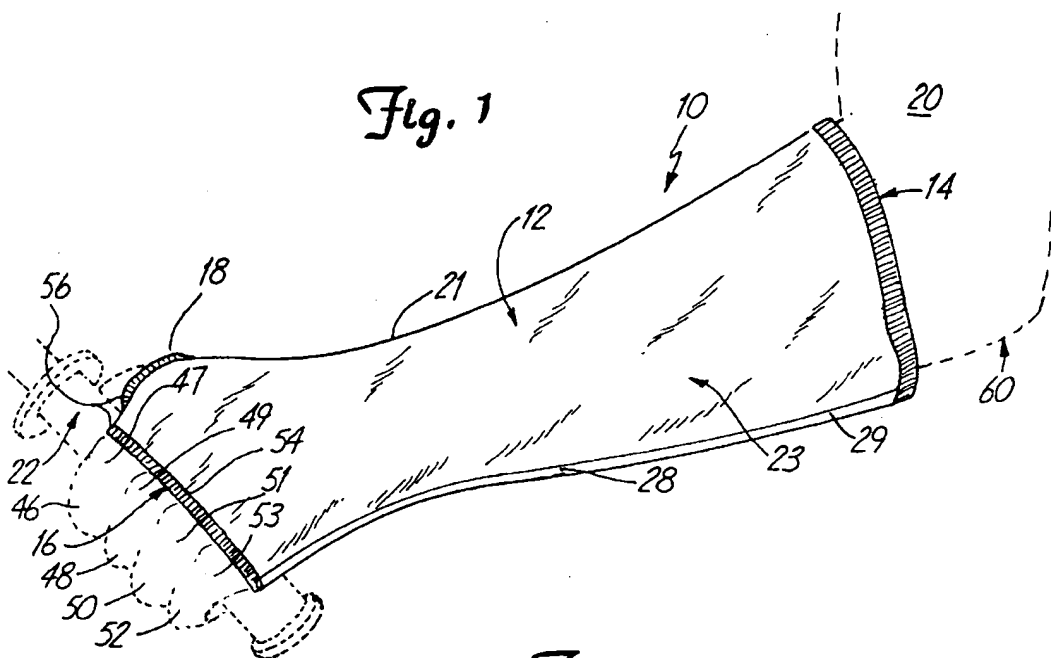
**United States Patent** [19]**Kast et al.**[11] **Patent Number:** **5,878,435**[45] **Date of Patent:** **Mar. 9, 1999**[54] **HAND AND FOREARM PROTECTOR**[76] **Inventors:** **Rhonda S. Kast; Ricky V. Redman,**  
both of 98 - 64th Way, Fridley, Minn.  
554324,967,419 11/1990 Elliott ..... 2/161.6  
5,070,541 12/1991 Goss ..... 2/16  
5,073,988 12/1991 Lewis, Jr. et al. .... 2/162*Primary Examiner*—Michael A. Neas[21] **Appl. No.:** **968,977**[22] **Filed:** **Nov. 12, 1997**[51] **Int. Cl.<sup>6</sup>** ..... **A41D 19/00**[52] **U.S. Cl.** ..... **2/16; 2/159; 2/162**[58] **Field of Search** ..... **2/16, 159, 161.6,**  
**2/162, 170, 59, 125, 126, 163, 269, 270**[56] **References Cited****U.S. PATENT DOCUMENTS**

D. 299,562	1/1989	Lee	.....	D29/20
363,829	5/1887	Jennings	.....	2/159
622,688	4/1899	Horn	.....	2/159
906,856	12/1908	Bernard	.....	2/162
2,904,792	9/1959	Elliott	.....	2/16
3,000,378	9/1961	Zieman	.....	2/16

[57] **ABSTRACT**

A hand and forearm protector having a sleeve with a primary opening at one end and at another end a discrete finger opening and a discrete thumb opening also includes a longitudinal opening disposed along the sleeve. The longitudinal opening extends from a point directly adjacent a juncture of the carpal bones and the radius of a hand of the wearer and extends rearwardly along an forward side of the forearm approximately to the primary opening at the end of the sleeve. A zipper is included that extends from the juncture of the sleeve that overlies the carpal bones and radius and the zipper extends rearwardly to the end of the sleeve for bringing the edges of the sleeve together to conform the sleeve to the forearm of the wearer.

**4 Claims, 5 Drawing Sheets**



*Fig. 3*

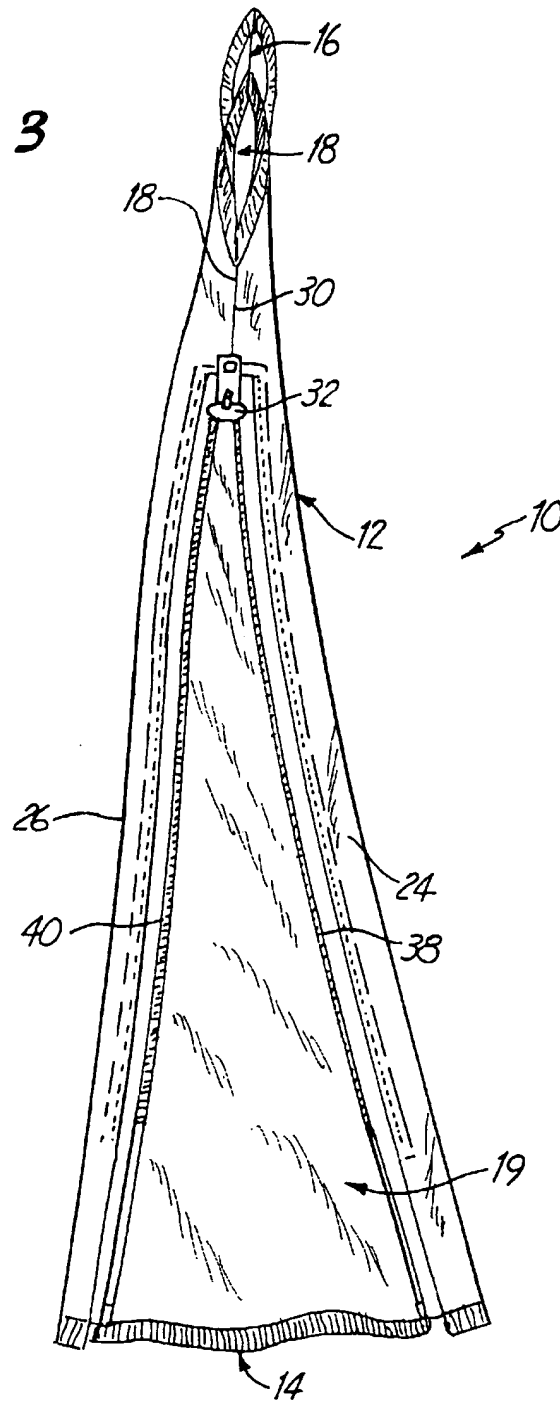


Fig. 4

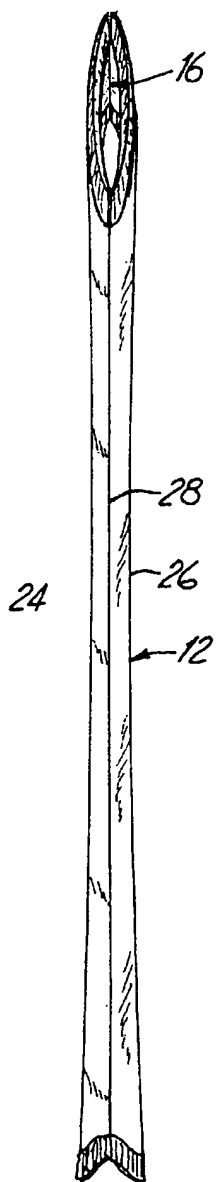


Fig. 5

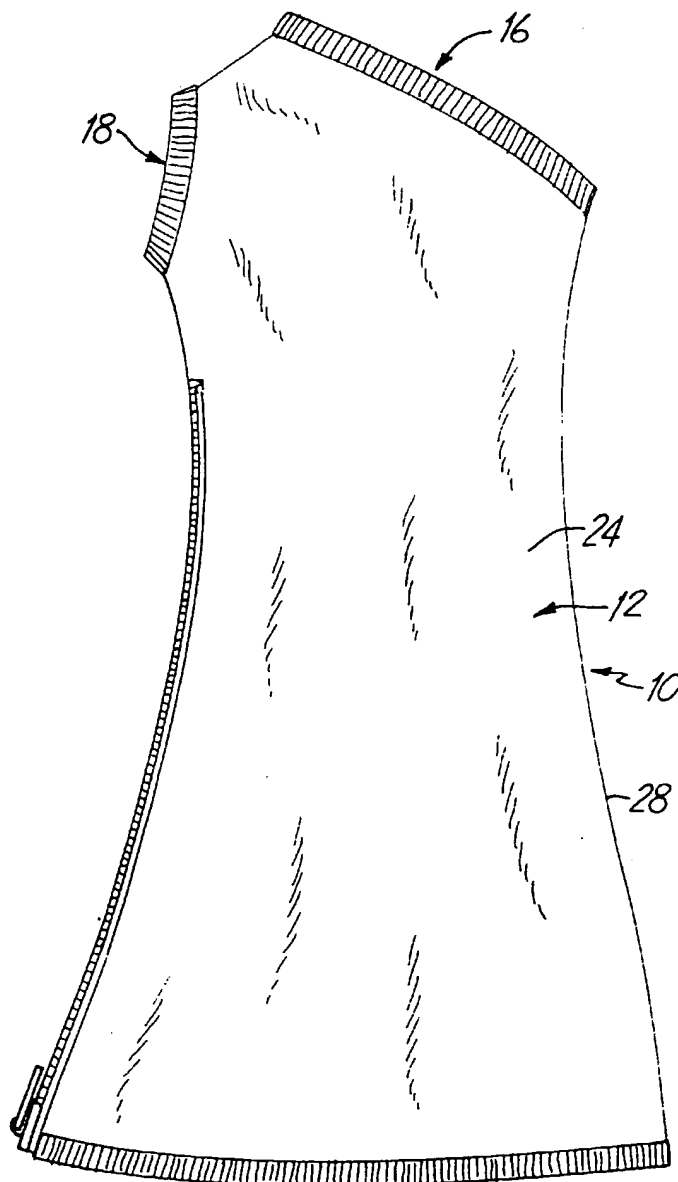




Fig. 6

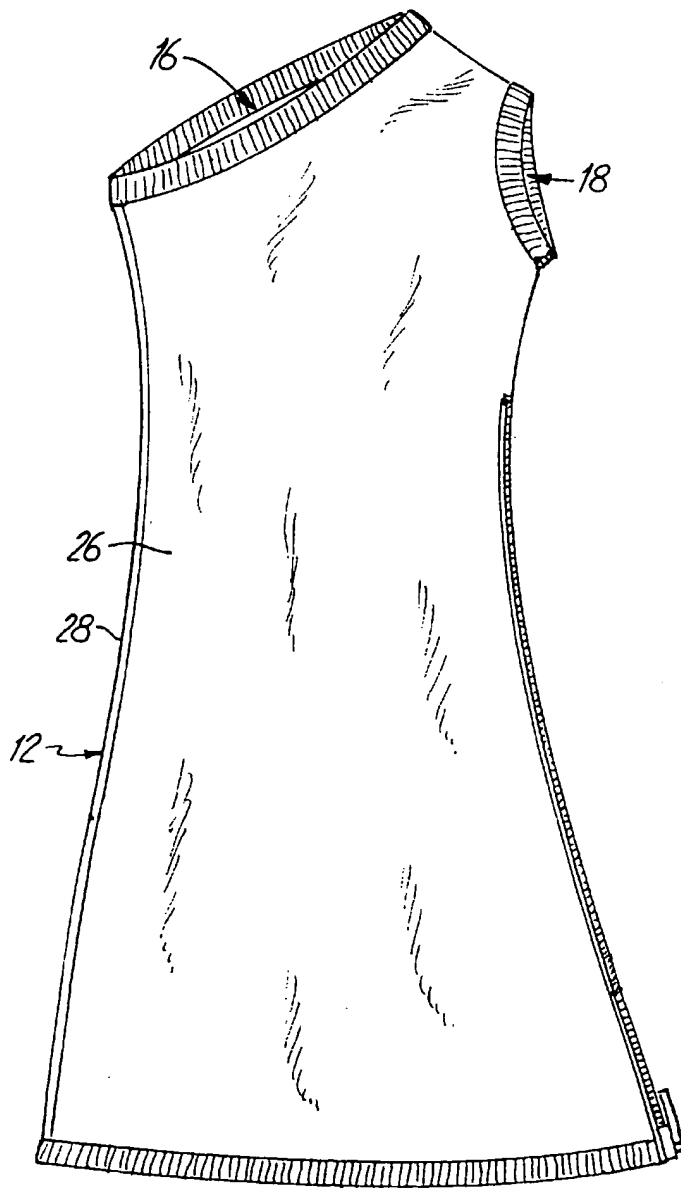


Fig. 7

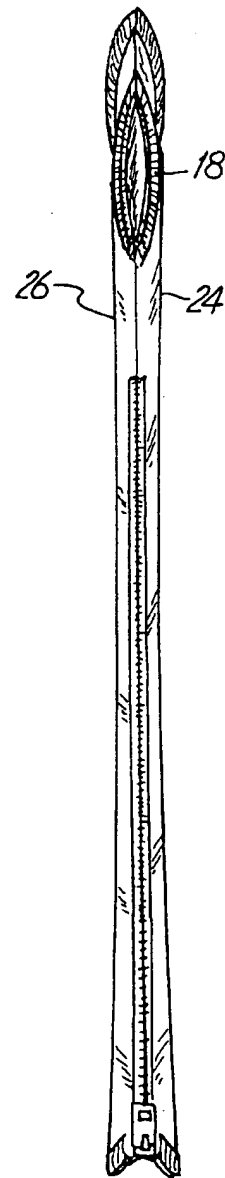


Fig. 8

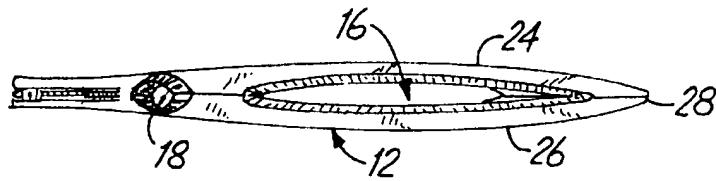
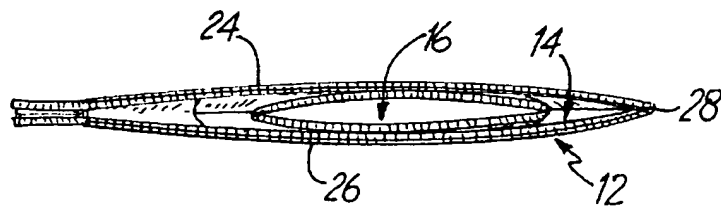


Fig. 9



## HAND AND FOREARM PROTECTOR

## BACKGROUND OF THE INVENTION

The present invention relates to hand and forearm protectors, and in particular, it relates to a hand and forearm protector that is also visually appealing.

Coverings for the hand and forearm or for the forearm or hand individually are well known. There are numerous reasons why such hand and forearm protectors are used. Some of these reasons relate to protection in athletics, for example, linemen wear forearm protectors in football or in-line skaters wear hand and wrist guards. Hand and forearm protectors also are used for medical reasons as restraining devices such as to protect a sprained wrist. Additional, examples of hand and forearm protectors are found in the following U.S. patents.

Inventor	U.S. Pat. No.
Chang	4,011,596
Finnieston et al.	4,765,319
Finnieston et al.	4,873,968
Elliot	4,967,419
Matthews	5,402,536
Olson et al.	5,526,531
Pierce, Jr.	Des. 290,766
Pierce, Jr.	Des. 330,676

## BRIEF SUMMARY OF THE INVENTION

The present invention includes a hand and forearm protector having a sleeve. The sleeve has a primary opening at one end and at another end a discrete finger opening and a discrete thumb opening. A longitudinal opening is disposed along the sleeve and extends from a point directly proximal a juncture of the carpal bones and the radius of a hand of the wearer rearwardly along a foreword side of the forearm to approximately the end of the sleeve. A closure mechanism, preferably a zipper, extends from the point of the sleeve overlying the juncture of the carpal bones and radius rearwardly to the end of the sleeve for bringing the edges of the sleeve together to conform the sleeve to the forearm of the wearer.

## BRIEF DESCRIPTION OF THE DRAWINGS

FIG. 1 is a perspective view of the forearm protector of the present invention.

FIG. 2 is a perspective view from a different angle of the forearm protector.

FIG. 3 is a side view of the forearm protector with a zipper in an open position.

FIG. 4 is a left side plan view of the forearm protector.

FIG. 5 is a top plan view of the forearm protector.

FIG. 6 is a bottom plan view of the forearm protector.

FIG. 7 is a right side plan view of the forearm protector.

FIG. 8 is a front plan view.

FIG. 9 is a rear plan view.

## DETAILED DESCRIPTION OF THE PREFERRED EMBODIMENTS

The hand and forearm protector of the present invention is generally illustrated at 10 in FIGS. 1-9. The hand and forearm protector 10 is used to cover and protect a proximal portion of a hand 21 and an entire forearm 23 of a motor-

cycle driver 20 when riding and gripping handlebars 22 of a motorcycle (not illustrated). The hand and forearm protector 10 is also designed to be worn as a decorative piece of clothing and as such its use is not limited to driving motorcycles.

As best illustrated in FIGS. 1 and 2, the hand and forearm protector 10 includes a sleeve portion 12 having at one end a forearm opening 14 and at another end a discrete digit opening 16 and a discrete thumb opening 18. The thumb opening 18 is an opening that is discrete from and separate from the digit opening 16. The openings 16 and 18 are separated by a section 56 of the sleeve 12. The sleeve also includes a longitudinal opening 19 that overlies a forward forearm portion. By forward forearm is meant that portion of the forearm that faces forward when the arms are left to hang naturally and loosely along side the body.

The sleeve 12 of the hand and forearm protector 10 is made of a flexible continuous piece of fabric sewn to create a cylindrical-type structure into which the hand 21 is inserted along with the entire forearm 23 of the wearer 20. The sleeve 12 may be made of any suitable fabric that is pliable, wear resistant and suitable for use outdoors. A preferred material is leather although other materials suitable or popular for outdoor use are included within the scope of the present invention.

For purposes of description in this application, the surface of the sleeve 12 is divided into an outer surface segment 24 and an inner surface segment 26 joined at a rearward surface segment 28. The outer surface segment faces away from the body when the arms are left to hang naturally and loosely along side the body while the inner segment faces the body. Similarly, the rearward surface segment 28 covers a rearward portion of the forearm 23. The sleeve 12 has a continuous uninterrupted surface through the outer segment 24, the inner segment 26 and the rearward segment surface segment 28 as illustrated in the Figures. The sleeve 12 extends away from the hand, to approximately 1 to 1½ inches from the wearers elbow 60, as best illustrated in FIG. 1. In one preferred embodiment, the sleeve 12 is made of two distinct pieces of leather, joined by sewing along a line 29 that extends along the entire length of the sleeve as best illustrated in FIG. 1, and sewn along a line 33 between the thumb opening 18 and digit opening 16, as best illustrated in FIGS. 5 and 6, and sewn along a line 31 that extends from the thumb opening 18 to the longitudinal opening 19.

A zipper 32 is provided to open and close the opening 19. The zipper is positioned to start at a point 34 on the sleeve that is directly adjacent rearwardly of the ball of the thumb which is sometimes referred to as the thenar muscle. In relation to bone structure, this position may also be defined as a juncture of the carpal bones and radius. The sleeve is sewn along the line 31 such that the sleeve conforms in a snug fashion to the ball of the thumb.

The longitudinal opening 19 extends from this position to the end of the sleeve at the forearm opening 14 to permit inserting the hand of the wearer into the forward portion of the sleeve and once inserted, the zipper 32 is closed to conform the sleeve to the wearer's forearm. The zipper 32 when in a closed position brings an upper edge 38 of the segment 24 and a lower edge 40 of the segment 26 together to conform the sleeve 12 to the forearm 23 of the wearer 20 in a form-fitting fashion.

To insert the hand and forearm into the forearm protector of the present invention, the zipper 32 is positioned in an open position as illustrated in FIG. 3 which permits opening 19 to widen. An inner flap section 44 triangular in configu-

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ration is attached along one edge to an inner surface of the segment 26 and at another edge to an inner surface of the segment 24. The flap 44 is disposed such that its apex is proximate the ball of the thumb while its base is disposed proximate the forearm opening 14. The flap section 44 protects the user's forearm from being pinched by the zipper 32 when the slide of the zipper 32 is moved.

The digit opening 16 is sufficiently wide for all four fingers 46, 48, 50 and 52 to extend therethrough. The opening 16 includes an edge 54 which encircles all four fingers as a unit. The sleeve 12 of the hand and forearm protector extends up to each fingers' first set of joints or knuckles 47, 49, 51 and 53. The first set of joints of the fingers 46, 48, 50 and 52 are defined as those joints or knuckles that are formed at the articulation of the metacarpal bone and the phalange of each finger. The sleeve 12 does not extend over the joints or knuckles 47, 49, 51 and 53 thereby exposing those knuckles as best illustrated in FIG. 1 wherein the edge 54 lies directly adjacent to the exposed knuckles 47, 49, 51 and 53.

Similarly, the thumb opening 18 has an edge 55 that is disposed to extend the sleeve to a position such that the first joint or knuckle of the thumb that is formed between the metacarpal bone and the phalange is exposed.

It will be appreciated that the position of the zipper 32, that is along an inner section of the forearm, permits the application of decorative designs along the outer segment 24, the rearward segment 28 and the inner segment 26. Indicia such as designs and other decorative features may be placed on the sleeve without interference or interruption by closure or fastening mechanisms that are found in prior art forearm protectors. The tight fit or conformance to the proximal portion of the hand exposing all of the knuckles of the hand and thumb is very visually pleasing.

Although the present invention has been described with reference to preferred embodiments, workers skilled in the

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art will recognize that changes may be made in form and detail without departing from the spirit and scope of the invention.

We claim:

1. A hand and forearm protector comprising:

a sleeve for overlying a forearm and a proximal hand portion of a wearer;

a primary opening at one end of the sleeve;

a discrete digit opening disposed at another end of the sleeve wherein the sleeve extends past the set of joints of the metacarpals and the phalanges to a point adjacent a first set of joints of the phalanges which are adjacent to the set of joints of the metacarpals and the phalanges of the wearer's fingers leaving the joints of the phalanges exposed;

a discrete thumb opening disposed at another end of the sleeve wherein the sleeve extends beyond the joint of the phalanges and first metacarpal and is adjacent to the joint of the phalanges leaving the joint exposed;

alongitudinal opening along the sleeve extending adjacent from a point that overlies a juncture of the carpal bones and the radius and extending rearwardly towards the primary opening to proximately the end of the sleeve; and

a zipper for closing the longitudinal opening to conform the sleeve to the forearm of the wearer, the closure being disposed to overlie a forward side of the forearm.

2. The protector of claim 1 and further including a protective flap that extends between edges of the opening protecting the wearer from being pinched by the zipper.

3. The protector of claim 1 wherein the sleeve extends to approximately 1 to 1½ inches from an elbow of the wearer.

4. The protector of claim 1 wherein the sleeve includes decorative indicia on an uninterrupted surface.

\* \* \* \* \*

UNITED STATES PATENT AND TRADEMARK OFFICE  
**CERTIFICATE OF CORRECTION**

PATENT NO. : 5,878,435

DATED : MARCH 9, 1999

INVENTOR(S) : RHONDA S. KAST ET AL.

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

Col. 4, Line 14, after "fingers" insert --,--

Col. 4, Line 20, after "phalanges" insert --,--

Col. 4, Line 21, delete "alongitudinal", and insert --a longitudinal--

Signed and Sealed this  
Fifth Day of October, 1999

Attest:



Q. TODD DICKINSON

Attesting Officer

Acting Commissioner of Patents and Trademarks

Appendix C \*\*\*\*  
[Table of Cases]

*Ball Corp. v. United States*, 729 F.2d 1429 (Fed. Cir. 1984)

*Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472 (Fed. Cir. 1998)

*In re Amos*, 953 F.2d 613 (Fed. Cir. 1991)

*In re Clement*, 131 F.3d 1464 (Fed. Cir. 1997)

*In re Handel*, 312 F.2d 943 (CCPA 1963)

*In re Harita*, 847 F.2d 801 (Fed. Cir. 1988)

*In re Weiler*, 790 F.2d 1576 (Fed. Cir. 1986).

**BALL CORPORATION, Appellee, v. THE UNITED STATES, Appellant**  
**729 F.2d 1429; 1984 U.S. App. LEXIS 14870; 221 U.S.P.Q. (BNA) 289**  
**Appeal No. 84-680**  
**March 15, 1984**  
**UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT**  
**Baldwin, Bennett, and Smith, Circuit Judges.**

**Disposition**

**AFFIRMED AND REMANDED.**

**Counsel**

Joseph A. Hill, of Washington, District of Columbia, for Appellant.

Allen Kirkpatrick, of Washington, District of Columbia, for

Appellee.

**Editorial Information: Prior History**

Appealed from United States Claims Court.

**Opinion**

**Opinion by:** SMITH

**{729 F.2d 1430}** SMITH, Circuit Judge.

This case presents the question whether a patentee is barred by the recapture rule from securing, through reissue, claims to subject matter previously canceled from the original application. Plaintiff-appellee, Ball Corporation (Ball), brought suit against the Government in the United States Court of Claims under 28 U.S.C. § 1498(a) (1976) for unauthorized use of the invention claimed in U.S. patent No. Re. 29,296 (July 5, 1977) to Krutsinger, et al. (the Krutsinger patent). The Government moved for summary judgment and Ball filed a cross-motion for summary judgment. Both motions were denied.<sup>1</sup> The Government appealed denial of its motion to this court. At the time of that first appeal, the judgment of the trial judge was not final and the issues had not been certified for appeal. In view of the uncertified, interlocutory nature of the appeal at that time, this court on March 30, 1983, issued an order dismissing the appeal for lack of jurisdiction with leave to seek certification and to appeal pursuant to 28 U.S.C. § 1292(d)(2). On November 22, 1983, the trial judge certified the questions. Permission was granted on December 12, 1983, to take interlocutory appeal to this court. The Government again appeals. We conclude **{729 F.2d 1431}** that the trial judge properly denied the Government's motion for summary judgment, and we remand the case for trial.

*Background*

The invention covered by the Krutsinger patent relates to a dual slot antenna assembly [10] (Fig. 1) intended for use on missiles.

[SEE ILLUSTRATION IN ORIGINAL]

The antenna (Fig. 2) consists of two thin cylindrical concentric conductors [20, 24] assembled so that they are radially spaced slightly apart to form a cavity [18]. The cavity may be void or may be filled with a dielectric material. The axial length of the conductors is substantially equal to one-half wavelength at the anticipated operating frequency of the antenna. The conductor assembly can be mounted around the outer skin of the vehicle (Fig. 1).

The circumferential edges of the cylindrical conductors define radiation slots [23, 25] (Fig. 3).

[SEE ILLUSTRATION IN ORIGINAL]

Because the cylindrical conductors are one-half wavelength long, these radiation slots are, ipso facto, longitudinally spaced one-half wavelength apart at the anticipated operating frequency of the antenna. The radiation slots are excited by signal energy from a source and cooperate to

produce an omnidirectional dipole radiation pattern.<sup>2</sup> Due to the one-half wavelength spacing between the radiation slots, the electromagnetic radiation emanating from the {729 F.2d 1432} slots [R(1), R(2)] radiates in the same direction and overlaps in an additive manner to provide a stronger radiation pattern.

Signal energy is supplied to the antenna by a connector [70] (Fig. 4).

[SEE ILLUSTRATION IN ORIGINAL]

In the preferred embodiment of the invention, the connection of the inner and outer cylindrical concentric conductive elements to the source is accomplished by means of a single coaxial transmission feedline. It is this feedline element around which the present controversy revolves. In particular, this case involves the number of feedlines to the outer conductor that may be properly claimed in the Krutsinger reissue patent in light of the prosecution history of the original patent application.

#### *The Canceled Claims*

Dependent claims 8 and 9 are the only claims of the original application critical to this appeal. Claim 8 includes the single feedline, whereas claim 9 does not. Claim 8 calls for "at least one" conductive lead to be connected to the edge of one of the conductors. Claim 9 requires that "a plurality of leads" be connected to the edge of one of the conductors at circumferentially spaced intervals.

In the first office action on the original application the examiner rejected claims 1-8 and indicated that claims 9 and 10 should be limited to a plurality of feedlines. The claims were amended and, on July 14, 1972, the examiner made his second rejection final. The examiner again suggested the allowability of the plurality of feedlines claims if presented in independent form. The remaining claims were rejected over the newly cited reference, Cork, U.S. patent No. 2,234,234. The Cork patent discloses a single feedline [3] (Fig. 5) and is similar in all other material respects to Krutsinger's antenna.

[SEE ILLUSTRATION IN ORIGINAL]

Following the second office action, Ball added limitations to the claims requiring that a plurality of leads be connected to an edge of the outer conductor. These leads were recited to be spaced-apart at intervals substantially equal to one wavelength at the anticipated operating frequency of the antenna. Ball also canceled claim 7 and dependent claim 8 (the canceled claims), of the original application, which are set forth below:

7. A dual slot antenna assembly comprising: a first substantially cylindrical conductor, the axial length of which is approximately equal to one-half wavelength at the anticipated operating frequency of said assembly; a second substantially cylindrical conductor, the axial length of which is at least equal to the axial length of said first conductor, said second conductor being positioned concentrically within and radially spaced from said first conductor so as to define a pair of circumferential slots spaced one-half wavelength apart at said anticipated operating frequency and providing independent radiation patterns emanating in the same direction; and electrical signal feed means connected with said {729 F.2d 1433} conductor for electrically exciting both of said slots.

8. An assembly according to Claim 7 wherein said feed means includes at least one conductive lead which terminates connected to the edge of one of said conductors defining one of said slots.

U.S. patent No. 3,810,183 (the original patent) issued on May 7, 1974, to Ball as assignee, on the basis of the original application, as amended.

Subsequently, Ball decided that it was entitled to claims broad enough to include the single feedline. On July 16, 1975, within the 2-year statutory period for broadened reissue provided in 35 U.S.C. § 251, Ball filed a reissue application. Claims 1-4 of the reissue application comprised the four claims of the original patent. New claims 5-7 were added to the reissue application. Only the new claims, 5-7, directed to the single feedline embodiment, are in issue in this proceeding.<sup>3</sup>

#### *The Alleged Error*

In support of its reissue application Ball stated that the original patent was partially inoperative because it claimed less than Ball had a right to claim. Ball identified as error the undue limitation of



the claims of the original patent to a plurality of feedlines:

The unwarranted limited scope of our original patent claims were errors [sic] that arose without any deceptive intention as a result of inadequate and/or ineffective communication with our former patent attorney, \* \* \* and/or as a result of an inadequate understanding on our part of the potential effect of recitations in the original patent claim language under United States laws; \* \* \* 4

U.S. patent No. Re. 29,296 issued on July 5, 1977, on the basis of the reissue application.

*The Reissue Claims*

Ball filed an administrative claim with the United States Navy on January 18, 1978, seeking damages and compensation for unauthorized use of, *inter alia*, the invention covered by claims 5, 6, and 7 of U.S. patent No. Re. 29,296. Claims 5, 6, and 7 of the reissue patent are set forth below:

*5. A dual slot antenna assembly comprising:*

*a pair of laterally spaced-apart conductive elements separated with respect to one another by a sheet of dielectric material,*

*one of said conductive elements being of larger dimensions and underlying the other element and defining an electrical reference or ground surface;*

*said conductive elements defining a pair of radiation slots between opposing edges of said other element and said reference surface, said radiation slots being longitudinally spaced-apart a predetermined distance approximately equal to one-half wavelength at the anticipated operating frequency of said assembly,*

*each of which radiation slots emanates radiation therefrom such that the radiation patterns developed are in substantially the same direction;*

*said radiation slots having a length dimension equal to the entire length of said opposing edges, which length dimension is greater than the spacing between said conductive elements; and*

*a single electrical signal feed assembly integrally connected with said other conductive element at only one of said opposing edges for electrically exciting both of said radiation slots from a single signal feed junction.*

**{729 F.2d 1434}** *6. An assembly according to claim 5 wherein said conductive elements and said sheet of dielectric material each comprise part of a single sheet of dielectric material metallicity cladded on opposite sides thereof.*

*7. An antenna structure comprising:*

*an electrically conducting ground surface,*

*a single layer electrically conducting surface comprising both an r.f. radiator conducting area and an r.f. feedline conducting area integrally connected thereto and formed therewith,*

*a dielectric sheet disposed between said ground surface and the single layer electrically conducting surface,*

*said conducting surfaces defining a pair of radiation slots between opposing edges of said r.f. radiator and said ground surface, said radiation slots being longitudinally spaced apart by a predetermined distance approximately equal to one-half wavelength at the anticipated operating frequency of said antenna structure;*

*each of which radiation slots emanates radiation therefrom such that radiation patterns developed are in substantially the same direction;*

*said radiation slots having a length dimension equal to the entire length of said opposing edges, which length dimension is greater than the spacing between said surfaces; and*

*said r.f. feedline being connected to the outside edge of one only of said opposing edges of said r.f. radiation conducting area to at least one predetermined point on the periphery of said radiator conducting area. [Emphasis in original.]*

On March 25, 1981, Ball filed a petition in the United States Court of Claims under 28 U.S.C. § 1498 (1976),<sup>5</sup> seeking reasonable and entire compensation for the "infringement" of claims 5, 6, and 7 of U.S. patent No. Re. 29,296. On June 29, 1981, prior to filing an answer, the Government moved for summary judgment. Ball filed a cross-motion for summary judgment.

Judge Colaianne denied both motions. As to the Government's motion, denial of which is on appeal here, the trial judge found that the undisputed evidence of record did not support the Government's arguments; as to Ball's cross-motion, the trial judge found that material issues of fact remained which compelled denial of the motion. Because we agree that neither the recapture rule nor the estoppel doctrine mandate grant of the Government's summary judgment motion, we affirm.

#### *Issues*

Two issues are raised in this appeal: (1) whether the error alleged by Ball is sufficient as a matter of law under 35 U.S.C. § 251 (1976) to support reissue; and (2) whether Ball is estopped from securing, through reissue, claims covering the single feedline feature.

The Government contends that Ball's deliberate cancellation of the single feedline claims was not error. That act was taken to avoid a prior art rejection and, in the Government's view, the recapture rule bars Ball from securing similar claims through reissue. The Government also contends {729 F.2d 1435} that the deliberate nature of Ball's acts estops Ball from securing similar claims through reissue. Ball did not appeal the denial of its summary judgment motion but, rather, defends the trial judge's opinion as correct as a matter of law. Resolution of this controversy involves a substantial body of precedent.<sup>6</sup> The parties differ in their interpretation of the law and in their application of it to the facts of this case.

#### *The Recapture Rule*

Reissue is not a substitute for Patent Office appeal procedures. Reissue is an extraordinary procedure and must be adequately supported by the circumstances detailed in 35 U.S.C. § 251 (1976)<sup>7</sup> and in the implementing regulations, 37 C.F.R. § 1.175 (1982). The Government asserts that the nature of error that will justify reissue is narrowly circumscribed to ensure that reissue remains the exception and not the rule. Relying on *Edward Miller & Co. v. Bridgeport Brass Co.*,<sup>8</sup> the Government contends that "a mere error of judgment" is not adequate to support reissue; rather the error must be "a real *bona fide* mistake, inadvertently committed."

The 1952 revision of the patent laws made no substantive change in the definition of error under section 251.<sup>9</sup> While deliberate cancellation of a claim cannot ordinarily be considered error,<sup>10</sup> the CCPA has repeatedly held that the deliberate cancellation of claims *may* constitute error, if it occurs without deceptive intent.<sup>11</sup> In *In re Petrow*,<sup>12</sup> the CCPA went so far as to state that error is sufficient where the deliberate cancellation of claims does not amount to an admission that the reissue claims were not patentable at the time the original claims were canceled. Similarly, in *In re Wesseler*,<sup>13</sup> the CCPA stated that error is established where there is no evidence that the appellant intentionally omitted or abandoned the claimed subject matter. {729 F.2d 1436} Thus, the CCPA has construed the term error under section 251 broadly.<sup>14</sup>

The Ninth Circuit employed a more rigid standard in *Riley v. Broadway-Hale Stores, Inc.*<sup>15</sup> stating: "when the chief element added by reissue has been abandoned while seeking the original patent, the reissue is void." The trial judge sought to determine whether Ball had made a deliberate judgment that claims of substantially the same scope as the new reissue claims would have been unpatentable. The Government, arguing from *Riley*, submits that the trial judge's approach loses sight of the feature given up by a patentee in order to secure the original patent. We decline to adopt the rigid standard applied in *Riley*, in favor of the more liberal approach taken by the CCPA. *Petrow* clearly establishes the vitality of the standard employed by the trial judge under this court's precedent.

Further, the Government argues that we need not reach the issue of claim scope because the sufficiency of error is a threshold issue. While claim scope is no oracle on intent, the Government fails to apprehend its role. Rarely is evidence of the patentee's intent in canceling a claim presented. Thus, the court may draw inferences from changes in claim scope when other reliable evidence of the

patentee's intent is not available. Claim scope is not the lodestar of reissue. Rather, the court's reliance on that indicator in the case law appears to be born of practical necessity as the only available reliable evidence.

The Government relies heavily on *Haliczer v. United States*,<sup>16</sup> which also involved a suit under 28 U.S.C. § 1498. The Court of Claims in that case held the reissue claims invalid because the patentee sought to acquire through reissue the *same* claims that had earlier been canceled from the original application. The recapture rule bars the patentee from acquiring, through reissue, claims that are of the *same* or of *broader scope* than those claims that were canceled from the original application.<sup>17</sup> On the other hand, the patentee is free to acquire, through reissue, claims that are *narrower* in scope than the canceled claims.<sup>18</sup> If the reissue claims are narrower than the canceled claims, yet broader than the original patent claims, reissue must be sought within 2 years after grant of the original patent.

Thus, the applicability of the recapture rule and the sufficiency of error under section 251 turn in this case, in the absence of other evidence of the patentee's intent, on the similarity between the reissue and the canceled claims. Narrower reissue claims are allowable; broader reissue claims or reissue claims of the same scope as the canceled claims are not.<sup>19</sup> The subject matter of the claims is not alone controlling.<sup>20</sup> Similarly, the focus is not, as the Government contends, on the specific limitations or on the elements of the claims but, rather, on the *scope* of the claims.<sup>21</sup>

**{729 F.2d 1437} Ball's Reissue Claims**

The trial judge required the Government to establish that the applicant has made a deliberate decision that the canceled claims are unpatentable. The Government argues that that standard is not correct because it loses sight of the *feature* that the patentee gave up during prosecution of the original application. We find the Government's argument entirely unpersuasive. The proper focus is on the *scope* of the claims, not on the individual *feature* or *element* purportedly given up during prosecution of the original application. The trial judge quite properly focused on the scope of the claims and we find no error in this respect. He determined that the reissue claims were intermediate in scope -- broader than the claims of the original patent yet narrower than the canceled claims.

The alleged inadequacy of Ball's proffered error is not as clear as the Government contends. The error supporting reissue submitted by Ball comports with the statute and regulations. Further, we fail to perceive the "inconsistency" of Ball's position as asserted by the Government.

The canceled claims, claims 7 and 8,<sup>22</sup> define the invention quite broadly. Canceled claim 8 requires feed means including at least one conductive lead. The reissue claims,<sup>23</sup> in contrast, include limitations not present in the canceled claims: the cavity is filled with a dielectric material; and an electrical signal feed assembly replaces the feed means of the canceled claims. The electrical signal feed assembly (Fig. 6) is a network of leads with a single coaxial feedline to that network. The network consists of a plurality of thin ribbon-like conductive leads.

[SEE ILLUSTRATION IN ORIGINAL]

Feed points [53] to the outer conductor are one wavelength apart at the anticipated operating frequency of the antenna. The leads of this network [52, 54, 56, 58] are dimensioned to provide continuous impedance matching between the cavity and the single coaxial feedline [70], which feeds into the assembly at the aperture [48]. The signal feed assembly is more limited than the "at least one" feed means limitation of canceled claim 8.

The reissue claims are, however, broader in one respect. The canceled claims are limited to an antenna of cylindrical configuration, whereas the reissue claims are not so limited. We are aware of the principle that a claim that is broader in any respect is considered to be broader than the original claims even though it may be narrower in other respects.<sup>24</sup> That rule will not bar Ball from securing the reissue claims here on appeal.

**{729 F.2d 1438}** Pursuant to section 251, broadened reissue must be sought within 2 years after issuance of the original patent. The CCPA, in *In re Rogoff*,<sup>25</sup> noted that section 251

contains no exceptions or qualifications as to time or extent of enlargement. The sole issue, therefore, is whether the claims on appeal enlarge, i.e., broaden, the patent claim.

It is well settled that a claim is broadened, so far as the question of right to reissue is concerned, if it is so changed as to bring within its scope any structure which was not within the scope of the original claim. In other words, a claim is broadened if it is broader in any respect than the original claim, even though it may be narrowed in other respects.\* \* \*

Thus, the principle that a claim is broadened if it is broader in any respect than the original claim serves to effect the bar of section 251 against reissue filed later than 2 years after issuance of the original patent. In this case, Ball filed its application for reissue within the 2-year period for broadened reissue specified in section 251.

We know of no authority applying the above rule to reissue claims relative to the scope of canceled claims within the 2-year period for broadened reissue. Nor do we perceive the wisdom of such extension in this case. The rule is rigid and properly so in that it effects an express statutory limitation on broadened reissue. The recapture rule, however, is based on equitable principles. The rigidity of the broader-in-any-respect rule makes it inappropriate in the estoppel situation presented in this appeal.

Hence, we decline to apply that rule here, where the broader feature relates to an aspect of the invention that is not material to the alleged error supporting reissue. In *Willingham*, the CCPA reversed the rejection of a claim that was narrower than the canceled claim as to one element, although broader as to another element. "The extent to which [deliberate cancellation of a claim from the original application] may also prevent [a patentee] from obtaining other claims differing in form or substance from that cancelled necessarily depends upon the facts in each case and particularly on the reasons for the cancellation."<sup>26</sup> Accordingly, we hold that the reissue claims are not substantially identical in scope to the canceled claims.

As noted *supra*, there is widespread agreement that reissue claims that are narrower than the canceled claims are allowable. In *In re Wadlinger*,<sup>27</sup> the CCPA faced a situation in which the reissue claims were, as the trial judge found here, of "different" scope from the canceled claims. While both the reissue and canceled claims were directed to the same process in *Wadlinger*, the canceled claims were considered broader, resulting in claims of different scope. The reissue claims were held valid. Similarly, we find that the non-material, broader aspects of Ball's reissue claims do not deprive them of their fundamental narrowness of scope relative to the canceled claims. Thus, the reissue claims are sufficiently narrower than the canceled claims to avoid the effect of the recapture rule.

#### *Estoppel*

The Government also argues that Ball is estopped to secure the reissue claims. We do not consider this argument as stating an independent ground for relief. {729 F.2d 1439} The recapture rule is a creature of equity and it embodies the estoppel notions which the Government now urges upon us.<sup>28</sup> We have already resolved this issue against the Government.

We agree with the patentee that the Government's "file wrapper estoppel" argument is equally unavailing. The doctrine of estoppel based on the prosecution history is a corollary to the doctrine of equivalents, a tool in the analysis of infringement. The parties are before this court purely on a controlling issue of law relative to the validity of the reissue claims being asserted by Ball. There has not yet been a full trial on the issue of infringement, let alone on the validity of the reissue claims.<sup>29</sup> The Government's estoppel argument does no more than restate the basic equitable principles underlying the recapture rule.

#### *Conclusion*

The trial judge properly articulated the law governing reissue. While broader in scope than the original claims, the reissue claims are narrower in scope than the canceled claims. The error supporting reissue appears to be sufficient. On the basis of the facts before us and the reasons given for the cancellation of the claims from the original application, we cannot find, as a matter of law, that Ball is barred from securing reissue claims drawn to the single feedline embodiment of its invention. The case is remanded to the Claims Court for further proceedings consistent with this opinion.

**AFFIRMED AND REMANDED.**

## Footnotes

### Footnotes for Opinion

1 On October 8, 1982, pursuant to this court's order of October 4, 1982, Judge Colaanni of the U.S. Claims Court entered a judgment denying both parties' motions for summary judgment, corresponding to his earlier report in the case, filed by him as a trial judge of the U.S. Court of Claims on August 23, 1982.

2 Previous missile antennas exhibited signal nulls that made monitoring difficult from a ground tracking station as the missile rolled or changed direction in flight. The claimed antenna exhibits a substantially isotropic radiation pattern which overcomes this problem by eliminating signal nulls.

3 See *Haliczer v. United States*, 174 Ct. Cl. 507, 356 F.2d 541, 544-45, 148 USPQ 565, 568-69 (Ct. Cl. 1966) (range of equivalents of original patent claims would not include canceled feature).

4 See United States Patent and Trademark Office, *Manual of Patent Examining Procedure* § 1401.08 (1974) (error arising from a lack of understanding or of knowledge by applicant's attorney as to the real invention may be acceptable).

5 28 U.S.C. § 1498 (1976), as amended by The Federal Courts Improvement Act of 1982, Pub. L. No. 97-164, 1982 U.S. CODE CONG. & AD. NEWS (96 Stat.) 25, provides, in pertinent part:

"§ 1498. Patent and copyright cases

"(a) Whenever an invention described in and covered by a patent of the United States is used or manufactured by or for the United States without license of the owner thereof or lawful right to use or manufacture the same, the owner's remedy shall be by action against the United States in the United States Claims Court for the recovery of his reasonable and entire compensation for such use and manufacture.

"For the purposes of this section, the use or manufacture of an invention described in and covered by a patent of the United States by a contractor, a subcontractor, or any person, firm, or corporation for the Government and with the authorization or consent of the Government, shall be construed as use or manufacture for the United States."

6 The holdings of the U.S. Court of Claims and of the U.S. Court of Customs and Patent Appeals were adopted as precedent in this court in *South Corp. v. United States*, 690 F.2d 1368, 1370, 215 USPQ 657, 658 (Fed. Cir. 1982). Both prior courts have ruled on the issues involved in this case. Additionally, several circuit courts have also considered the application of the recapture rule.

7 Section 251 provides in pertinent part:

"§ 251. Reissue of defective patents

"Whenever any patent is, *through error without any deceptive intention*, deemed wholly or partly inoperative or invalid, \* \* \* by reason of the patentee claiming more or less than he had a right to claim in the patent, the Commissioner shall, on the surrender of such patent and the payment of the fee required by law reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. \* \* \*

\* \* \*

"No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent." (Emphasis supplied.)

8 *Edward Miller & Co. v. Bridgeport Brass Co.*, 104 U.S. 350, 355, 26 L. Ed. 783 (1882).

9 *In re Wadlinger*, 496 F.2d 1200, 1206-07, 181 USPQ 826, 831-32 (CCPA 1974); *In re Wesseler*, 54 C.C.P.A. 735, 367 F.2d 838, 849, 151 USPQ 339, 347 (CCPA 1966); *In re Byers*, 43 C.C.P.A. 803, 230 F.2d 451, 454, 109 USPQ 53, 55 (CCPA 1956); *Riley v. Broadway-Hale Stores, Inc.*, 217 F.2d 530, 531 n.1, 103 USPQ 414, 415 n.1 (9th Cir. 1954). But see *In re Willingham*, 48 C.C.P.A. 727, 282 F.2d 353, 355, 127 USPQ 211, 214 (CCPA 1960). "Error" is interpreted in the same manner as under section 64 of the old law, *i.e.*, accident, inadvertence, or mistake.

10 *In re Petrow*, 56 C.C.P.A. 710, 402 F.2d 485, 487, 159 USPQ 449, 450 (CCPA 1968); *Willingham*, 282 F.2d at 357, 127 USPQ at 215.

11 See *Wadlinger*, 496 F.2d at 1206, 181 USPQ at 831; *Petrow*, 402 F.2d at 487, 159 USPQ at 450; *Wesseler*, 367 F.2d at 849, 151 USPQ at 348; *Willingham*, 282 F.2d at 357, 127 USPQ at 215. See also *Tee-Pak, Inc. v. St. Regis Paper Co.*, 491 F.2d 1193, 1201, 181 USPQ 75, 81 (6th Cir. 1974); *Manual of Patent Examining Procedure* § 1401.08.

12 *Petrow*, 402 F.2d at 488, 159 USPQ at 451. See also *Wesseler*, 367 F.2d at 846, 151 USPQ at 344-46; *Willingham*, 282 F.2d at 357, 127 USPQ at 215-16; *Tee-Pak*, 491 F.2d at 1201, 181 USPQ at 81.

13 *Wesseler*, 367 F.2d at 850, 151 USPQ at 349. See also *Riley*, 217 F.2d at 532, 103 USPQ at 415.

14 *Wadlinger*, 496 F.2d at 1207-08, 181 USPQ at 832; *In re Richman*, 56 C.C.P.A. 1083, 409 F.2d 269, 273-75, 161 USPQ 359, 362-63 (CCPA 1969); *Wesseler*, 367 F.2d at 849, 151 USPQ at 347-48; *Willingham*, 282 F.2d at 355-56, 127 USPQ at 214. But see *In re Wadsworth*, 27 C.C.P.A. 735, 107 F.2d 596, 43 USPQ 460 (CCPA 1939).

15 *Riley*, 217 F.2d at 532, 103 USPQ at 415.

16 *Haliczer*, 174 Ct. Cl. 507, 356 F.2d 541, 148 USPQ 565.

17 *Id.* at 545, 148 USPQ at 569 (bars reissue claims of same scope); *Byers*, 230 F.2d at 455-57, 109 USPQ at 56-57 (bars reissue claims that are of broader scope than canceled claims); *Wadsworth*, 107 F.2d at 599, 43 USPQ at 463 (bars reissue claims of similar scope).

18 *Wadlinger*, 496 F.2d at 1204, 181 USPQ at 830; *Petrow*, 402 F.2d at 488, 159 USPQ at 451; *Wesseler*, 367 F.2d at 846-47, 151 USPQ at 346; *Willingham*, 282 F.2d at 356, 127 USPQ at 215.

19 If reissue is sought where claims have not been previously canceled, analysis becomes more difficult. In that case relative claim scope is not available to illuminate the alleged error. We are not faced with that situation in this proceeding.

20 *Petrow*, 402 F.2d at 488, 159 USPQ at 451.

21 *Richman*, 409 F.2d at 274-75, 161 USPQ at 362-63. See also *Wadsworth*, 27 C.C.P.A. 735, 107 F.2d 596, 43 USPQ 460 (analysis turns on substantiality of similarity of reissue to canceled claims).

22 See *supra* "The Canceled Claims."

23 See *supra* "The Reissue Claims."

24 *In re Self*, 671 F.2d 1344, 1346, 213 USPQ 1, 3 (CCPA 1982) (reissue application filed 7 years after issuance of original patent); *In re Chromy*, 50 C.C.P.A. 1330, 318 F.2d 937, 939, 137 USPQ 884, 885 (CCPA 1963) (4 years after issue); *In re Price*, 49 C.C.P.A. 1070, 302 F.2d 741, 741-42, 133 USPQ 527, 528 (CCPA 1962) (3 years after issue); *In re Ruth*, 47 C.C.P.A. 1014, 278 F.2d 729, 730, 126 USPQ 155, 156 (CCPA 1960) (4 years after issue).

25 *In re Rogoff*, 46 C.C.P.A. 733, 261 F.2d 601, 603-04, 120 USPQ 185, 186 (CCPA 1958).

26 *Willingham*, 282 F.2d at 357, 127 USPQ at 215.

27 *Wadlinger*, 496 F.2d at 1205-06, 181 USPQ at 830-31.

28 Reissue is remedial in nature and is based on fundamental principles of equity and fairness. The recapture rule is inherently founded on similar considerations of equity, providing guidance in the application of the law governing reissue. See *Wesseler*, 367 F.2d at 848, 151 USPQ at 347; *Willingham*, 282 F.2d at 354-55, 127 USPQ at 214.

29 The Government apparently misconstrues *Haliczer* in this respect. In *Haliczer*, the court determined that the doctrine of equivalents would require that the *original* claims, carried over into the reissue patent, would not be entitled to the range of equivalents that were purposely surrendered during prosecution of the *original* patent. This is based on an estoppel notion born of the inconsistency of arguing that the *original* claims cover that which was given up during the prosecution of the original patent. The *reissue* claims, not the original claims, are in issue here and the Government's reasoning is, therefore, inapposite. There is no inconsistency in arguing the broadened scope of the reissue claims and, thus, no estoppel.

**HESTER INDUSTRIES, INC., Plaintiff-Appellant, v. STEIN, INC., Defendant-Cross Appellant.**  
142 F.3d 1472; 1998 U.S. App. LEXIS 9288; 46 U.S.P.Q.2D (BNA) 1641

97-1352, 97-1353

May 7, 1998, Decided

**UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT**

Before PLAGER and SCHALL, Circuit Judges.<sup>11</sup> A member of the panel that heard argument in this case was unable to continue with consideration of the case because of recusal. Pursuant to Rule 47.11 of this court, the matter was decided by the remaining members of the panel.

**Disposition**

**AFFIRMED.**

**Counsel**

Robert W. Adams, Nixon & Vanderhye, P.C., of Arlington, Virginia, argued for plaintiff-appellant. With him on the brief were Robert A. Vanderhye, James T. Hosmer, Robert W. Faris, and William J. Griffin.

Charles H. De La Garza, Arnold, White & Durkee, of Minneapolis, Minnesota, argued for defendant-cross appellant. With him on the brief were L. Gene Spears, Attorney of Record, and James C. Pistorino, of Houston, Texas.

**Opinion**

**Editorial Information: Prior History**

Appealed from: United States District Court for the Eastern District of Virginia. Judge Ellis.

**Editorial Information: Subsequent History**

Certiorari Denied October 19, 1998, Reported at: 1998 U.S. LEXIS 6705.

**Opinion by:** PLAGER

**{142 F.3d 1474}** PLAGER, *Circuit Judge*.

Hester Industries, Inc. ("Hester") appeals from a summary judgment of invalidity entered by the United States District Court for the Eastern District of Virginia. The district court ruled that the reissue patent claims asserted by Hester against Stein, Inc. ("Stein") are invalid for failing to meet the statutory "error" and "original patent" requirements for reissue patents set forth in 35 U.S.C. § 251 P 1 (1994). *Hester Indus., Inc. v. Stein, Inc.*, 963 F. Supp. 1403 (E.D. Va. 1997). Stein cross-appeals a pretrial oral ruling in which the district court adopted Hester's proposed construction of the claim term "high humidity steam."

Because the asserted reissue claims impermissibly recapture subject matter surrendered by Hester through deliberate arguments repeatedly made to the Patent Office to overcome prior art, we hold that Hester is barred from asserting "error" within the meaning of 35 U.S.C. § 251 P 1. We accordingly affirm the summary judgment of invalidity. Because the asserted claims are invalid, we need not and do not reach the claim construction issue.

**BACKGROUND**

At issue in this case are two reissue patents, U.S. Patent No. Re. 33,510 (the " '510 reissue patent") and U.S. Patent No. Re. 35,259 (the " '259 reissue patent"). The two patents are reissues of the same original patent, U.S. Patent No. 4,582,047 (the " '047 patent" or "original patent"), which they replaced pursuant to 35 U.S.C. § 251.<sup>2</sup> The patents are directed to a high humidity steam cooker having a continuously running conveyor for cooking food items such as poultry and other meat products. Hester, a processor of pre-cooked poultry and other meat products, owns the patents, and Charles E. Williams ("Williams"), a Hester employee, is the sole named inventor. After the '259 reissue patent (the second reissue) issued in 1996, Hester sued Stein, a manufacturer of industrial appliances, for allegedly infringing several reissue claims in the two reissue patents.

The two reissue patents and the original patent have the same written description; the patents differ

only with respect to their claims. That written description describes an industrial-size steam cooker for cooking large quantities of food products. The cooker is described as having a cooker chamber in which a steam atmosphere is maintained. The food products are carried through the cooker chamber on a conveyor belt that runs through a spiral path. The written description teaches that efficient cooking is achieved without the loss of humidity, flavor, or appearance by maintaining a water-drop-free steam atmosphere within the chamber at near 100 degrees C and 100% humidity, at above atmospheric pressure.

Two separate sources of steam, one internal and one external, are described for maintaining the steam atmosphere. The internal source of steam described is a pool of water on the floor of the cooker chamber, heated by a heating element in the pool. The external source described is a steam generator, located outside the cooker chamber and connected by pipes to various locations within the cooker chamber to inject steam at those locations. The written description states that the external steam source typically provides 25% of {142 F.3d 1475} the steam, with the remainder provided by the internal source. '047 patent, col. 3, ll. 42-45, 57-59. The heating element in the internal steam source is controlled to maintain the desired amount of steam and pressure within the cooker chamber. *Id.* col. 3, ll. 59-63.

The section of the written description entitled DETAILED DESCRIPTION OF THE PREFERRED EMBODIMENT describes the cooking atmosphere thus:

The cooking is solely with water droplet free steam near 100 degrees C. and 100% humidity at a pressure above atmospheric. The high humidity atmosphere prevents losses of humidity of the product as it passes through the cooker and helps retain juices, essences and flavor of the product. Also it improves the heating steam interface heat exchange at the product surface for more efficient cooking.

The higher pressure not only produces a pressure-cooker like cooking efficiency to the cooking process, but is critical in connection with the flavor and conveyor type product flow as well.

*Id.* col. 3, ll. 22-33.

The original patent contains one independent claim, claim 1, directed to a food cooking system. The claim specifies that the cooking system cooks solely with steam and that the system includes two sources of steam to provide the steam atmosphere. Characteristics of the steam atmosphere are set forth, and the cooking system is said to include a means passing a conveyor belt through the cooker housing. Claim 1, with relevant text emphasized, reads:

A food cooking system *cooking solely with steam* foods such as fish, fowl, meats or produce carried through a cooker on a continuously running conveyor belt, comprising in combination, a cooker housing, *means passing said conveyor belt through said housing* to expose food products within the cooker housing only to *said steam as the sole cooking medium*, and *two sources of steam providing said steam* to cook the food products, nozzles for releasing steam located inside said housing, one comprising a steam generator supplying supplemental steam into said housing at said nozzles located there inside *to maintain the atmosphere together with the other steam source at near 100% humidity 100 degrees C. and a pressure above atmospheric*, and the other source of steam comprising a pool of water within said housing with heating means for boiling the water to create steam.

*Id.* col. 5, l. 59 to col. 6, l. 8. For purposes here, this is substantially the same form in which the claim was first filed (as application claim 1) in the application for the original patent. Accordingly, we do not distinguish between the issued claim and the application claim, but instead simply refer to claim 1.

In addition to the independent claim, the original patent contains several claims which are dependent upon claim 1. Relevant here is dependent claim 12, which specifies in pertinent part: "A system as defined in claim 1 *wherein the conveyor belt is passed inside said housing in a spiral path* coiling downwardly . . . ." *Id.* col. 6, ll. 59-61 (emphasis added). This claim stemmed from original application claim 16, which specified that the conveyor belt is "passed . . . in a spiral path."

The application for the '047 patent (the original patent) was filed in 1979. The patent did not issue until 1986, nearly seven years later. Over the almost seven years in which the application was prosecuted before the United States Patent and Trademark Office ("Patent Office"), inventor Williams, through his attorney, repeatedly emphasized the "solely with steam" and "two sources of steam" features of the claimed invention in attempting to establish patentability over the prior art. For example, after the



Examiner first rejected claim 1 as well as all the other claims as obvious, Office Action of Feb. 6, 1980, at 2, Williams distinguished a cited prior art cooker that cooked with a combination of infra-red dry heat and steam on the ground that the claimed invention cooked solely with steam, stating: "This principle is completely different from applicant's invention where the claims define cooking *solely* with steam." Applicant Response of Apr. 28, 1980 (emphasis in original). Williams also distinguished claim 1 on the basis of the "two sources of steam" limitation, the specified characteristics of the steam atmosphere, and {142 F.3d 1476} the recited continuously running conveyor belt. *Id.*

Application claim 16, which specified a spiral conveyance path, was rejected as obvious in view of an additional prior art cooker that included a spiral conveyor. Office Action of Feb. 6, 1980, at 4. In response, Williams amended claim 16 to specify further details of the spiral conveyance path and then argued that the claimed spiral conveyance path was distinguished from that shown in the prior art. Applicant Response of Apr. 28, 1980.

However, the Examiner continued to reject all claims as obvious. Office Action of July 9, 1980. At that point, Williams placed even greater reliance on the "solely with steam" and "two sources of steam" limitations in an attempt to overcome the obviousness rejection. For example, in his first appeal of the obviousness rejection to the Board of Patent Appeals and Interferences ("Board"), Williams stated, "The claimed system cooks solely with steam . . . by means of two separate and critical steam sources . . . ." Applicant Brief on Appeal, at 2 (Aug. 20, 1980) (emphasis in original). Later in the same brief, Williams specifically distinguished the cited prior art on the basis of these limitations:

The primary reference Vischer cooks with IR radiation not steam. Clearly the claimed feature of cooking *solely* with steam is directly contrary to the teaching of the Vischer patent, which could therefore never make obvious any process or equipment cooking *solely* with steam as claimed.

....

The Examiner errs in any implication that Jourdan shows two sources of steam.

*Id.* at 9-10 (emphasis in original).

Prior to the Board hearing Williams' appeal, the Examiner reopened prosecution on the merits in view of newly discovered prior art, thereby removing the appeal from the Board.<sup>3</sup> Office Action of Mar. 17, 1981. The Examiner then rejected all of the claims as obvious over the new prior art. *Id.* In response, Williams distinguished claim 1 over that prior art on the same bases, *i.e.*, the "solely with steam" and "two sources of steam" limitations. Applicant Response to Office Action (Apr. 17, 1981). However, the Examiner was not persuaded, even after these same arguments were repeated in subsequent papers submitted to the Patent Office.

Accordingly, Williams initiated a second appeal to the Board. He again emphasized the "solely with steam" and "two sources of steam" limitations. Applicant Brief on Appeal, at 13 (Dec. 22, 1981). He explained that the two sources of steam interact to provide a "synergy" that is "novel and nowhere suggested in any of the cited [prior] art." *Id.* Williams drove home his reliance on the "solely with steam" limitation most forcefully in his reply brief to the Board: "Clearly the Examiner reversibly errs as a matter of fact and in his efforts to make a case out against the *very material claimed feature that steam is the sole cooking medium (claim 1)*. Thus reversal is respectfully solicited." Applicant Reply Brief on Appeal, at 6 (Sep. 30, 1982) (emphasis in original).

The Board was persuaded and accordingly reversed the obviousness rejection in its opinion dated June 21, 1985, stating:

We find no suggestion in the combined teachings of the references which would have led the ordinarily skilled worker in the art to an apparatus utilizing steam as the sole cooking medium; utilizing two separate sources of steam, one of which includes a pool of water in the cooking chamber with means for boiling the water; and wherein the atmosphere within the cooking chamber is maintained above atmospheric by the two sources of steam.

Thereafter the claims were allowed and the application issued as the '047 patent on April 15, 1986.

On the two-year anniversary of the '047 patent's issuance, Williams applied for a reissue pursuant to 35 U.S.C. § 251, alleging that the patent claims had been drawn too narrowly due to attorney error. In the required oath accompanying the reissue application, Williams explained that he became {142 F.3d 1477} aware of this alleged error after learning that Stein was in the process of developing a

competing cooker in early 1988. According to his oath, Williams and his employer Hester concluded that the '047 patent should cover the Stein cooker, notwithstanding the fact that the cooker used a non-steam heat source and only one source of steam in the cooking process. Williams further explained that Hester's present counsel advised Hester that the '047 patent claims, as written, might not cover Stein's cooker. Thus, Williams, by oath, declared that the patent was insufficient because it claimed less than he had a right to claim.

Specifically, Williams identified two relevant deficiencies of the '047 patent, as follows (indentation and numbering added):<sup>4</sup>

- [1] that each of claims 1-14 therein requires cooking "solely with steam" and exposing food products within the cooker housing "only to said steam as the sole cooking medium" . . . [and]
- [2] that each of claims 1-14 therein requires "two sources of steam providing said steam to cook the food products, nozzles for releasing steam located inside said housing" [.]

These deficiencies, according to Williams, "arose after [he] executed and filed the original application from which the '047 patent issued" and were caused by "the failure of [his prior] patent attorney . . . to appreciate the full scope of [his] invention."

This application ripened into the '510 reissue patent nearly three years later on January 1, 1991. However, prior to its issuance, Williams filed a second reissue application, for reasons not relevant here, on June 21, 1990, alleging the same errors used to support the first reissue. Six years later, this second reissue application issued as the '259 reissue patent. Hester then filed this action, accusing Stein of infringing two claims in the first reissue patent and six claims in the second. Specifically, Hester accused Stein of infringing reissue claims 26 and 59 of the '510 reissue patent and reissue claims 28, 30, 31, 32, 75, and 76 of the '259 reissue patent.

The requirement in original claim 1 that cooking is "solely with steam" is absent from each of the asserted reissue claims. Also absent is the "two sources of steam" limitation. Rather, the asserted reissue claims merely recite a source of steam or at least one source of steam. None of the asserted reissue claims explicitly recite the steam atmosphere characteristics specified in original claim 1, *i.e.*, the characteristics of near 100 degrees C and 100% humidity at above atmospheric pressure.

Instead, all but one of the asserted reissue claims recite "high humidity steam."<sup>5</sup>

Claim 26 of the '510 reissue patent is representative of the two asserted reissue claims in that patent. It provides in pertinent part:

A food cooking system for cooking food products carried on a moving conveyor belt, comprising:  
a cooker housing[.]

*means disposed within said housing for defining a conveyance path,*

a conveyor belt disposed along said conveyance path for supporting and conveying said food products along said path,

means coupled to said belt for causing said belt and said food products supported thereby to substantially continually translate along said conveyance path . . . , and

*a source of steam providing steam to contact and cook the food products, said steam source comprising at least one of the following:*

an external steam generator supplying steam into said housing, and a pool of water within said housing with heating means communicating with said pool of water for creating steam. . . [.]

**{142 F.3d 1478}** *wherein said steam source provides high humidity steam and said food products are directly exposed to said high humidity steam.*

'510 patent, col. 8, ll. 8-31, 36-38 (emphasis added, and text of claim 24, upon which claim 26 depends, incorporated).

The asserted reissue claims of the '259 reissue patent are, for purposes here, substantially similar. One difference is that several of these claims explicitly recite a "spiral conveyance path." Claim 28, which is representative, provides in pertinent part:

A spiral steam cooker for at least partially cooking exposed food products, said cooker comprising:

a housing defining an internal volume therein;

a conveyor belt at least partially *disposed along a spiral conveyance path* within said internal volume . . . ; and

*a steam source* operatively coupled to said housing, said steam source *providing a high humidity steam atmosphere* within said internal volume, said high humidity steam atmosphere directly contacting and at least partially cooking the exposed food products . . . .

'259 patent, col. 9, l. 61 to col. 10, l. 12 (emphasis added).

Before the district court, Stein moved for summary judgment that the asserted reissue claims are invalid for failing to meet the requirements of the reissue statute, 35 U.S.C. § 251. That section (with emphasis added) reads:

Whenever any patent is, through *error* without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or *by reason of the patentee claiming more or less than he had a right to claim in the patent*, the Commissioner shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent *for the invention disclosed in the original patent*, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.

In particular, Stein argued that the "error" requirement of § 251 P 1, as well as the requirement therein that the reissue claims be "for the invention disclosed in the original patent" (the "original patent" requirement), were not met. With regard to the "error" requirement, Stein argued that Williams had not erred in including the "solely with steam" and "two sources of steam" limitations in the original claims, and further argued that the removal of those limitations violated the "recapture" rule. Stein further argued that the asserted reissue claims violated the "original patent" requirement because, Stein asserted, the original patent does not evidence an "objective" intent to claim the invention in the manner of the asserted reissue claims.

The district court granted Stein's motion. The court first concluded that there was no "error" as contemplated by § 251 P 1. Specifically, the court concluded that the alleged failure of counsel to appreciate the scope of the invention was belied by the clear language in the original patent claims, the prosecution history of the patent, and the absence of any explanation as to the nature or cause of the attorney's failure to appreciate the full scope of the invention. *Hester*, 963 F. Supp. at 1408. The court did not reach Stein's assertion that the asserted reissue claims violate the recapture rule, though the court relied heavily on the original patent's prosecution history in determining that the "error" requirement was not met. *See id.* at 1409-11.

The district court ruled that the asserted reissue claims are alternatively invalid for failing to meet the "original patent" requirement. *Id.* at 1412. The district court concluded that the "original patent" clause of § 251 P 1 includes a separate requirement that the original patent manifest an "objective" intent to claim the invention as later claimed on reissue. *Id.* at 1412-13. The court concluded that the original patent does not manifest such an objective intent, and thus the claims are also invalid under the "original patent" clause of § 251 P 1. *Id.* at 1412-15.

In its appeal of the invalidity judgment, *Hester* argues that the district court erred in concluding that the "error" and "original patent" requirements of § 251 P 1 were not met. {142 F.3d 1479} Stein, in seeking to uphold the judgment, makes the same arguments presented to the district court in its motion for summary judgment. *Hester*, on the other hand, argues that the "error" requirement was met by way of prior patent counsel's failure to appreciate the full scope of the invention. *Hester* further asserts that the recapture rule is inapplicable because the reissue claims were never presented during prosecution of the original patent and later abandoned by amendment or cancellation. With regard to the "original patent" clause of § 251 P 1, *Hester* submits that there is no separate requirement of a manifestation of an objective intent to claim.

Also at issue on appeal is the district court's resolution of a "Motion For Claim Interpretation" brought by Stein. In that motion, Stein argued that the claim term "high humidity steam" should be construed in accordance with the only specific description of the steam atmosphere provided in the patents, *i.e.*,

as water-droplet-free steam near 100 degrees C and 100% humidity at above atmospheric pressure. Hester, relying on the opinion of its expert, proposed a broader construction, arguing that the description contained in the patents is merely one example of "high humidity steam." The district court, in a ruling delivered from the bench prior to holding the asserted reissue claims invalid, adopted Hester's proposed construction of the claim term. The ruling was never reduced to a formal order or judgment. The parties, by way of cross-appeal by Stein, present the same issue on appeal.

## DISCUSSION

I

In reviewing the summary judgment of invalidity, we keep in mind that summary judgment is appropriate only when the record shows that "there is no genuine issue as to any material fact and that the moving party is entitled to judgment as a matter of law." Fed. R. Civ. P. 56(c). Whether the statutory requirements of 35 U.S.C. § 251 have been met is a question of law. See *In re Clement*, 131 F.3d 1464, 1468, 45 U.S.P.Q.2D (BNA) 1161, 1163 (Fed. Cir. 1997). This legal conclusion can involve underlying factual questions. See *id.*

II

As previously explained, the "error" and "original patent" requirements at issue here are found in the first paragraph of § 251. The "error" requirement limits the availability of a reissue patent to certain correctable errors. See *In re Amos*, 953 F.2d 613, 616, 21 U.S.P.Q.2D (BNA) 1271, 1273 (Fed. Cir. 1991). As seen in the above-emphasized text of § 251, one such correctable error is the patentee claiming his invention too broadly or too narrowly.<sup>6</sup> See *id.*

The "original patent" requirement is a second and independent requirement, see *Amos*, 953 F.2d at 615, 21 U.S.P.Q.2D (BNA) at 1272, which restricts a reissue patent to "the invention disclosed in the original patent." 35 U.S.C. § 251 P 1. We address each of these requirements in turn.

A

1

In considering the "error" requirement, we keep in mind that the reissue statute is "based on fundamental principles of equity and fairness, and should be construed liberally." *In re Weiler*, 790 F.2d 1576, 1579, 229 U.S.P.Q. (BNA) 673, 675 (Fed. Cir. 1986). We also keep in mind that "not every event or circumstance that might be labeled 'error' is correctable by reissue." *Id.* Indeed, the reissue procedure does not give the patentee the right "to prosecute *de novo* his original application." *Id.* at 1582, 229 U.S.P.Q. (BNA) at 677; see also *Mentor Corp. v. Coloplast, Inc.*, 998 F.2d 992, 995, 27 U.S.P.Q.2D (BNA) 1521, 1524 (Fed. Cir. 1993).

One of the most commonly asserted "errors" in support of a broadening reissue is the failure of the patentee's attorney to appreciate the full scope of the invention during the prosecution of the original patent application. See *Amos*, 953 F.2d at 616, 21 U.S.P.Q.2D (BNA) {142 F.3d 1480} at 1273; *In re Wilder*, 736 F.2d 1516, 1519, 222 U.S.P.Q. (BNA) 369, 371 (Fed. Cir. 1984). This form of error has generally been accepted as sufficient to satisfy the "error" requirement of § 251. See *Clement*, 131 F.3d at 1468, 45 U.S.P.Q.2D (BNA) at 1163; *Wilder*, 736 F.2d at 1519, 222 U.S.P.Q. (BNA) at 371. Williams asserted this form of error as the basis for his reissue applications, and the Patent Office accepted his assertion as adequate.

However, the district court concluded that there was no such error by Williams' attorney. *Hester*, 963 F. Supp. at 1411. In reaching this conclusion, the court was particularly persuaded by the prosecution history of the original patent. The court concluded that the attorney's repeated attempts to distinguish Williams' invention on the basis of the "solely with steam" and "two sources of steam" limitations belied Williams' assertion that his attorney failed to appreciate the full scope of his invention. *Id.* at 1409-11. The court also determined that there was no other form of § 251 "error" and thus held the asserted reissue claims invalid. *Id.* at 1411-12.

2

We share the district court's discomfort with Williams' attempt to remove, through reissue, the "solely with steam" and "two sources of steam" limitations after having relied so heavily on those limitations to obtain allowance of the original patent claims over the prior art. This concern is addressed most squarely by the "recapture rule," recently discussed at length in *Clement*, 131 F.3d 1464, 45 U.S.P.Q.2D (BNA) 1161. The recapture rule "prevents a patentee from regaining through reissue . . .

subject matter that he surrendered in an effort to obtain allowance of the original claims." *Clement*, 131 F.3d at 1468, 45 U.S.P.Q.2D (BNA) at 1164. The rule is rooted in the "error" requirement in that such a surrender is not the type of correctable "error" contemplated by the reissue statute. See *Mentor*, 998 F.2d at 995-96, 27 U.S.P.Q.2D (BNA) at 1525.

In its motion for summary judgment, Stein presented the recapture rule as one basis for finding the asserted reissue claims invalid, and Stein repeats this argument on appeal as one basis for affirming the summary judgment of invalidity. While the district court did not explicitly rule on this ground, its opinion indicates the view that Hester, through the reissue patents, recaptured surrendered subject matter. *Hester*, 963 F. Supp. at 1412 (stating that through the reissues, Hester obtained claims covering "ovens with characteristics repeatedly distinguished and disclaimed in the PTO" and that that was contrary to the "error" requirement of § 251). As will be next explained, we conclude that the asserted reissue claims violate the recapture rule and that the summary judgment ruling is appropriately affirmed on this ground.

"Under [the recapture] rule, claims that are 'broader than the original patent claims in a manner directly pertinent to the subject matter surrendered during prosecution' are impermissible." *Clement*, 131 F.3d at 1468, 45 U.S.P.Q.2D (BNA) at 1164 (quoting *Mentor*, 998 F.2d at 996, 27 U.S.P.Q.2D (BNA) at 1525). Application of the recapture rule begins with a determination of whether and in what respect the reissue claims are broader than the original patent claims. See *id.* A reissue claim that does not include a limitation present in the original patent claims is broader in that respect. See *id.* Here, it is undisputed that the asserted reissue claims are broader than the original patent claims in that the reissue claims do not include the "solely with steam" and "two sources of steam" limitations found in each of the original patent claims.

Having determined that the reissue claims are broader in these respects, under the recapture rule we next examine whether these broader aspects relate to surrendered subject matter. See 131 F.3d at 1468-69, 45 U.S.P.Q.2D (BNA) at 1164. "To determine whether an applicant surrendered particular subject matter, we look to the prosecution history for *arguments* and changes to the claims made in an effort to overcome a prior art rejection." *Id.* at 1469, 45 U.S.P.Q.2D (BNA) at 1164 (emphasis added). This statement in *Clement* indicates that a surrender can occur by way of arguments or claim changes made during the prosecution of the {142 F.3d 1481} original patent application. To date, the cases in which this court has found an impermissible recapture have involved claim amendments or cancellations. See, e.g., *id.* at 1469-70, 45 U.S.P.Q.2D (BNA) at 1164-65; *Mentor*, 998 F.2d at 995-96, 27 U.S.P.Q.2D (BNA) at 1524-25. However, in addition to the suggestion in *Clement* that argument alone can effect a surrender, this court expressly left open that possibility in *Ball Corp. v. United States*: "If reissue is sought where claims have not been previously canceled, analysis becomes more difficult. In that case relative claim scope is not available to illuminate the alleged error. We are not faced with that situation in this proceeding." 729 F.2d 1429, 1436 n.19, 221 U.S.P.Q. (BNA) 289, 295 n.19 (Fed. Cir. 1984). Prior to this case, this court has not squarely addressed the question.

This court's prior opinions indicate that, as a general proposition, in determining whether there is a surrender, the prosecution history of the original patent should be examined for evidence of an admission by the patent applicant regarding patentability. See *Clement*, 131 F.3d at 1468, 45 U.S.P.Q.2D (BNA) at 1164 (noting that, with regard to claim amendments, the recapture rule does not apply in the absence of evidence that the amendment was an admission that the scope of the claim was not patentable); *Mentor*, 998 F.2d at 995, 27 U.S.P.Q.2D (BNA) at 1524 (same); *Seattle Box Co. v. Industrial Crating & Packing, Inc.*, 731 F.2d 818, 826, 221 U.S.P.Q. (BNA) 568, 574 (Fed. Cir. 1984) (declining to apply the recapture rule when there was no evidence that the "amendment . . . was in any sense an admission that the scope of [the] claim was not patentable"). In this regard, claim amendments are relevant because an amendment to overcome a prior art rejection evidences an admission that the claim was not patentable. See *Mentor*, 998 F.2d at 995-96, 27 U.S.P.Q.2D (BNA) at 1524-25 (finding surrender by way of claim amendments); *Ball*, 729 F.2d at 1436, 221 U.S.P.Q. (BNA) at 294 (noting that a court may draw inferences from changes in claim scope).

Arguments made to overcome prior art can equally evidence an admission sufficient to give rise to a finding of surrender. Indeed, in *Mentor* and *Clement* the findings of a surrender were based in part on the arguments made in conjunction with the claim amendments. *Mentor*, 998 F.2d at 995-96, 27 U.S.P.Q.2D (BNA) at 1524-25; *Clement*, 131 F.3d at 1470-71, 45 U.S.P.Q.2D (BNA) at 1165-66. Logically, this is true even when the arguments are made in the absence of any claim amendment. Amendment of a claim is not the only permissible predicate for establishing a surrender.

The view that arguments alone can give rise to a surrender is consistent with the policy behind the reissue statute and the accompanying recapture rule. As already noted, the reissue statute is "based on fundamental principles of equity and fairness." *Weiler*, 790 F.2d at 1579, 229 U.S.P.Q. (BNA) at 675. There is no unfairness in binding the patentee to deliberate assertions made in order to obtain allowance of the original patent claims over the prior art. Indeed, fairness to the public must also be considered. In this regard, as stated in *Mentor*, "the reissue statute cannot be construed in such a way that competitors, properly relying on prosecution history, become patent infringers when they do so." 998 F.2d 992 at 996, 27 U.S.P.Q.2D (BNA) 1521 at 1525. The recapture rule operates to prevent this from happening. *See id.* Furthermore, as recognized in *Ball*, the recapture rule is based on principles of equity and therefore embodies the notion of estoppel. 729 F.2d at 1439, 221 U.S.P.Q. (BNA) at 296.

Indeed, the recapture rule is quite similar to prosecution history estoppel, which prevents the application of the doctrine of equivalents in a manner contrary to the patent's prosecution history. *See Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 137 L. Ed. 2d 146, 117 S. Ct. 1040, 1051 (1997). Like the recapture rule, prosecution history estoppel prevents a patentee from regaining subject matter surrendered during prosecution in support of patentability. *See id.*

Hester argues that an analogy cannot be made with prosecution history estoppel because the reissue procedure and prosecution history estoppel are the antithesis of one another--reissue allows an expansion of patent rights whereas prosecution history estoppel {142 F.3d 1482} is limiting. However, Hester's argument is unpersuasive. The analogy is not to the broadening aspect of reissues. Rather, the analogy is with the recapture rule, which restricts the permissible range of expansion through reissue just as prosecution history estoppel restricts the permissible range of equivalents under the doctrine of equivalents.

This court earlier concluded that prosecution history estoppel can arise by way of unmistakable assertions made to the Patent Office in support of patentability, just as it can by way of amendments to avoid prior art. *See, e.g., Texas Instruments, Inc. v. International Trade Comm'n*, 988 F.2d 1165, 1174, 26 U.S.P.Q.2D (BNA) 1018, 1025 (Fed. Cir. 1993). The same reasoning that led us to conclude that arguments alone can give rise to prosecution history estoppel lends support to the proposition that arguments alone can give rise to a surrender for purposes of the recapture rule.

Thus we conclude that, in a proper case, a surrender can occur through arguments alone. We next evaluate whether such a surrender occurred here with respect to the "solely with steam" and "two sources of steam" limitations, the pertinent aspects in which the asserted reissue claims are broader than the original patent claims. The obvious conclusion is that there has been a surrender.

As detailed above, Williams repeatedly argued that the "solely with steam" and "two sources of steam" limitations distinguished the original claims from the prior art. These were Williams' primary bases for distinguishing the broadest claim, independent claim 1, from the prior art. At no less than 27 places in six papers submitted to the Patent Office, Williams asserted that the "solely with steam" limitation distinguished the claimed invention from the prior art, and Williams did the same with respect to the "two sources of steam" limitation at no less than 15 places in at least five papers.

Williams argued that each of these limitations was "critical" with regard to patentability, and Williams further stated that the "solely with steam" limitation was "very material" in this regard. In essence, these repeated arguments constitute an admission by Williams that these limitations were necessary to overcome the prior art. Indeed, when the Board reversed the Examiner's rejection of the original claims, these were the primary bases indicated for patentability. Williams, through his admission effected by way of his repeated prosecution arguments, surrendered claim scope that does not include these limitations.

Having concluded that there has been a surrender, we must next determine whether the surrendered subject matter has crept back into the asserted reissue claims. *See Clement*, 131 F.3d at 1469, 45 U.S.P.Q.2D (BNA) at 1164. When the surrender occurs by way of claim amendment or cancellation, "comparing the reissue claim with the canceled claim is one way to do this." *See id.* This analysis is not available when the surrender is made by way of argument alone. Instead, in this case, we simply analyze the asserted reissue claims to determine if they were obtained in a manner contrary to the arguments on which the surrender is based.

Clearly they were. None of the asserted reissue claims include either the "solely with steam" limitation or the "two sources of steam" limitation. Thus, this surrendered subject matter--i.e., cooking other

than solely with steam and with at least two sources of steam--has crept into the reissue claims. The asserted reissue claims are unmistakably broader in these respects.

Finally, because the recapture rule may be avoided in some circumstances, we consider whether the reissue claims were materially narrowed in other respects. See, e.g., *Mentor*, 998 F.2d at 996, 27 U.S.P.Q.2D (BNA) at 1525 ("Reissue claims that are broader in certain respects and narrower in others may avoid the effect of the recapture rule."); *Clement*, 131 F.3d at 1470, 45 U.S.P.Q.2D (BNA) at 1165. For example, in *Ball* the recapture rule was avoided because the reissue claims were sufficiently narrowed (described by the court as "fundamental narrowness") despite the broadened aspects of the claims. 729 F.2d at 1438, 221 U.S.P.Q. (BNA) at 296. In the context of a surrender by way of argument, this principle, in appropriate cases, may operate to overcome the recapture rule when the reissue claims are materially narrower in **{142 F.3d 1483}** other overlooked aspects of the invention. The purpose of this exception to the recapture rule is to allow the patentee to obtain through reissue a scope of protection to which he is rightfully entitled for such overlooked aspects.

However, this is not such a case. The asserted reissue claims are not materially narrower, despite Hester's arguments to the contrary. Hester argues that the claims are materially narrower by the addition of the "spiral conveyance path" and "high humidity steam" limitations. The term "high humidity steam" is included in each of the asserted reissue claims except reissue claim 30 of the '259 reissue patent. However, the term "high humidity steam" is actually the same as or broader than the limitation in original claim 1 that this term replaced. Original claim 1 specifies a steam atmosphere "at near 100% humidity 100 degrees C. and a pressure above atmospheric." '047 patent, col. 6, ll. 3-4. Hester concedes that the term "high humidity steam" is not narrower than this limitation in original claim 1. In fact, with respect to the claim construction issue, Hester argues that the limitation in original claim 1 is but one example of "high humidity steam." Accordingly, the use of the term "high humidity steam" does not save the reissue claims from the recapture rule.

The term "spiral conveyance path" is also not materially limiting. This term appears explicitly in asserted reissue claims 28, 32, 75, and 76 of the '259 reissue patent; it does not appear explicitly in the other reissue claims asserted. Original claim 1 includes a corresponding limitation, namely, "means passing said conveyor belt through said housing . . . ." This is a so-called means-plus-function clause drafted pursuant to 35 U.S.C. § 112 P 6 (1994).<sup>7</sup> According to § 112 P 6, the clause is to be construed to "cover the corresponding structure . . . described in the specification and equivalents thereof." The only corresponding structure described in the specification (more properly, the written description of the patent) passes the conveyor belt through a spiral path. See '047 patent, col. 4, l. 64 to col. 5, l. 8. Thus, the explicit recitation of a "spiral conveyance path" in some of the asserted reissue claims does not materially narrow those claims. Indeed, Hester does not explain how the explicit recitation of a spiral conveyance path--which is present in prior art cookers cited by the examiner during the prosecution of the original patent--materially narrows these claims. In sum, neither alone nor together do the terms "high humidity steam" and "spiral conveyance path" materially narrow the claims.

Furthermore, the "spiral conveyance path" and "high humidity steam" limitations are not aspects of the invention that were overlooked during prosecution of the original patent. To the contrary, as just explained, these aspects were included in original claim 1. Additionally, with regard to the "spiral conveyance path" limitation, original dependent claim 12 explicitly recites "a spiral path." '047 patent, col. 6, l. 60. In prosecuting the original patent, Williams pointed out these features in an attempt to overcome the Examiner's obviousness rejection. Hester cannot now argue that Williams overlooked these aspects during the prosecution of the original patent application. In conclusion, this is not a case which involves the addition of material limitations that overcome the recapture rule.

In effect, Hester, through eight years of reissue proceedings, prosecuted Williams' original patent application anew, this time placing greater emphasis on aspects previously included in the original patent claims and removing limitations repeatedly relied upon to distinguish the prior art and described as "critical" and "very material" to the patentability of the invention. The reissue statute is to be construed liberally, but not that liberally. The realm of corrections contemplated within § 251 does not include recapturing surrendered subject matter, without the addition of materially-narrowing **{142 F.3d 1484}** limitations, in an attempt to 'custom-fit' the reissue claims to a competitor's product.

No doubt if two patent attorneys are given the task of drafting patent claims for the same invention, the two attorneys will in all likelihood arrive at somewhat different claims of somewhat different scope. And such differences are even more likely when, as here, the second attorney drafts the new claims nearly a decade later and with the distinct advantage of having before him the exact product offered

by the now accused infringer. This reality does not justify recapturing surrendered subject matter under the mantra of "failure to appreciate the scope of the invention." The circumstances of the case before us simply do not fit within the concept of "error" as contemplated by the reissue statute. See *Mentor*, 998 F.2d at 996, 27 U.S.P.Q.2D (BNA) at 1525 ("Error under the reissue statute does not include a deliberate decision to surrender specific subject matter in order to overcome prior art, a decision which in light of subsequent developments in the marketplace might be regretted.").

With respect to the recapture issue, there are no underlying material facts as to which there is a genuine issue in dispute. The original patent's prosecution history, on which we rely, is before us and undisputed. All that remains is the ultimate legal conclusion as to whether the asserted reissue claims fail to meet the "error" requirement because the claims impermissibly recapture surrendered subject matter. See *id.* at 994, 27 U.S.P.Q.2D (BNA) at 1524 (stating that whether the "error" requirement has been met is a legal conclusion). For the reasons explained above, we conclude as a matter of law that the asserted reissue claims fail in this regard. Summary judgment of invalidity of the asserted reissue claims under § 251 is called for. Accordingly, we affirm the district court's entry of summary judgment.

B

As an alternative basis for holding the asserted reissue claims invalid, the district court concluded that the reissue claims do not meet the "original patent" clause of § 251 P 1, which requires that the reissue patent be "for the invention disclosed in the original patent." *Hester*, 963 F. Supp. at 1412. In reaching this conclusion, the court interpreted the "original patent" clause as requiring an "objective" intent, manifested in the original patent, to claim the invention as claimed in the reissue patent. *Id.* The court based this interpretation on the Supreme Court's statement in *U.S. Industrial Chemicals, Inc. v. Carbide & Carbon Chemicals Corp.*, 315 U.S. 668, 676, 86 L. Ed. 1105, 62 S. Ct. 839 (1942), that there was an objective intent requirement under the predecessor reissue statute, 35 U.S.C. § 64 (1964), which required that the reissue patent be "for the same invention." 963 F. Supp. at 1413.

Based on this construction of the "original patent" clause, the district court framed the issue as, "whether the 047 patent manifests an objective intent to cover ovens that utilize heat sources other than steam, and have less than two steam sources." *Id.* The district court concluded that the asserted reissue claims failed to meet this test and thus were invalid under the "original patent" clause. *Id.* at 1413-15. On appeal, the parties focus on whether the "original patent" clause embodies the requirement of an objective intent to claim.

This court squarely addressed the issue in *Amos*, 953 F.2d at 616, 21 U.S.P.Q.2D (BNA) at 1273. The *Amos* court held that § 251 does not include a separate requirement of an objective intent to claim. 953 F.2d at 618-19, 21 U.S.P.Q.2D (BNA) at 1275-76. Rather, the court concluded: "the essential inquiry under the 'original patent' clause of § 251 . . . is whether one skilled in the art, reading the specification, would identify the subject matter of the new claims as invented and disclosed by the patentees." *Id.* at 618, 21 U.S.P.Q.2D (BNA) at 1275. The court noted that this inquiry is analogous to the "written description" requirement of 35 U.S.C. § 112 P 1 (1994). *Id.* The court further stated that, to the extent the construct of an objective intent to claim is useful, it is "only one factor that sheds light" on whether the "original patent" clause of § 251 is satisfied. *Id.* at 619 & n.2, 21 U.S.P.Q.2D (BNA) at 1275-76 & n.2 (quoting *In re Hounsfield*, 699 F.2d 1320, 1323, {142 F.3d 1485} 216 U.S.P.Q. (BNA) 1045, 1047-48 (Fed. Cir. 1983)).

With regard to the Supreme Court's opinion in *U.S. Industrial*, 315 U.S. 668, 86 L. Ed. 1105, 62 S. Ct. 839, the *Amos* court noted that that case was decided under the predecessor reissue statute which required reissue claims to be for the "same invention," and concluded that *U.S. Industrial* does not now mandate a separate "objective intent to claim" requirement. *Id.* The *Amos* court noted that this court reached the same conclusion eight years earlier in *Hounsfield*, 699 F.2d at 1323, 216 U.S.P.Q. (BNA) at 1047-48. *Id.*

Thus, the district court's conclusion that the "original patent" clause of § 251 was not satisfied based on an "objective intent to claim" requirement was in error. Stein does not contend that the test set forth in *Amos* for the "original patent" clause—i.e., whether one skilled in the art would identify the subject matter of the reissue claims as invented and disclosed by the patentee—is not met by the asserted reissue claims. Rather, Stein relies entirely on its assertion that there is an "objective intent to claim" requirement and that that requirement is not met. However, we need not resolve this issue further, having already concluded that the asserted reissue claims are invalid for failing to meet the "error" requirement of § 251.

III



Finally, Stein presents to us the question of whether the district court properly construed the claim term "high humidity steam." It is not immediately apparent whether this issue is properly before us. The district court did not construe the term in conjunction with a final judgment, such as a summary judgment of noninfringement or invalidity. Rather, the district court issued an oral ruling on the matter in preparation for trial. However, the district court having held the asserted claims invalid on summary judgment, which we here affirm, there can be no question of liability and hence the claim construction issue is moot. Therefore, we need not decide whether Stein's appeal of the claim construction is proper, and if so, whether the district court's construction was correct.

#### CONCLUSION

We affirm the grant of summary judgment of invalidity of the asserted reissue claims for failure to comply with 35 U.S.C. § 251 P1. Stein's cross-appeal is dismissed.

#### COSTS

Each party shall bear its own costs.

**AFFIRMED**

#### Footnotes

##### Footnotes

2 The district court noted that the issuance of two reissue patents for the same original patent was a "curiosity" that appeared to be unprecedented. *Hester*, 963 F. Supp. at 1405 n.2. However, the propriety of two reissues for the same patent was not addressed below and has not been raised on appeal. Accordingly, we express no opinion on the matter.

3 Accordingly, the Board never heard Willams' first appeal.

4 The reissue oath specifies two further insufficiencies, namely, that the '047 patent requires:

[3] "a steam generator supplying supplemental steam into said housing at said nozzles located there inside to maintain the atmosphere together with the other steam source at near 100% humidity 100 degrees C, and a pressure above atmospheric" and

[4] "a pool of water within the housing with heating means for boiling the water to create steam."

(Indentation and numbering added.)

5 Claim 30 of the '259 reissue patent does not contain the "high humidity steam" language.

6 The last paragraph of § 251 requires that a request to enlarge the scope of claims be "applied for within two years from the grant of the original patent." 35 U.S.C. § 251 P 4 (1994).

7 Use of the word "means" in a claim clause triggers a presumption that § 112 P 6 applies. See *York Prods., Inc. v. Central Tractor Farm & Family Ctr.*, 99 F.3d 1568, 1574, 40 U.S.P.Q.2D (BNA) 1619, 1623-24 (Fed. Cir. 1996). The presumption can be overcome if the clause recites sufficient structure. See *id.* The clause at issue here recites no structure for performing the function of passing the conveyor belt through the housing. Accordingly, § 112 P 6 unquestionably applies.

IN RE JAMES R. AMOS  
953 F.2d 613; 1992 U.S. App. LEXIS 2456; 21 U.S.P.Q.2D (BNA) 1271  
91-1298  
February 18, 1992, Decided  
UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

**Notice:** RULE 47.8. OPINIONS AND ORDERS DESIGNATED AS UNPUBLISHED SHALL NOT BE EMPLOYED AS PRECEDENT BY THIS COURT, AND MAY NOT BE CITED BY COUNSEL, EXCEPT IN SUPPORT OF A CLAIM OF RES JUDICATA, COLLATERAL ESTOPPEL, OR LAW OF THE CASE. ANY PERSON MAY REQUEST THAT AN UNPUBLISHED OPINION OR ORDER BE PREPARED AND REISSUED FOR PUBLICATION, CITING REASONS THEREFOR. SUCH REQUEST WILL BE GRANTED OR DENIED BY THE PANEL THAT RENDERED THE DECISION.

**Editorial Information: Prior History**

Original Opinion of December 31, 1991, Reported at 1991 U.S. App. LEXIS 30189.

**Opinion**

Petition on Rehearing Denied.

IN RE JAMES R. AMOS, CHESTER K. GREATHOUSE and DAVID S. RIDDLE  
953 F.2d 613; 1991 U.S. App. LEXIS 30189; 21 U.S.P.Q.2D (BNA) 1271  
91-1298  
December 31, 1991, Decided  
UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT  
Before MAYER, LOURIE and CLEVINGER, Circuit Judges.

**Disposition** REVERSED

**Counsel** Marvin Moody, of Hill, Van Santen, Steadman & Simpson, Chicago, Illinois, argued for appellants.  
Lee E. Barrett, Associate Solicitor, of Arlington, Virginia, argued for the Commissioner of Patents and Trademarks. With him on the brief was Fred E. McKelvey, Solicitor.

**Editorial Information: Prior History**

Appealed from: Board of Patent Appeals and Interferences

**Editorial Information: Subsequent History**

As Corrected January 9, 1992. Second Amendment February 3, 1992. Petition on Rehearing Denied February 18, 1992, Reported at 1992 U.S. App. LEXIS 2456.

**Opinion**

**Opinion by:** CLEVINGER

{953 F.2d 614} CLEVINGER, *Circuit Judge*.

James R. Amos, Chester K. Greathouse, and David S. Riddle (collectively, "patentees") submitted an application for a broadened reissue of U.S. Patent No. 4,610,582 ("582 patent"). New claims 10

through 12 were finally denied after appeal to the Board of Patent Appeals and Interferences ("Board") of the U.S. Patent and Trademark Office ("PTO") because the "failure to claim the subject matter of claims 10 through 12 was not the result of the 'error' required by 35 USC 251" since the "objective intent of the patentees" had been to claim only the subject matter in the already issued claims. *Ex parte Amos*, No. 90-3019, slip op. at 8 (BOPAI Feb. 27, 1991). We reverse because the objective intent of the patentees cannot, alone, form the basis for a denial of reissue claims.

I

The 582 patent, which issued on September 9, 1986, claims a set of rollers mounted to hold down a workpiece laid upon a moving table until the end of the table is reached, whereupon the rollers lift away from the table surface. The rollers are designed to lift away so that they cannot fall off the end of the table. 582 patent, col. 1, ln. 15-28, col. 4, claims 1-9. The specification contemplates that lifting will occur automatically:

As the rollers approach the end of the table travel the outside roller is raised either mechanically by the roller cams or electronically by the computer controlling the router. This action prevents the roller from falling off the table and then being damaged as the table moves back against the outside roller.

582 patent, col. 3, ln. 61, col 4, ln. 2 (reference numbers deleted).

The original claims were not directed to the alternative of using a computer to control the lifting of the rollers. Less than one year after issuance and thus within the statutory time permitted for broadened reissue, the patentees filed a declaration with the PTO that they believed "the original patent to be through error, without deceptive intention, wholly or partly inoperative and invalid for the reason that we claimed less than we had a right to claim in not including claims of the scope of newly submitted claims 10, 11 and 12 which are directed to the concept of controlling the rollers and clamps by the computer." The examiner objected to the declaration because the patentees had not "specified the errors relied upon, and how they arose or occurred" as expressly required by 37 C.F.R. § 1.175(a)(5) (1988). The Manual of Patent Examining Procedure, at § 1414.03 illustrates the scope of the regulatory provision, by stating, in part:

It is particularly important that the reissue oath or declaration specify in detail how the errors arose or occurred. . . . If the reissue oath or declaration does not particularly specify "how," i.e., the manner in which the errors arose or occurred, the Office will be unable to adequately evaluate reissue applicant's statement in compliance with § 1.175(a)(6) that the "errors arose 'without deceptive intention' on the part of the applicant"; see § 1414.04.

**{953 F.2d 615}** Thereafter, the patentees submitted a supplemental declaration which, in pertinent part, averred:

How this error arose is as follows. Due to mistake and inadvertence during the preparation of the original application which resulted in [the 582 patent], the attorney who drafted the original claims did not include due to oversight any claims to the combination of the computer for the router which may be connected to control the rollers and the clamps to automatically release them. . . .

After September 9, 1986 when U.S. Patent issued, the inventors asked for an opinion as to whether the allowed claims in U.S. Patent covered a combination for a computer for router which may be connected to control the rollers and the clamps to automatically release. As soon as such request was received, the attorney for applicants studied the issued claims of [the 582 patent] and gave the opinion to the inventors that such combination of the computer was not covered by the issued claims. The inventors then instructed the attorney to prepare and file this reissue application with claims to the computer embodiment.

Supplemental Reissue Declaration at para. 4 (reference numbers deleted).

Nonetheless, the examiner finally rejected claims 10-12 because the declaration failed "to particularly specify how the errors relied upon arose or occurred, as required under 37 CFR 1.175(a)(5)." Office Action in U.S. Application Ser. No. 056,784 from PTO Examiner to the patentees (Oct. 17, 1988) at 2. Furthermore, the examiner rejected the claims because they were not "for the same invention as that disclosed as being the invention in the original patent," asserting that this was required by 35 U.S.C. § 251. The examiner stated that there was no "evidence that applicant considered the use of the router computer to control the rollers and the clamps to be their invention." *Id.* (citing *In re Mead*, 581 F.2d 251, 198 USPQ 412 (CCPA 1978)). We read, as did the Board, the examiner's final rejection to be based upon both of two independent prerequisites to reissue, found in 35 U.S.C. § 251, which are that

the patentee specify "error without any deceptive intention" and that the Commissioner may not reissue a patent with new claims unless the reissued patent is "for the invention disclosed in the original patent." On the patentees' appeal to the Board, the examiner filed an answer which contended that, additionally, the "disclosure fails to present an enabling disclosure on which claims 10-12 can find support" as required by 35 U.S.C. § 112 para. 1.

## II

In its opinion, the Board first addressed the examiner's finding that the reissue declaration was legally insufficient under 37 C.F.R. § 1.175(a)(5) for failing to specify or identify the type of error contemplated by the statute. The Board held:

Our assessment of the supplemental reissue declaration, however, indicates to us that it complies with 37 CFR 1.175(a)(5). Specifically, we determine that section 4) of the supplemental declaration, bridging pages 2 and 3 thereof, particularly specifies in reasonable detail how the errors relied upon arose by setting forth a chronology of relevant events.

*Ex parte Amos*, slip op. at 4.

The Board further found that "the subject matter of these claims was disclosed in accordance with 35 USC 112." *Id.* at 8. However, the Board concluded that:

appellants' failure to claim the subject matter of claims 10 through 12 was not the result of the "error" required by 35 USC 251. The subject matter of claims 10 through 12 was not originally claimed, not an object of the original patent, and not depicted in the drawing. Thus, we perceive that the *objective intent* of the patentees manifested in the original patent was to solely claim the invention of claim 1 through 9.

\*\*\*

Specifically, appellants submit that there is no manifestation of an *intent* not to claim in the original patent, and argue that the patent clearly shows that they *intended to claim* the control of the rollers and clamps by the computer. The {953 F.2d 616} difficulty we have with this advocated position is that appellants do not provide us with any insight as to where the original disclosure evidences an *intent to claim*, and we can find none.

In summary, this board sustains the examiner's rejection of appellants' claims under 35 USC 251, for the reasons given above.

*Ex parte Amos*, slip op. at 8-9 (emphasis added).

The Board thus specifically declined to affirm the rejection on two of the grounds suggested by the examiner: that the disclosure did not support the claims under § 112 para. 1; and, that the supplemental affidavit did not satisfy the statutory requirement that reissue is permitted only upon demonstration of error without any deceptive intention. Rather, the Board found that the disclosure of the original patent failed to set forth an "intent to claim" the subject matter for which protection was sought on reissue.

## III

This appeal invites us to address the proper role under 35 U.S.C. § 251, if any, for the concept of an "intent to claim" in a rejection of claims submitted during reissue. We start, as we must, with the words of the statute, which, in pertinent part, state:

Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Commissioner shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.

35 U.S.C. § 251 para. 1 (1988).

The section requires that the patentee base the application for reissue upon one of four specified grounds statutorily-identified as correctable defects. *In re Clark*, 522 F.2d 623, 625-26, 187 USPQ 209, 211-12 (CCPA 1975). First, an asserted defect may arise from an error in the specification. *In re*

*Salem*, 553 F.2d 676, 679, 193 USPQ 513, 516 (CCPA 1977) (reissue permitted to correct specification term "polyvalent anions" to clearly-implied "source of polyvalent anions"). Second, the patentee may correct a defective drawing. The final two reasons for which the patentee may seek reissue concern original claims subsequently discovered to have been either too narrow or too broad. *In re Handel*, 50 C.C.P.A. 918, 312 F.2d 943, 948, 136 USPQ 460, 464 (CCPA 1963) (purpose of statute is to permit limitations to be added to, or removed from, claims). The basis for seeking narrowing reissue has generally been the belated discovery of partially-invalidating prior art. *In re Harita*, 847 F.2d 801, 805, 6 USPQ2d 1930, 1932 (Fed. Cir. 1988). In contrast, a broadened reissue has generally been founded upon post-issuance discovery of attorney error in understanding the scope of the invention. *In re Wilder*, 736 F.2d 1516, 1519, 222 USPQ 369, 371 (Fed. Cir. 1984) ("attorney's failure to appreciate the full scope of the invention is one of the most common sources of defects"), *cert. denied*, 469 U.S. 1209, 84 L. Ed. 2d 323, 105 S. Ct. 1173 (1985); *see also Scripps Clinic & Research Found. v. Genentech, Inc.*, 927 F.2d 1565, 1575, 18 USPQ2d 1001, 1009 (Fed. Cir. 1991).

In setting forth the purpose of the reissue, the patentee must submit an oath or declaration along with the surrendered patent and a payment of the requisite fee. 37 C.F.R. § 1.172(a) (1988); *see* 35 U.S.C. § 251 para. 3 (1988). "There are two distinct statutory requirements that a reissue oath or declaration must satisfy. First, it must state that the patent is defective or partly inoperative or invalid because of defects in the specification or drawing, or because the patentee has claimed more or less than he is entitled to. Second, the applicant must allege that the defective, inoperative, or invalid patent arose through error without deceptive intent." *Wilder*, 736 F.2d at 1518, {953 F.2d 617} 222 USPQ at 370; *see also Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 882 F.2d 1556, 1564-65, 11 USPQ2d 1750, 1757-58 (Fed. Cir. 1989), *cert. denied*, 493 U.S. 1076, 110 S. Ct. 1125, 107 L. Ed. 2d 1031 (1990).

Finally, the statute restricts the Commissioner to reissuing the patent only "for the invention disclosed in the original patent" with the proviso that "no new matter shall be introduced into the application." The "original patent" clause of § 251 creates a requirement that precludes reissue, historically styled as a "same invention" rejection, of patents with claims to subject matter that could not have been claimed in the original patent that is submitted for reissue.

As is apparent from the foregoing statutory analysis, "the phrase 'intent to claim' does not appear in the statute." *In re Weiler*, 790 F.2d 1576, 1581, 229 USPQ 673, 676 (Fed. Cir. 1986); *see also Scripps Clinic*, 927 F.2d at 1575, 17 USPQ2d at 1009 ("Intent to claim" is not the criterion for reissue").

#### IV

In practice, the rejection of reissue claims has been founded upon either a failure to demonstrate error without deceptive intention, *see Weiler*, or because the newly submitted claims are not supported by the disclosure of the "original patent." In the decision before us, the Board specifically rejected the examiner's contention that the supplementary declaration was insufficient to demonstrate "error without any deceptive intention."<sup>1</sup> Thus, we do not read the Board opinion as having rejected the claims because the submitted declaration failed to specify the statutorily-required error.

Thus, we must read the Board's invocation of the "infelicitous" phrase, "intent to claim," *see Weiler*, 790 F.2d at 1580, 229 USPQ at 675, as a decision that the new claims were not "for the invention disclosed in the original patent," or, in the time-honored terminology, were not for the "same invention." We note that the phrase has been oft employed in support of a rejection grounded upon a failure of the patentee to show that the new claims are directed to the "same" invention as that originally disclosed. *In re Rowand*, 526 F.2d 558, 187 USPQ 487 (CCPA 1975); *In re Mead*, 581 F.2d 251, 198 USPQ 412 (CCPA 1978). Therefore, the Board's decision must be based upon its determination that the original disclosure does not support the subject matter of the new claims as required by the "original patent" clause of § 251.

We thus must turn to our binding precedent from the Court of Customs and Patent Appeals to understand the legal parameters that support a "same invention" or "original patent" rejection of claims in a reissue application. As noted by that court:

"intent to claim" arose from the requirement that the reissue be for the "same invention" as the original, i.e., that it cover what was "intended to have been covered" by the original [citing 35 U.S.C. § 64 (1946), *repealed by* Patent Act of 1952, Pub. L. No. 593, § 251, 66 Stat. 792, 808 (1952)]. . . .

Thus, in *Rowand* and similar cases, "intent to claim" has little to do with "intent" *per se*, but rather is analogous to the requirement of § 112, first paragraph that the specification contain a "written description of the invention, and of the manner and process of making and using it." It is, as appellant urges, synonymous with "right to claim."

*Mead*, 581 F.2d at 256, 198 USPQ at 417.

Our predecessor court further explained the proper test under the "same invention" or "original patent" statutory arm:

**{953 F.2d 618}** Determining what protection appellants intended to secure by their original patent for the purposes of § 251 is an essentially factual inquiry confined to the *objective* intent manifested by the original patent.

*Rowand*, 526 F.2d at 560, 187 USPQ at 489 (emphasis original).

Hence, the purpose of the rubric "intent to claim" is to ask the same question as to whether "new matter" has been "introduced into the application for reissue" thus, perforce, indicating that the new claims are not drawn to the same invention that was originally disclosed. That inquiry is but a restatement of the question whether that which is claimed in reissue could have been claimed on the basis of the original disclosure, given that the requisite inadvertent error has been demonstrated, as is the case here. Thus, the inquiry that must be undertaken to determine whether the new claims are "for the invention" originally disclosed, to paraphrase *Rowand*, is to examine the entirety of the original disclosure and decide whether, through the "objective eyes" of the hypothetical person having ordinary skill in the art, an inventor could fairly have claimed the newly submitted subject matter in the original application, given that the requisite error has been averred. We agree with, and, in any event, are bound by, the statement in *Mead*, quoted above, that the inquiry under § 251 as to whether the new claims are for the invention originally disclosed is analogous to the analysis required by § 112 para. 1. Under one aspect of that analysis, a court must ascertain whether "the disclosure originally filed [conveys] to those skilled in the art that applicant had invented the subject matter later claimed." *Wilder*, 736 F.2d at 1520, 222 USPQ at 372; *see also In re Kaslow*, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983); *In re Edwards*, 568 F.2d 1349, 1351, 196 USPQ 465, 467 (CCPA 1978) ("The function of the description requirement is to ensure that the inventor had possession, as of the filing date of the application relied on, of the specific subject matter later claimed by him.").

Since the Board concluded that the original disclosure embraces the matter claimed in reissue, the Board erred in denying the reissue application on the basis of the lack of an "intent to claim." In the case at hand, the Solicitor, in his brief to this court, expressly concedes that the Board was correct in finding that the patentees' reissue claims comply with the enablement and written description requirements of § 112 para. 1. Under *Rowand*, given a satisfactory averment of inadvertent error, this position is arguably inconsistent with a "same invention" rejection. However, the issue of whether the tests, for written description and enablement under § 112 para. 1 and for "same invention" under § 251, are in every case exactly co-extensive, neither briefed nor argued in this case, is not properly before us on the instant facts, since the Board's decision rests only upon the factual determination that the patentees' lacked an objective "intent to claim" the new subject matter. We need only decide whether a reissue application can be rejected under the "error" rubric for failure to demonstrate an objective intent to claim, when the Board has held that the subject matter of the reissue claims meets the requirements of § 112 para. 1.

We conclude that, under both *Mead* and *Rowand*, a claim submitted in reissue may be rejected under the "original patent" clause if the original specification demonstrates, to one skilled in the art, an absence of disclosure sufficient to indicate that a patentee could have claimed the subject matter. Merely finding that the subject matter was "not originally claimed, not an object of the original patent, and not depicted in the drawing," does not answer the essential inquiry under the "original patent" clause of § 251, which is whether one skilled in the art, reading the specification, would identify the subject matter of the new claims as invented and disclosed by the patentees. In short, the absence of an "intent," even if objectively evident from the earlier claims, the drawings, or the original objects of the invention is simply not enough to establish that the new claims **{953 F.2d 619}** are not drawn to the invention disclosed in the original patent.<sup>2</sup>

Our conclusion in this circumstance is dictated by this Court's previous decision in *In re Hounsfield*, 699 F.2d 1320, 216 USPQ 1045 (Fed. Cir. 1983).<sup>3</sup> In *Hounsfield*, the Board rejected reissue claims on the ground that "the record makes it clear that it was not appellant's intention to claim the subject

matter of claims 7 through 11 in the original [131] patent." *Hounsfield*, 699 F.2d at 1321, 216 USPQ at 1046 (quoting the Board). The issue for decision was whether the rejection was sustainable under § 251. This Court concluded that:

lack of "intent to claim" is not an independent basis for denying a reissue application under section 251. It is only one factor that sheds light upon whether the claims of the reissue application are directed to the same invention as the original patent and the reissue would correct an inadvertent error in the original patent.

] *Hounsfield*, 699 F.2d at 1323, 216 USPQ at 1048.

Thus, we conclude, as did this Court in *Hounsfield*, that the presence or absence of an objective intent to claim, standing alone, is simply not dispositive of any required inquiry under § 251.

REVERSED

### Footnotes

#### Footnotes for Opinion

1 In its brief on behalf of the Commissioner of Patents and Trademarks, the Solicitor suggests that the reissue declarations did not satisfy the statutory requirement of error without deceptive intention. Assuming, *arguendo*, that the Solicitor's office can challenge the decision of the Board, we reject the suggestion. The Board's decision that the supplementary declaration averred sufficient facts to support a finding of error is not clearly erroneous.

2 The Board cites the case of *U.S. Industrial Chems. v. Carbide & Carbon Chems. Corp.*, 315 U.S. 668, 62 S. Ct. 839, 86 L. Ed. 2d 1105, 53 U.S.P.Q. (BNA) 6 (1942), in support of its use of the phrase "intent to claim." In *U.S. Industrial*, the Supreme Court held that the reissue claims were invalid because the patentees had added new matter to the original disclosure which was the only support for those claims. In the course of the decision, which was based upon the statutory requirement that the reissue claims be for the "same invention," see 35 U.S.C. § 64 (1946), the Supreme Court referred to various other tests under which reissue claims might be held invalid. To the extent that the language of *U.S. Industrial* supports the use of the legal oxymoron, "objective intent to claim," as an analytical tool to discern the scope of the original disclosure, nothing in this opinion, nor in *Mead*, *Rowand*, or *In re Hounsfield*, 699 F.2d 1320, 216 USPQ 1045 (Fed. Cir. 1983), differs in legal significance. The objective intent to claim found in the original disclosure, insofar as the construct is analytically useful, however, exists as "only one factor that sheds light upon whether the claims in the reissue application are directed to the same invention as the original patent and the reissue would correct an inadvertent error in the original patent." *Hounsfield*, 699 F.2d at 1323, 216 USPQ at 1048.

3 Neither party nor the Board cited or discussed this case. Inexplicably, all three rely instead on dicta from *Weiler*. The issue for decision in *Weiler* was whether the patentee had demonstrated error without deceptive intention, not whether the claims were to the same invention as the "original patent." We do not quibble with the holding in *Weiler* that satisfaction of the § 112 para. 1 written description requirement does not establish "error" under § 251. *Weiler*, 790 F.2d at 1581 n.2, 229 USPQ at 676 n.2. *Weiler* did not involve the question of whether § 112 para. 1 speaks conclusively to the "original patent" requirement of § 251. See 4 D. Chisum *Patents* § 15.03[3] n.15 (1991). We have no ready explanation for the Board's or the parties' attention to *Weiler* and utter inattention to *Hounsfield*.

**IN RE CLEMENT**  
**131 F.3d 1464; 1997 U.S. App. LEXIS 35023; 45 U.S.P.Q.2D (BNA) 1161**  
**97-1202**  
**December 12, 1997, Decided**  
**UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT**  
**Before MAYER, Circuit Judge, SMITH, Senior Circuit Judge, and CLEVENGER, Circuit Judge.**

**Disposition**

AFFIRMED IN PART AND VACATED IN PART.

**Counsel**

Lawrence M. Green, Wolf, Greenfield & Sacks, P.C., of Boston, Massachusetts, argued for the appellant. With him on the brief was Christopher S. Schultz.  
John M. Whealan, Associate Solicitor, Office of the Solicitor, Patent and Trademark Office, of Arlington, Virginia, argued for the appellee. With him on the brief were Nancy J. Linck, Solicitor, Albin F. Drost, Deputy Solicitor, and Scott A. Chambers, Associate Solicitor.

**Opinion**

**Editorial Information: Prior History**

Appealed from: Patent and Trademark Office Board of Patent Appeals and Interferences. (Serial No. 08/054,951).

**Opinion by:** MAYER

**{131 F.3d 1466}** MAYER, *Circuit Judge*.

Jean-Marie Clement appeals the decision of the United States Board of Patent Appeals and Interferences sustaining the rejection of claims 1-18 and 49-52 in reissue application Serial No. 08/054,951 under 35 U.S.C. § 251 (1994). Because the board correctly applied the recapture rule to bar claims 49-52 and because claims 1-18 alone cannot support the reissue application, we affirm in part and vacate in part.

*Background*

This case is about U.S. Patent No. 4,780,179 (the '179 patent) issued to Jean-Marie Clement. The '179 patent claims a method for treating waste paper that removes "stickies," such as glues and plastics, under a first set of environmental conditions, before removing inks under a second set of environmental conditions.

The '179 patent issued from application Serial No. 06/822,943 (the '943 application), which was a continuation of application Serial No. 06/482,623 (the '623 application). During prosecution, Clement amended the claims to overcome U.S. Patent No. 4,360,402, issued to Ortner et al. (Ortner), and an article written by Michael Burns entitled "Waste Paper Preparation Plant and Systems," published in the June/August 1973 issue of Paper Technology (Burns). The broadest of the '623 application's claims, original claim 1, recites:

A method of treating a mixture of printed and contaminated waste paper in order to produce pulps for the use in the manufacture of pulp and paper boards, which method comprises:

- (a) forming an aqueous pulp of said waste material at low temperature, low specific mechanical energy, thereby forming a pulpable slurry and releasing the non-ink contaminants from the surface of the paper but without dispersing them inside the fibrous suspension;
- (b) separating the non-ink contaminants from the pulp by mechanical separation, without the use of froth floatation or solvent extraction or other process, using conventional screens and centrifugal cleaners and without any further application of strong shear forces to the pulp;
- (c) softening of the ink particles vehicles and weakening of their bondings with the surface of the fibres by submitting the pulp at a consistency of more than 15% at the simultaneous actions of (A)



high temperature - between 85 and 130 degrees C. - (B) high shear forces and (C) at least one de-inking agent, under alkaline [sic] conditions;

(d) detaching the ink particles from the surface of the fibres and dispersing them **{131 F.3d 1467}** into the fibrous suspension by submitting the pulp to the simultaneous actions of (A) high temperature - between 85 and 130 degrees C. - (B) high shear forces and (C) at least one chemical dispersing agent, under alkaline [sic] conditions;

(e) removing the free ink particles by means of the most appropriate known method and up to the degree of brightness required by the final use of the pulp.

In an effort to overcome Ortner, Clement submitted a preliminary amendment in the '943 application dated January 27, 1986, which replaced original claim 1 with claim 42. Claim 42 is limited to: (1) carrying out step (a) at room temperature; (2) using mechanical energy less than 50 KW.H/Ton in step (a); (3) removing the ink by applying a combination of high temperature between 85 and 130 degrees C, mechanical energy greater than 50 KW.H/Ton, and a de-inking or chemical dispersing agent under alkaline conditions in steps (c) and (d), respectively; and (4) limiting the duration of steps (c) and (d) to between two and ten minutes. In this preliminary amendment, Clement argued that Ortner's process could not apply simultaneously the higher temperature and larger shear force (mechanical energy greater than 50 KW.H/Ton) recited in steps (c) and (d). Clement also argued that using a higher temperature in Ortner's process would prevent the final product from having the necessary brightness.

In response, the examiner withdrew the Ortner reference, but relied on Burns until Clement's amendments dated December 23, 1986, and June 29, 1987, and an examiner's amendment dated May 16, 1988, added the following limitations: (1) steps (a) and (b) remove substantially all the non-ink contaminants including the stickies; (2) steps (c) and (d) include strong alkaline conditions having a pH of at least 9; (3) the brightness of the final pulp in step (f) is at least 59 ISO; and (4) step (b) takes place at room temperature. The table at Appendix A shows claim 42 before the last two amendments. In his December 23, 1986, amendment, Clement specifically argued that Burns fails to disclose the strong alkaline conditions having a pH greater than 9 that he added to steps (c) and (d). In his June 29, 1987, amendment, he continued to traverse the examiner's assertion that Burns discloses removing the stickies at room temperature through the application of mechanical energy lower than 50 KW.H/Ton. The patent issued on October 25, 1988, with claim 42 becoming claim 1, as shown in the table at Appendix B.

On October 18, 1990, Clement filed reissue application Serial No. 07/600,012 (the '012 application). During prosecution of the '012 application, he admitted that he added "very specific process parameters" to issued claim 1 during prosecution of the '943 application "in order to distinguish over the prior art." Clement later abandoned the '012 application in favor of continuation reissue application Serial No. 08/054,951 (the '951 application), presently on appeal. The '951 application includes claims 1-18, which correspond to claims 1-18 of the '179 patent, and claims 49-52, which are admittedly broader than the '179 patent's claims. In his reissue declaration, Clement stated that as a result of his failure to understand the claims and his attorney's failure to appreciate the scope of his invention, claims 1-18 of the '179 patent are unduly limited because "step (a) recites forming the first fibrous suspension at room temperature by applying specific mechanical energy lower than 50 KW. H/Ton." In addition, "the temperature, mechanical energy and pH conditions set forth in steps (c) and (d)" unduly limit claim 1 and claims 2-18, which depend from it. Claim 49 eliminates these limitations and the room temperature limitation in the first claim's step (b). The table at Appendix B compares reissue claim 49 with claim 1 of the '179 patent with differences italicized.

The examiner rejected claims 49-52 under 35 U.S.C. § 251<sup>1</sup> for being broadened in a reissue application filed outside the two year statutory period. The examiner also rejected **{131 F.3d 1468}** claims 1-18 and 49-52 under section 251 for lacking a basis for reissue because recapture is not an error so correctable. The examiner found the reissue declaration defective under 37 C.F.R. § 1.175 (1997) because it failed not only to mention the error in step (b), but also to explain sufficiently how any of the errors arose. The examiner determined that these defects were not curable because the recapture rule applied. Clement appealed the examiner's final rejection to the United States Board of Patent Appeals and Interferences (the board).

The board determined that Clement filed his broadening reissue application timely. It further found that during prosecution of the '179 patent, Clement added temperature, mechanical energy, and pH limitations to overcome prior art rejections. The board noted that the temperature limitation in step (a)

and the temperature and mechanical energy limitations in steps (c) and (d) "were argued by [Clement] to be features not suggested by Ortner or Burns and . . . were accepted by the examiner as distinguishing over these references." It concluded that Clement implicitly admitted that "broader claims not restricted to . . . [these limitations] were not patentable over the prior art represented by Ortner." The board found that claims 49-52 do not include these limitations and concluded that the reissue claims seek to broaden the patent in a manner directly pertinent to subject matter that Clement deliberately surrendered to overcome prior art rejections. It therefore sustained the rejection of claims 49-52 for failing to comply with 35 U.S.C. § 251, and the rejection of claims 1-18 and 49-52 based on a defective reissue declaration. Clement appeals.

### Discussion

Determining whether an applicant has met the statutory requirements of 35 U.S.C. § 251 is a question of law, which we review *de novo*. *Mentor Corp. v. Coloplast, Inc.*, 998 F.2d 992, 994, 27 U.S.P.Q.2D (BNA) 1521, 1524 (Fed. Cir. 1993). This legal conclusion is based on underlying findings of fact, which we sustain unless they are clearly erroneous. *In re Kemps*, 97 F.3d 1427, 1430, 40 U.S.P.Q.2D (BNA) 1309, 1312 (Fed. Cir. 1996); *Mentor*, 998 F.2d at 994, 27 U.S.P.Q.2D (BNA) at 1524. An attorney's failure to appreciate the full scope of the invention qualifies as an error under section 251 and is correctable by reissue. *In re Wilder*, 736 F.2d 1516, 1519, 222 U.S.P.Q. (BNA) 369, 370-71 (Fed. Cir. 1984). Nevertheless, "deliberate withdrawal or amendment . . . cannot be said to involve the inadvertence or mistake contemplated by 35 U.S.C. § 251." *Haliczer v. United States*, 174 Ct. Cl. 507, 356 F.2d 541, 545, 148 U.S.P.Q. (BNA) 565, 569 (Ct. Cl. 1966). The recapture rule, therefore, prevents a patentee from regaining through reissue the subject matter that he surrendered in an effort to obtain allowance of the original claims. See *Mentor*, 998 F.2d at 995, 27 U.S.P.Q.2D (BNA) at 1524. Under this rule, claims that are "broader than the original patent claims in a manner directly pertinent to the subject matter surrendered during prosecution" are impermissible. *Id.* at 996, 27 U.S.P.Q.2D (BNA) at 1525.

The first step in applying the recapture rule is to determine whether and in what "aspect" the reissue claims are broader than the patent claims. For example, a reissue claim that deletes a limitation or element from the patent claims is broader in that limitation's aspect. Clement argues that the board focused too much on the specific limitations that were omitted from the reissue claims. Although the scope of the claims is the proper inquiry, *In re Richman*, 56 C.C.P.A. 1083, 409 F.2d 269, 274, 161 U.S.P.Q. (BNA) 359, 362 (CCPA 1969), claim language, including limitations, defines claim scope. *Abtox, Inc. v. Exitron Corp.*, 122 F.3d 1019, 1023, 43 U.S.P.Q.2D (BNA) 1545, 1548 (Fed. Cir. 1997); *Bell Communications Research, Inc. v. Vitalink Communications Corp.*, 55 F.3d 615, 619, 34 U.S.P.Q.2D (BNA) 1816, 1819 (Fed. Cir. 1995) ("The language of the claim defines the scope of the protected invention."). Under *Mentor*, courts must determine in which aspects the reissue claim is broader, which includes broadening as a result of an omitted limitation. The board did not err by determining which limitations Clement deleted from the patent claims.

The second step is to determine whether the broader aspects of the reissue {131 F.3d 1469} claims relate to surrendered subject matter. To determine whether an applicant surrendered particular subject matter, we look to the prosecution history for arguments and changes to the claims made in an effort to overcome a prior art rejection. See *Mentor*, 998 F.2d at 995-96, 27 U.S.P.Q.2D (BNA) at 1524-25; *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 U.S.P.Q. (BNA) 289, 294-95 (Fed. Cir. 1984).

Although the recapture rule does not apply in the absence of evidence that the applicant's amendment was "an admission that the scope of that claim was not in fact patentable," *Seattle Box Co. v. Industrial Crating & Packing, Inc.*, 731 F.2d 818, 826, 221 U.S.P.Q. (BNA) 568, 574 (Fed. Cir. 1984), "the court may draw inferences from changes in claim scope when other reliable evidence of the patentee's intent is not available," *Ball*, 729 F.2d at 1436, 221 U.S.P.Q. (BNA) at 294. Deliberately canceling or amending a claim in an effort to overcome a reference strongly suggests that the applicant admits that the scope of the claim before the cancellation or amendment is unpatentable, but it is not dispositive because other evidence in the prosecution history may indicate the contrary.<sup>2</sup> See *Mentor*, 998 F.2d at 995-96, 27 U.S.P.Q.2D (BNA) at 1524-25; *Ball*, 729 F.2d at 1438, 221 U.S.P.Q. (BNA) at 296; *Seattle Box Co.*, 731 F.2d at 826, 221 U.S.P.Q. (BNA) at 574 (declining to apply the recapture rule in the absence of evidence that the applicant's "amendment . . . was in any sense an admission that the scope of [the] claim was not patentable"); *Haliczer*, 356 F.2d at 545, 148 U.S.P.Q. (BNA) at 569 (acquiescence in the rejection and acceptance of a patent whose claims include the limitation added by the applicant to distinguish the claims from the prior art shows

intentional withdrawal of subject matter); *In re Willingham*, 48 C.C.P.A. 727, 282 F.2d 353, 354, 357, 127 U.S.P.Q. (BNA) 211, 213, 215 (CCPA 1960) (no intent to surrender where the applicant canceled and replaced a claim without an intervening action by the examiner). Amending a claim "by the inclusion of an additional limitation [has] exactly the same effect as if the claim as originally presented had been canceled and replaced by a new claim including that limitation." *In re Byers*, 43 C.C.P.A. 803, 230 F.2d 451, 455, 109 U.S.P.Q. (BNA) 53, 55 (CCPA 1956).

Once we determine that an applicant has surrendered the subject matter of the canceled or amended claim, we then determine whether the surrendered subject matter has crept into the reissue claim. Comparing the reissue claim with the canceled claim is one way to do this. *In re Wadlinger*, 496 F.2d 1200, 1204, 181 U.S.P.Q. (BNA) 826, 830 (CCPA 1974); *Richman*, 409 F.2d at 274, 161 U.S.P.Q. (BNA) at 362. If the scope of the reissue claim is the same as or broader than that of the canceled claim, then the patentee is clearly attempting to recapture surrendered subject matter and the reissue claim is, therefore, unallowable. *Ball*, 729 F.2d at 1436, 221 U.S.P.Q. (BNA) at 295 ("The recapture rule bars the patentee from acquiring, through reissue, claims that are the same or of broader scope than those claims that were canceled from the original application.") (emphasis omitted); *Byers*, 230 F.2d at 456, 109 U.S.P.Q. (BNA) at 56. In contrast, a reissue claim narrower in scope escapes the recapture rule entirely. *Ball*, 729 F.2d at 1436, 221 U.S.P.Q. (BNA) at 295.

Some reissue claims, however, are broader than the canceled claim in some aspects, but narrower in others. In *Mentor*, for example, the issued claim, which was directed to a condom catheter, recited an adhesive means that was transferred from an outer to an inner surface without turning the condom inside-out. 998 F.2d at 993, 27 U.S.P.Q.2D (BNA) at 1523. The issued claim also recited, *inter alia*, that the condom catheter included a "thin cylindrical sheath member of resilient material rolled outwardly upon itself to form consecutively larger rolls . . . ." One canceled claim recited an adhesive means between the rolls, but did not specify that the adhesive was transferred from the outer to the inner surface without turning the condom inside-out. Another canceled claim recited that **{131 F.3d 1470}** adhesive was transferred from the outer to the inner surface, but did not specify that this operation was done without turning the condom inside-out. The prior art rejections focused on the obviousness of the adhesive means positioned between the rolls and the process of transferring adhesive to the inner surface of the condom.

In making amendments to the claim, the applicant argued that "none of the references relied upon actually showed the *transfer of adhesive* from the outer surface to the inner surface as the sheath is rolled up and then unrolled." *Id.* at 995-96, 27 U.S.P.Q.2D (BNA) at 1524-25 (emphasis in original). The reissue claim eliminated the limitation that adhesive was transferred from the outer to the inner layer, and was, therefore, broader in this aspect. The reissue claim was also narrower than the canceled claim because it recited that the catheter included "a thin, *flexible* cylindrical member of resilient material rolled outwardly upon itself to form a *single roll* . . . ." (Emphasis added). We held that, although the "flexible" and "single roll" limitations made the reissue claim narrower than both the canceled and issued claims, it did not escape the recapture rule because these limitations did not "materially narrow the claim[]." *Id.* at 996-97, 27 U.S.P.Q.2D (BNA) at 1525-26.

Similarly, in *Ball*, the issued claim recited "a plurality of feedlines" and a "substantially cylindrical conductor." 729 F.2d at 1432-33, 221 U.S.P.Q. (BNA) at 291-92. The canceled claim recited "feed means including at least one conductive lead," and a "substantially cylindrical conductor." The prosecution history showed that the patentee added the "plurality of feedlines" limitation in an effort to overcome prior art, but the cylindrical configuration limitation was neither added in an effort to overcome a prior art rejection, nor argued to distinguish the claims from a reference. *Id.* The reissue claim included limitations not present in the canceled claims that related to the feed means element, but allowed for multiple feedlines. On balance, the claim was narrower than the canceled claim with respect to the feed means aspect. The reissue claim also deleted the cylindrical configuration limitation, which made the claim broader with respect to the configuration of the conductor. 729 F.2d at 1437, 221 U.S.P.Q. (BNA) at 295. We allowed the reissue claim because the patentee was not attempting to recapture surrendered subject matter. 729 F.2d at 1438, 221 U.S.P.Q. (BNA) at 296.

In both *Mentor* and *Ball*, the relevance of the prior art rejection to the aspects narrowed in the reissue claim was an important factor in our analysis. From the results and reasoning of those cases, the following principles flow: (1) if the reissue claim is as broad as or broader than the canceled or amended claim in all aspects, the recapture rule bars the claim; (2) if it is narrower in all aspects, the recapture rule does not apply, but other rejections are possible; (3) if the reissue claim is broader in some aspects, but narrower in others, then: (a) if the reissue claim is as broad as or broader in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the

rejection, the recapture rule bars the claim; (b) if the reissue claim is narrower in an aspect germane to prior art rejection, and broader in an aspect unrelated to the rejection, the recapture rule does not bar the claim, but other rejections are possible. *Mentor* is an example of (3)(a); *Ball* is an example of (3)(b).

In our case, reissue claim 49 is both broader and narrower in areas relevant to the prior art rejections. Comparing reissue claim 49 with claim 42 before the May 1988 and June 1987, amendments (see the tables at Appendices A and B), we see that claim 49 is narrower in one area, namely, the brightness is "at least 59 ISO in the final pulp." This narrowing relates to a prior art rejection because, during the prosecution of the '179 patent, Clement added this brightness limitation in an effort to overcome Burns. Our comparison also reveals that reissue claim 49 is broader in that it eliminates the room temperature and specific energy limitations of step (a), and the temperature, specific energy, and pH values of steps (c) and (d). This broadening directly relates to several prior art rejections because, in an effort to overcome Ortner, Clement added to step (a) the limitation that it is carried out "at room temperature," and applies "specific {131 F.3d 1471} mechanical energy lower than 50 KW.H/Ton to form a pumpable slurry . . . ." He argued, moreover, that the latter limitation overcame Burns despite the examiner's contention to the contrary. Clement also added to steps (c) and (d) the temperature and specific energy values in an effort to overcome Ortner, and the "strong" alkaline conditions "having a pH of at least 9" limitation in an effort to overcome Burns. Clement admitted, furthermore, that he added these "very specific process parameters . . . in order to distinguish over the prior art." Claim 49 omits each of these limitations.

On balance, reissue claim 49 is broader than it is narrower in a manner directly pertinent to the subject matter that Clement surrendered throughout the prosecution. Even with the additional limitations, claims 50-52 are also broader than they are narrower in a manner directly pertinent to the subject matter that Clement surrendered during prosecution.

We do not address whether the reissue claims in this case are broader than the canceled claims in a manner directly related to the alleged error supporting reissue because we see no dispositive significance in this inquiry. In *Ball*, we said that the recapture rule does not apply when the reissue claim is broader than the canceled claim in a manner unrelated to the alleged error supporting reissue, but did not address whether the recapture rule would apply if the broadening did relate to the alleged error. 729 F.2d at 1438, 221 U.S.P.Q. (BNA) at 296. We can envision a scenario in which the patentee intentionally fails to enumerate an error so that he may eliminate a limitation that he argued distinguished the claim from a reference or added in an effort to overcome a reference and claim protection under *Ball*. We, therefore, think *Ball* is limited to its facts: the recapture rule does not apply when the broadening not only relates to an aspect of the claim that was never narrowed to overcome prior art, or argued as distinguishing the claim from the prior art, but also is not materially related to the alleged error. Accordingly, *Ball* does not require us to determine whether the broader aspects of the reissue claims are related to the alleged error supporting reissue.

Clement argues that, although claim 49 is broader than the issued claims, it is materially narrower than original claim 1; therefore, the recapture rule should not apply. He relies on the unsupported assumption that, for purposes of the recapture rule, we should compare the scope of the reissue claims with that of only original claim 1 to determine whether or not the reissue claim is broader in a material way. Clement has chosen original claim 1 as the basis for comparison because, in his view, it does not include limitations enumerated by the board as missing from the reissue claims. These limitations are the room temperature limitation in step (a) and the specific values of the specific energy limitations in steps (c) and (d).

Clement's assumption ignores the board's finding that the reissue claims delete the value of the high temperature and pH limitations in steps (c) and (d) and the room temperature limitation of step (b). It also ignores much of the prosecution history. The prosecution history shows that Clement abandoned the subject matter of claim 42, as it existed before the examiner's amendment dated May 16, 1988, because he allowed the examiner to amend it to obtain allowance and no other evidence suggests that Clement did not intend to abandon it. He also abandoned the subject matter of claim 42, as it existed before his June 29, 1987, amendment, as it existed before his December 23, 1986, amendment, and as it existed in his preliminary amendment. Based on his actions and statements in the prosecution history of the '179 patent and his admission in the history of the '012 application, every time Clement amended his claims, he intentionally omitted or abandoned the claimed subject matter. Furthermore, his argument that we should compare reissue claim 49 with original claim 1 is reminiscent of the patentee's unsuccessful argument in *Byers*. There, the patentee argued that the reissue claims were "intermediate in scope between certain broad claims which were canceled from

[the patentee's] original application and the limited claim allowed in the patent." 230 F.2d at 457, 109 U.S.P.Q. (BNA) at 57. In response, the court {131 F.3d 1472} noted that the "rejection is not based on the cancellation of the broader claims referred to in [the patentee's] brief . . . . The fact that there were other claims whose cancellation did not constitute such a bar is immaterial." *Id.*

We agree with the board's conclusion that the reissue claims are broader than the patent claims in a manner directly pertinent to the subject matter that Clement surrendered during prosecution. Therefore, it correctly applied the recapture rule, and we affirm the board's decision to sustain the examiner's rejection of claims 49-52.

Because we affirm the board's decision on recapture, Clement cannot cure the allegedly defective declaration with respect to claims 49-52. As a result, we do not reach that issue. Because claims 1-18 are not subject to the recapture rule, however, a defective declaration would not, in and of itself, invalidate them. The Commissioner concedes this point and reminds that, because under 35 U.S.C. § 252 (1994) the surrender of the '179 patent does not take effect until the reissue patent issues, "original claims 1-18 continue to exist with their normal presumption of validity," unaffected by the examiner's rejection based on the allegedly defective declaration. We, therefore, vacate the board's decision to the extent that it rejects claims 1-18 because of the allegedly defective declaration.

Claims 1-18 alone cannot support a reissue application. See *In re Keil*, 808 F.2d 830, 830, 1 U.S.P.Q.2D (BNA) 1427, 1428 (Fed. Cir. 1987) (Section 251 requires a change in "either the patent specification or claims."); *In re Dien*, 680 F.2d 151, 152 n.4, 214 U.S.P.Q. (BNA) 10, 12 n.4 (CCPA 1982) ("It goes without saying that reissue of a patent in identical form with the original patent is not a possibility."). The '951 application would fail, therefore, to comply with section 251 even if Clement were to cure the allegedly defective declaration.

#### *Conclusion*

Accordingly, the decision of the Board of Patent Appeals and Interferences sustaining the rejection of claims 49-52, and to reject the reissue application is affirmed, and its decision to reject original claims 1-18 is vacated.

#### **COSTS**

Each party shall bear its own costs.

**AFFIRMED IN PART AND VACATED IN PART**

#### *APPENDIX A*

**{131 F.3d 1473}**

#### **Claim 42**

**Before Clement's Amendment on 6/29/87 Claim 42**

#### **Before Examiner's Amendment on 5/16/88**

A method of treating a mixture of printed and contaminated waste paper in order to produce pulps for use in the manufacture of paper and paperboards, which method comprises: A method of treating a mixture of printed and contaminated waste paper in order to produce pulps for use in the manufacture of paper and paperboards, which method comprises:(a) forming an aqueous fibrous suspension of said waste paper at room temperature without deinking agents by applying specific mechanical energy lower than [sic] 50 KW.H/Ton to form a pumpable slurry and to release the non-ink contaminants, from the surface of the paper fibers in the absence of deinking agents and without dispersing such non-ink contaminants as finely divided particles throughout the fibrous suspension;(a) forming a first aqueous fibrous suspension of said waste paper at room temperature by applying specific mechanical energy lower than [sic] 50 KW.H/Ton to form a pumpable slurry and to release the non-ink contaminants, from the surface of the paper and without dispersing such non-ink contaminants as finely divided particles throughout the fibrous suspension;(b) removing the released non-ink contaminants from the fibrous suspension by screening and cleaning;(b) removing the non-ink contaminants which have been released without dispersal as finely divided particles from the first fibrous suspension by screening and cleaning to form a second aqueous fibrous suspension substantially free of non-ink contaminants;(c) softening the ink vehicles and weakening their binding with the surface of the fibers by submitting the fibrous suspension at a consistency of more than 15% to the simultaneous actions of (A) a

high temperature between 85 degrees and 130 degrees C, (B) high shear forces substantially corresponding to a specific mechanical energy of more than 50 KW.H/Ton applied at the said consistency of more than 15% and (C) at least one deinking agent under strong alkaline conditions having a pH preferably greater than 9;(c) after the step of removing the non-ink contaminants softening the ink vehicles and weakening their binding with the surface of the fibers by submitting the second fibrous suspension at a consistency of more than 15% to the simultaneous actions of (A) a high temperature between 85 degrees and 130 degrees C, (B) high shear forces substantially corresponding to a specific mechanical energy of more than 50 KW.H/Ton applied at the said consistency of more than 15% and (C) at least one deinking agent under strong alkaline conditions having a pH of at least 9; and(d) detaching the ink particles from the surface of the fibers and dispersing them into the fibrous suspension by submitting the fibrous suspension to the simultaneous actions of (A) high temperature between 85 degrees and 130 degrees C, (B) high shear forces substantially corresponding to a specific mechanical energy of more than 50 KW.H/Ton applied at the said consistency of more than 15% and (C) at least one chemical dispersing agent, under strong alkaline conditions having a pH preferably greater than 9;(d) detaching the ink particles from the surface of the fibers and dispersing them into the second fibrous suspension by submitting the second fibrous suspension to the simultaneous actions of (A) high temperature between 85 degrees and 130 degrees C, (B) high shear forces substantially corresponding to a specific mechanical energy of more than 50 KW.H/Ton applied at the said consistency of more than 15% and (C) at least one chemical dispersing agent, under strong alkaline conditions having a pH of at least 9 whereby higher specific energy inputs and higher temperatures are used to detach the ink particles from the fibers of the second fibrous suspension after removal of the non-ink contaminants than are used on the first fibrous suspension before removal of the non-ink contaminants;(e) limiting the total duration of the ink softening and detaching steps (c) and (d) to a range between 2 and 10 minutes and(e) limiting the total duration of the ink softening and detaching steps (c) and (d) to a range between 2 and 10 minutes and(f) removing the detached ink particles from the fibrous suspension to provide the degree of brightness required in the final product of the pulp.(f) removing the detached ink particles from the second fibrous suspension to provide the degree of brightness required in the final product of the pulp.

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#### **APPENDIX B**

**Patent Claim 1 Reissue Claim 49A** method of treating a mixture of printed and contaminated waste paper in order to produce a pulp for use in the manufacture of paper and paperboards, said waste paper containing non-ink contaminants including stickies, which method comprises: A method of treating a mixture of printed and contaminated waste paper in order to produce a pulp for use in the manufacture of paper and paperboards, said waste paper containing non-ink contaminants including stickies, which method comprises:(a) forming a first aqueous fibrous suspension of said waste paper *at room temperature {131 F.3d 1474}* by applying *specific mechanical energy lower than [sic] 50 KW.H/Ton* to form a pumpable slurry and to release substantially all of the non-ink contaminants including the stickies, from the surface of the paper and without dispersing such non-ink contaminants as finely divided particles throughout the fibrous suspension;(a) forming a first aqueous fibrous suspension of said waste paper *at a temperature below the melting point of the non-ink contaminants* by applying *specific mechanical energy sufficient* to form a pumpable slurry and to release substantially all of the non-ink contaminants including the stickies, from the surface of the paper and without dispersing such non-ink contaminants as finely divided particles throughout the fibrous suspension;(b) removing substantially all of the non-ink contaminants including the stickies, which have been released without dispersal as finely divided particles from the first fibrous suspension by screening and cleaning *at room temperature* to form a second aqueous fibrous suspension substantially free of the non-ink contaminants including the stickies;(b) removing substantially all of the non-ink contaminants including the stickies, which have been released without dispersal as finely divided particles from the first fibrous suspension by screening and cleaning to form a second aqueous fibrous suspension substantially free of the non-ink contaminants including the stickies;(c) after the step of removing the non-ink contaminants softening the ink vehicles and weakening their binding with the surface of the fibers by submitting the second fibrous suspension at a consistency of more than 15% to the simultaneous actions of (A) *a high temperature between 85 degrees and 130 degrees C., (B) high shear forces substantially corresponding to a specific mechanical energy of more than 50 KW.H/Ton* applied at the said consistency of more than 15%

and (C) *at least one deinking agent under strong alkaline conditions having a pH of at least 9*; and (c) after the step of removing the non-ink contaminants, (1) softening the ink vehicles and weakening their binding with the surface of the fibers, and then (2) detaching the ink particles from the surface of the fibers and dispersing the particles into the second fibrous suspension by submitting the second fibrous suspension at a consistency of more than 15% to the simultaneous actions of temperature, pressure, specific energy and chemical dosing sufficient to insure softening of the ink vehicles, (d) detaching the ink particles from the surface of the fibers and dispersing them into the second fibrous suspension by submitting the second fibrous suspension to the simultaneous actions of (A) *high temperature between 85 degrees and 130 degrees C.*, (B) *high shear forces substantially corresponding to a specific mechanical energy of more than 50 KW.H/Ton* applied at the said consistency of more than [sic] 15% and (C) *at least one chemical dispersing agent, under strong alkaline conditions having a pH of at least 9* whereby higher specific energy inputs and higher temperatures are used to detach the ink particles from the fibers of the second fibrous suspension after removal of the non-ink contaminants than are used on the first fibrous suspension before removal of the non-ink contaminants; detachment of the ink particles from the surface of the fibers and dispersion of the detached ink particles into the second fibrous suspension, whereby higher specific energy inputs and higher temperatures are used to detach the ink particles from the fibers of the second fibrous suspension after removal of the non-ink contaminants than are used on the first fibrous suspension before removal of the non-ink contaminants; (e) limiting the total duration of the ink softening and detaching steps (c) and (d) to a range between 2 and 10 minutes and (d) limiting the total duration of step (c)(1) and (c)(2) to a range between 2 and 10 minutes and (f) removing the detached ink particles from the second fibrous suspension to provide a brightness of at least 59 ISO [in] the final pulp. (e) removing the detached ink particles from the second fibrous suspension to provide a brightness of at least 59 ISO in the final pulp.

#### Footnotes

##### Footnotes

1 Section 251 allows patentees to correct "errors" made during prosecution, such as claiming less than the patentee had a right to claim. A reissue patent may not, however, enlarge the scope of the claims unless the patentee files the reissue application within two years of the grant of the patent.

2 For example, if an applicant amends a broad claim in an effort to distinguish a reference and obtain allowance, but promptly files a continuation application to continue to traverse the prior art rejections, circumstances would suggest that the applicant did not admit that broader claims were not patentable - assuming that the applicant does not ultimately abandon the continuation application because the examiner refuses to withdraw the rejections.=K

**IN RE GEORGE J. HANDEL, JR.**  
**50 C.C.P.A. 918; 312 F.2d 943; 1963 CCPA LEXIS 407; 136 U.S.P.Q. (BNA) 460**  
**No. 6902**  
**Oral argument January 7, 1963**  
**February 13, 1963**  
**United States Court of Customs and Patent Appeals**

**Disposition**

Reversed.

**Counsel**

*Roger L. Hansel, Stevens, Davies, Miller & Mosher, William Hintze*  
*(Truman S. Safford and Marshall M. Holcombe, of counsel) for appellant.*  
*Clarence W. Moore (Raymond E. Martin, of counsel) for the*  
Commissioner of Patents.

**Editorial Information: Prior History**

APPEAL from Patent Office, Serial No. 755,830

**Opinion**

**Opinion by:** RICH

**{312 F.2d 944}**

**{50 C.C.P.A. 919}** Before WORLEY, Chief Judge, and RICH, MARTIN, SMITH, and ALMOND, JR., Associate Judges

RICH, Judge, delivered the opinion of the court:

This appeal is from the decision of the Patent Office Board of Appeals affirming the rejection of claims 4-6 of appellant's application Ser. No. 755,830, filed August 1, 1958, for reissue of his patent No. 2,705,797, granted April 12, 1955, for "Terminal Applicator Construction."

The sole issue in the case is whether the appealed claims are "for the invention disclosed in the original patent," as required by 35 U.S.C. 251, the statute governing the granting of reissues. The Patent Office held they are not and appellant argues to the contrary.

The invention disclosed in the original patent<sup>1(1)</sup> is a machine for applying electrical terminals to pieces of wire, the terminals being fed by the machine from a reel to the point of application in **{312 F.2d 945}** continuous strips from which they are severed, as applied, one at a time.

The need appellant sought to fill by his invention was for a machine capable of being variously set up to apply automatically "a considerable variety of electrical terminals or connectors." To this end, the machine, which is in the nature of a stamping press, is arranged to employ a variety of sets of matched crimping and shearing dies suited for use with the different terminals or connectors; and the feeding mechanism, which advances the strips of terminals or connectors one unit at a time, is made adjustable. Two of the more significant objects of the invention stated in the application read as follows:

Another object is the provision in a press of a practicable apparatus for applying terminals in which any one of several terminal feeding relationships may be **{50 C.C.P.A. 920}** selected and with which any one of several terminal applying assemblies may be combined all as a matter of mere routine.\* \* \*



A still further object resides in the provision of a feeding assembly wherein the length of feed may readily and accurately be adjusted.[Emphasis ours.]

It is not questioned that the specifications and drawings fully describe a machine which carries out these objects.

#### The Claims

The Patent Office admits that appealed claims 4, 5, and 6 incorporate entirely (with the exception of changing the word "mechanism" to "machine") the language of original patent claims 1, 2, and 3 and differ therefrom in subject matter only in that each of the appealed claims adds one or two elements to the patent claim on which it is based. We quote as acceptable the solicitor's explanation:

Claim 4 adds to claim 1 a storing means (the reel) and a means for sequentially feeding the connector strip, the latter having an adjustable stroke. Claim 5 is similar in scope to claim 4, except that it omits the storing means of the latter claim. Claim 6 likewise omits that storing means, but specifies that the feeding means or mechanism has "a plurality of settings corresponding to different feed strokes required by the different size and shape strip connectors."

The solicitor also states, and we agree, that the issue before us is the same as to all claims, notwithstanding their slight differences.

#### The Rejection

There is some confusion as to the rejection before us.

The examiner rejected the claims on two grounds: (1) "that they are drawn to the old combination of a fastener applicator and feed means," citing two references to show the combination; (2) "that the original patent was not partially inoperative and defective by reason of applicant's claiming less than he had a right to claim in his patent."<sup>2(2)</sup> {312 F.2d 946}

{50 C.C.P.A. 921} The board reversed ground (1), saying, "we shall not sustain the rejection of claims 4, 5, and 6 on the ground that the recited combination is disclosed by either of the\* \* \* references." That rejection is, therefore, clearly out of the case.

As to ground (2) it is necessary to recite some added facts<sup>3(3)</sup> before the statements of the board can be understood. It appears that at some time during the prosecution of the application for the original patent the examiner required "division" (restriction) as between claims to "1. Combination of applicator and feed; 2. Subcombination of applicator." The examiner says the applicant elected to prosecute claims to the subcombination, which resulted in the allowance of the three claims of the patent and in the issuance of the patent. In his Answer, in connection with his second ground of rejection, the examiner said:

The claims appealed herein are drawn to the same combination as the nonelected claims of the original application. The claims set forth the combination of a connector applicator and a feed mechanism. The present claims emphasize a different detail ["feature," the board called it] of the feed mechanism than those of the combination claims of the original application, however, that does not change the basic combination.\* \* \*

Therefore, it is not seen that the patent is defective and partially inoperative by reason of applicant claiming less [sic] than he had a right to claim.

It will thus be seen that underlying the examiner's refusal of the claims was his requirement for restriction and the applicant's election in the original application, including cancellation of nonelected claims. The board stated its understanding of the examiner's position as follows:

He has taken the position that appellant may not obtain claims by reissue that could have been obtained in a divisional application properly filed in response to the requirement for division in the original application.

{50 C.C.P.A. 922} The board then pointed out that appellant's argument was that since the appealed

claims and the nonelected claims were to distinctly different combinations he was not estopped to present the instant claims in a reissue application.

Against this background, we now quote the board's ruling on the examiner's second ground of rejection:

It is established that an applicant is estopped from obtaining in a reissue application a claim which because of a requirement for division, with which he acquiesced, was not allowable in his original application. [Cases cited.] However, since the {312 F.2d 947} instant claims recite a different character of connector feed mechanism from that recited in the claims cancelled in the original application, we do not regard the requirement for division and cancellation of nonelected claims in the original application as constituting an estoppel with respect to the appealed claims. [Emphasis ours.]

In view of this statement, as well as other discussion of the matter in the board's opinion, we cannot conclude otherwise than that the board rejected the entire rationale of the examiner's second rejection, which was predicated on the requirement for restriction and appellant's acceptance thereof.

The board nevertheless sustained the examiner's rejection of claims 4, 5, and 6, but on a basis never suggested by the examiner, and one which we regard, on the whole, as contrary to law. It said (emphasis ours):

Nevertheless, it is fundamental that a reissue must pertain to the same invention as that recited in the claims of the patent. *Parker & Whipple Company v. Yale Clock Company* 123 US 87; 41 OG 811; 1887 CD 584. The claims of the patent recite a "connector applicator mechanism" for applying connectors to wires by means of severing and crimping die assemblies and do not comprehend any means for feeding the connectors to the mechanism. The appealed claims recite a "connector applicator machine" and include, in addition to the aforementioned connector applicator mechanism, a mechanism for feeding connectors to said applicator mechanism. Consequently, by the introduction of an additional element the appealed claims are not directed to the same invention recited in the claims of the patent. Furthermore, we find in the patent no clear evidence of an intention to claim the particular subject matter of the appealed claims. Accordingly, we are of the opinion that the appealed claims are not merely a restatement of the invention claimed in the patent in narrower form but are a recitation of a different invention.

On request for reconsideration the board clearly reaffirmed its position saying that its decision had been that the appealed claims are directed to "a different invention from that recited in the claims of the patent sought to be reissued." (Emphasis ours.) It also reaffirmed its finding of no intent to claim the subject matter of the appealed claims but amplified its position by stating that this finding was {50 C.C.P.A. 923} based on an examination of the claims presented for prosecution in the application for the issued patent.<sup>4(4)</sup>

On the basis of the foregoing holdings in the tribunals below, we arrive at the following conclusions as to the rejection which is before us. The board clearly reversed ground (1) based on old combination. The board effectively reversed ground (2) by entirely disagreeing with the only reasoning used by the examiner to support it. The board said, however, that it was "not convinced of any fundamental error in the Examiner's position," which we can take in this context as meaning no more than that he was right in rejecting the claims. But the board substituted for the examiner's reasoning an entirely different statutory basis of its own for holding that appellant could not have claims 4, 5, and 6 in a reissue.

The examiner's reason was that appellant had not shown that he had claimed {312 F.2d 948} less than he had a right to claim in the original patent, a reason based on section 251 (see fn. 2, supra) coupled with an estoppel due to cancellation of nonelected claims. It appears clearly to us that the board substituted for the examiner's reasons for saying appellant had not brought himself within section 251, which reasons its rejected, entirely new reasons of its own, which were two: First, that the patent claims and the reissue claims are not for the same invention, on the basis of a comparison of both sets of claims alone; second, that looking to the patent as a whole a clear intention to claim the subject matter of the appealed claims does not appear.

We stated at the beginning of this opinion that the issue before us is whether the claims are for the invention disclosed in the patent. We say this notwithstanding the Patent Office Solicitor's opening statement in his brief that the appeal is from a decision affirming a rejection on the ground that appellant has not shown that he claimed less than he had a right to claim in his patent. Only in a very technical sense is the solicitor correct, because the examiner made such a rejection and the board held it not to be "fundamentally" in error and affirmed it. But in reality the board affirmed it only by reversing all the underlying reasoning of the examiner and substituting its own, relying on the same section of the statute but not on the same clause. The examiner's rejection was left an empty shell notwithstanding the affirmance.

{50 C.C.P.A. 924} [4] It seems to us that our function is to pass only on such grounds of rejection as have not been reversed by the highest tribunal of the Patent Office. In the instant case that means that the only grounds before us are the final reasons given by the board for refusing the appealed claims. We believe the issue to be as we have stated it.

#### Our Opinion

[5] The board erred in applying the wrong test to determine whether appellant's claims are for "the invention disclosed in the original patent," which is the only provision of section 251 relied on by the Patent Office. In looking only to the claims of the patent it disregarded the express command of the statute, which is to look at the disclosure. The cases relied on by the board, *U.S. Industrial Chemicals, Inc. v. Carbide & Carbon Chemicals Corporation*, 315 U.S. 668, 53 USPQ 6, and *Parker and Whipple Company v. Yale Clock Company*, 123 U.S. 87, 1887 C.D. 584, do not support its position. Although these cases were prior to the enactment of the Patent Act of 1952, which changed the words of the prior law, "for the same invention," to the words above quoted, even they stand for the proposition that the entire disclosure of the original patent is to be considered in determining what the patentee intended to claim and what invention the patent discloses.

[6] We are constrained to agree with appellant that if the board's view were to prevail, the reissue statute would be of very little practical effect, for, by elementary principles of claim interpretation, whenever an element or other limitation is added to or taken from a claim it becomes a claim to a different invention. Yet the whole purpose of the statute, so far as claims are concerned, is to permit limitations to be added to claims that are too broad or to be taken from claims that are too narrow. That is what the statute means in referring to "claiming more or less than he had a right to claim."

The decisions of this court, both before and after the effective date of the 1952 act, are also to the effect, as stated in *In re DeJarlais*, 43 CCPA 900(5), 904(6), 233 F.2d 323(7), 110 USPQ 36(8), that "It is also well settled that the same invention means whatever invention was described in the original patent, and which appears to have been intended to be secured thereby." See *In re Mayo*, 29 CCPA 1192, 129 F.2d 700, 54 USPQ 322, and *In re Murray, Jr.*, 20 CCPA 1046, 64 F.2d 788, 17 USPQ 365. {312 F.2d 949} In the District Court for the District of Columbia the same rule was applied in *Kinnear v. Marzall*, 85 F.Supp. 55, 88 USPQ 524. The Patent Office Solicitor admits that in these cases the courts found it sufficient to examine the specifications and claims {50 C.C.P.A. 925} but urges us, over several pages of brief, to "give due weight to the 'division aspect' of the prosecution history of the patented application\* \* \*." By this he apparently means the following, with which he concludes his brief:

Appellant showed a clear intent not to secure the invention directed to the claimed combination by canceling claims directed thereto in the patented application. In effect, he conceded away the right to claim the combination in that application. Since such right is a basic requirement of section 251, it is submitted that there is no legal basis for granting a reissue of the original patent.

Since the Patent Office has not seen fit to include in the record a single one of the allegedly cancelled claims we do not see how we could, even if we would, determine what appellant may have "conceded away." But this is of no moment inasmuch as the board disposed of this point and put it beyond our reach in its opinion on request for reconsideration, wherein it said:

We further pointed out in our decision that we found no claim presented during the prosecution of [the] patent application directed to a connector applicator machine of the character recited in the appealed claims and consequently found no clear evidence of appellant's intention to therein claim the subject matter of the herein appealed claims. [Emphasis ours.]

It would appear, therefore, that appellant has been adjudged by the board never to have made a claim to the subject matter of the appealed claims or of that character. Consequently he never cancelled such a claim. It follows that the solicitor's argument is directly contradicted by the finding of the board, based, moreover, on information to which we have no access.

As for the board's holding on intent, we find it to be contrary to the clear indication of the specification of the original patent, which the board failed to take into consideration, particularly the statement of objects quoted early in this opinion. They clearly point to the subject matter of the appealed claims as part of appellant's invention, especially when read with the detailed description of the machine and its mode of operation. Since we find this to be sufficient to sustain appellant's right to claim the subject matter of the appealed claims, we find it unnecessary to consider his other arguments based on the claims of his original patent.

The decision of the board is reversed.

### Footnotes

#### Footnotes for Opinion

1 The patent is not included in the record. The Patent Office Solicitor's brief admits, however, that the specifications of the patent and of the application are identical. We presume this admission includes the drawings. There were 3 original patent claims which are allowed claims in this reissue application, viz., claims 1, 2, and 3, the same numbers they have in the patent.

2 The reference here is obviously to the opening clauses of 35 U.S.C. 251, the first paragraph of which reads as follows:

"Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Commissioner shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue."

Quoting from McCrady, Patent Office Practice, 4th Ed., 1959, p. 309, "The term 'inoperative' has been construed to mean inoperative adequately to protect the invention, which may be due to failure of the solicitor to understand the invention\* \* \*." There is no issue of new matter in this case. At oral argument the solicitor admitted that the reissue claims on appeal are narrower than the claims of the original patent. Hence, the defect of the original claims would seem to be that they claimed more, not less, as the examiner said, than the applicant had a right to claim.

[1] The examiner's error seems to be traceable to the reissue oath. While in its the oath makes it perfectly clear that appellant's purpose was to narrow his claims (at least claims 4, 5, and 6) to avoid the possibility of their being invalid in view of an alleged prior public use, he too asserted that his patent was partly inoperative "by reason of his claiming less than he had a right to claim in his patent." The term "less" appears to have been used in the sense of fewer claims than he could properly have made, rather than in the statutory sense of subject matter included within the claims. Since the patent claims have been retained, neither more nor less is being claimed. The narrower appealed claims are simply a hedge against possible invalidity of the original claims should the prior use be proved, which is a proper reason for asking that a reissue be granted.

3 [2] These facts are assumed on the basis that the examiner stated them in his Answer and the

appellant has not denied them. However, we have nothing in the record before us on the basis of which we can see these facts for ourselves since they appear only from the record of the prosecution of the application resulting in the issuance of the patent, no part of such record having been included in the record on appeal.

4 [3] It is difficult to understand how the board could have expected to find, for the purpose of supporting a reissue, an intent to claim in claims presented in but cancelled from the patent application in view of a long line of reissue cases holding that deliberate cancellation of claims in the original application to obtain issuance, is not inadvertence (error) and therefore bars the grant of similar claims in the reissue, even though the claims were cancelled merely in response to a requirement for division. See McCrady, op. cit. fn. 2, p. 311-312.

**In Re Kozaburo Harita, Kukiyooshi Ajisawa, Kinji Iizuke, Yukihiro Kinoshita, Tetsuhide Kamijo, and  
Michihiro Kobayashi**  
**847 F.2d 801; 1988 U.S. App. LEXIS 6815; 6 U.S.P.Q.2D (BNA) 1930**  
**No. 87-1273**  
**May 24, 1988, Decided**  
**UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT**  
**Rich and Davis, Circuit Judges, and Nichols, Senior Circuit Judge. Davis, Circuit Judge,**  
**dissenting.**

**Counsel** for Appellant. George A. Depaoli, Depaoli & O'Brien, P.C., of Arlington, Virginia, argued  
Albin F. Drost, Assistant Solicitor, Office of the Solicitor, of  
Arlington, Virginia, argued for Appellee. With him on the brief were Joseph F. Nakamura,  
Solicitor and Fred E. McKelvey, Deputy Solicitor.

**Editorial Information: Prior History**

Appealed from: U.S. Patent and Trademark Office Board of Patent Appeals and Interferences.

**Opinion**

**Opinion by:** RICH

**{847 F.2d 802}** RICH, Circuit Judge.

This appeal is from the decision of the United States Patent and Trademark Office (PTO) Board of Patent Appeals and Interferences (board), 1 USPQ2d 1887, affirming the final rejection by the Special Program Examiner of claims 8-10 of Harita et al. application for reissue, serial No. 802,486, filed June 1, 1977. We reverse.

This reissue application, filed pursuant to 35 U.S.C. § 251, has as its primary purpose the correction of error in applicants' issued patent No. 3,940,422 ('422 patent) granted February 24, 1976, in that the patent contains claims which read on prior art which came to the attention of the applicants after they filed their application for said patent on January 17, 1974, but before the patent issued. Some of the prior art surfaced as a result of an action dated January 28, 1975, of the French patent office on a counterpart application and became known to applicants in February 1975, resulting in further searching which disclosed the rest of the prior art here involved.

Because the prior art, the materiality of which is unquestioned, was not disclosed to the PTO until the filing of this reissue application, an issue has been raised of "inequitable conduct" in connection with the prosecution of the application for the original patent. This reissue application was examined in the usual way in Group Art Unit 126 on its merits to the point where, on June 18, 1979, applicants were notified that claims 8-10 were in condition for allowance. On July 30, 1979, they were further notified that the sending of that notice was an inadvertence and that the claims (though found to be patentable over the prior art) were being reconsidered in the Office of the Assistant Commissioner for Patents. It is in his office that the "Special Program Examiner" is to be found and his function is to consider issues of violation of the duty of disclosure to the PTO as prescribed in 37 CFR 1.56, among other things. On June 19, 1984, he issued a final rejection of claims 8-10

based upon the violation by applicants' Japanese attorney, Akira Agata, of the **{847 F.2d 803}** duty of disclosure through bad faith (fraudulent intent) or gross negligence (gross and reckless misconduct) in connection with application Serial No. 434,252 [for the patent sought to be reissued], an application upon which the instant application [for reissue] relies.

From that rejection applicants appealed to the board, the board affirmed, and this appeal followed.

On the appeal to the board, the same Special Program Examiner, by way of a brief to the board stating the PTO position, filed an extensive Examiner's Answer. As may be observed from the published board opinion, the board wrote less than a single printed page in the course of which it said: "we shall adopt the examiner's position as our own" and "we emphasize our complete agreement with the examiner's position." It then attached as an appendix to its short opinion the full Examiner's Answer of some six printed pages. The position stated in that document from the Office of the Assistant Commissioner for Patents is therefore virtually what is on appeal here and is a full statement of the PTO's position.

## BACKGROUND

### *The Cast*

Kissei Pharmaceutical Co., Ltd., is the real party in interest. It is a Japanese corporation located in Japan not very active in the patent field. It filed its first patent application before 1970 and the 1974 application for the patent here involved was only the second it had filed and the first Kissei had ever filed in the United States. Mr. Maruyama, its Head of the Development Department 1968-79 and thereafter Head of the Research & Development Department, has been its spokesman in this case.

Mr. Harita and five other employees of Kissei are the named inventors in the patent and reissue application here involved. Harita's title 1971-76 was Head of the Chemical Research Division of the Development Department. He retired from the company in 1976 and went to work for the patent firm of Mizushima & Aoyama in Osaka, Japan.

Mr. Agata, already mentioned above, was the Japanese patent attorney or agent employed by Kissei to file the applications for patent here involved and had his office in Tokyo. For 12 years he had been an examiner and judge in the Japanese Patent Office, opening his own office in 1968.

Mr. Ajisawa was the second-named inventor on the patent application and was used by Kissei and Harita as their representative in dealings with Agata who, in turn, used him as his contact with his corporate client. The other four inventors play no roles in the events herein.

Mr. Daniel, a U.S. patent lawyer in Arlington, Virginia, was selected by Agata to file the U.S. application which resulted in the patent. However, in filing the reissue application, present counsel, Depaoli & O'Brien, P.C., also of Arlington, were employed, Mr. Depaoli arguing this appeal.

### *The Events*

Mr. Agata, having filed a Japanese application for Kissei on January 18, 1973, prepared and sent an English language version to Daniel to be filed within the convention year. It was properly executed by the inventors and on letter-size paper. Daniel, believing he should put it on legal-size paper, made some minor alterations in the language -- "cosmetic and stylistic editing" he called it -- had it retyped on legal-size paper and filed it in the PTO on January 17, 1974, the day before the end of the convention year, claiming "priority" on the basis of the Japanese filing date.

The record shows that the U.S. application, handled throughout by Daniel, had a normal and uncomplicated progress through the PTO with a first action citing some references which were overcome by argument, an amendment adding two method of use claims to the original seven product claims, a final rejection dropping the art rejection, some minor claim amendments to overcome non-reference rejections, and a restriction requirement as to the new claims. The application was allowed and the patent issued February 24, **{847 F.2d 804}** 1976, about 25 months after the application was filed. Daniel knew of no reason why it should not be issued. He was not told of the new prior art which had become known to Kissei.

Daniel, in reporting to Agata on his response to the first Office action, explained his reasons for adding the method of use claims. The application describes and claims a group of compounds useful for treating asthma, hay fever, etc., and he had noted that methods of treating these allergies were disclosed. He thought it would be advantageous to Kissei to claim the method and gave Agata a lengthy explanation a part of which the PTO uses to support its claim of inequitable conduct on which it rests its rejection. That part is quoted below, being preceded by an explanation that restriction would probably be required and that a divisional application would then have to be filed on the method, a prediction which materialized. The date of this letter is 11 October 1974 and it is Exhibit 11 attached to an Agata declaration.

There are conceivable reasons favoring the filing of a method divisional case. First, since the

prosecution of such a case will take some time, any patent issuing thereon will expire several years later than any patent issuing on the present application and thus give the applicants a longer monopoly period. More importantly, if some one [sic] should uncover a disclosure any where [sic] in the technical literature of any compound within the scope of the present claims, *such claims would be invalidated*. Even though the Examiner has so far brought to light no truly pertinent prior art, the Examiner's search cannot be considered absolutely complete and the possibility of some species of the present generic claims being known seems to me to be within the realm of possibility. The discovery of the present medical utility for the class of compounds would be considered a patentable invention even if the compounds themselves were old as such (assuming, of course, they had never been used for analogous medical utility). Hence, *a patent directed to the medical use method would not be invalidated by prior art teaching a species of the genus of compounds in question*. In order to lay an effective procedural basis for filing a new divisional case if your client decided this is desirable, I have included simple method [of] use claims now. [Emphasis ours.]

The foregoing is extracted from a three-page letter dealing also with other matters. Daniel had written along similar lines on January 29, 1974, after he filed the application. Daniel dealt exclusively with Agata and had no contact with Kissei or the inventors.

Agata meanwhile had filed and was in charge of applications corresponding to the U.S. and Japanese applications in twenty other countries. February 10, 1975, he received notice of an action by the French patent office citing a reference, Chemical Abstracts, Vol. 71 (1969) No. 3354V, disclosing compounds within the scope of the claims of the U.S. application which he reported to Kissei. This caused Kissei to search further in Chemical Abstracts and other prior art was found on which the claims read.

Inventor Ajisawa thereupon advised attorney Agata about this additional prior art and its significance with respect to the invention, asking Agata whether it was necessary to call the art to the attention of the U.S. PTO. Agata advised Ajisawa that it was not necessary, about which more will be said later.

Since Daniel dealt only with Agata, Kissei and all of the inventors had no contact with Daniel and, furthermore, had no prior experience with United States PTO practice nor any knowledge thereof. Ajisawa reported Agata's advice to his employer and no further action was taken on the U.S. application from Japan, it took its normal course, and the patent issued some eleven months later on February 24, 1976. All of the claims in the patent were, unfortunately, invalid for overclaiming because of a want of awareness by the examiner and by Daniel of the closest prior art, which is not a rare occurrence in the annals of patent {847 F.2d 805} law. That is one reason we have a reissue statute.

The next event, however, is certainly rare. Harita, after the issuance of the U.S. patent, retired from Kissei and obtained employment in the office of a Japanese patent attorney, Mr. Aoyama. There he began to familiarize himself with the regulations of the U.S. PTO and realized that the newly found prior art should have been disclosed to the PTO -- that Agata's advice had been wrong. He informed Kissei and steps were taken to file the application for reissue now before us through new U.S. attorneys. The reason or motive for their selection is not disclosed in the record, nor do we attach significance to it.

The grounds for reissue were the classic ones that the patent is "inoperative," within the meaning of 35 U.S.C. § 251, to protect the invention "by reason of the patentee claiming more . . . than he had a right to claim in the patent." The reissue application was filed with reasonable promptness under all the circumstances, about fifteen months after the patent issued, with no other motivation than the discovery that the patent was defective in that its claims were too broad and read on prior art.

The declaration accompanying the reissue application recites all of the prior art that should have been called to the examiner's attention, the application has been examined in the light thereof on its merits and, as indicated above, the claims have been found to be patentable over the prior art. Except for the "inequitable conduct" rejection by the Special Program Examiner, the reissue application is in condition for allowance. We will now summarize the events occurring during his prolonged review of the reissue application.

The application having been transferred to the Office of the Assistant Commissioner for Patents on or about July 30, 1979, to be "reconsidered under the provisions of M.P.E.P. 721.01" (now replaced), a first "Requirement for Information" was issued on April 1, 1980. This 9-page single-spaced document



submits to "All applicants" 14 questions; to the assignee 6 questions; to Japanese Counsel 8 questions; and to U.S. Counsel 5 questions. Two months were allowed for response. With a time extension, responses were filed July 29, 1980.

July 2, 1981, nearly a year later, a second Requirement for Information issued (8 pages) suggesting Agata had "deviated from normal practice in not seeking advice from U.S. counsel and that more information was needed to "determine the seriousness of this deviation." It also suggested that Mr. Daniel's answers had raised the additional issue of alteration of the specification by him after execution and serious misconduct on his part. Agata was asked 6 questions, Daniel 9 questions. Responses were filed November 2, 1981.

June 2, 1982, seven months later, a third Requirement for Information (7 pages) issued: 8 questions for Agata; 7 main questions with numerous subquestions for "Each of The Inventors and Akio Maruzama as Assignee" (which he was not) and for Mr. Ajisawa, about 12 in all, including inquiries into relations between Kissei and a U.S. corporation with relation to the patent and asking for all correspondence with that corporation touching on the validity of the patent, and 7 questions for Daniel including this one:

7. Did you ever revise, alter, edit and or retype applications previously sworn to, without reexecution, before filing said applications in the Patent and Trademark Office? Include in your explanation the serial number(s) of such case(s).

From the table of contents of the reissue application file wrapper it appears that this extraneous inquiry resulted in proceedings between Mr. Daniel and the PTO which consumed approximately a year and seven months (about which we are uninformed) which came to nothing so far as the application before us is concerned as indicated by the following statement in the Examiner's Answer which is the Appendix to the board opinion under review, 1 USPQ2d at 1888:

The alterations made by Mr. Daniel in the specification and claims of the parent application after execution by the inventors {847 F.2d 806} have been found to have been editorial in nature and not to warrant the striking of this reissue application. [Review of Facts, par. 3.]

(Striking was the only possible action at the time under then existing 37 CFR 1.56. The use of the term "parent application" for the original patent sought to be reissued appears to be a misnomer. There is no continuity between such an application and a reissue application. "Parent" implies copendency. Years may intervene between the issuance of a patent and an application to reissue it. There is never copendency.)

After its nearly four and a half years of investigation of everyone connected with the application for the original patent, including an attempted side investigation of Mr. Daniel on other applications, the Special Program Examiner rejected claims 8-10, found allowable by the art examiner over the prior art, including the new prior art discovered during the prosecution, on the sole ground that Akira Agata, the Japanese attorney, did not disclose the newly discovered art to the PTO *before the patent issued*. The PTO, notwithstanding its long investigation, has made no charge that any other party or attorney involved in this case failed in its duty to the PTO. It predicated the rejection, moreover, on 37 CFR 1.56(d), a rule which was not adopted by the PTO until January 28, 1977, which was nearly a year after the issuance of the patent here sought to be reissued. The language used by the Special Program Examiner in formulating his rejection is taken directly from § 1.56(d)(2) though no such language existed in the PTO Rules as of the time the acts complained of were committed. Since this case turns solely on the conduct of Mr. Agata, we now examine in more detail what the PTO investigation turned up about it.

#### *Agata's Explanations*

By way of background, we first mention what is stated in the reissue application declaration about the discovery of new prior art and what was done next. It explains how in early 1975 Agata gave Ajisawa, one of the inventors, a copy of the French office action citing the Chemical Abstracts item which led to further search at Kissei leading to two other like items. It further explains that at Kissei it was appreciated that this art anticipated claims in the U.S. application, but that none of the inventors or any other employees of Kissei had any familiarity with U.S. PTO practice and had never before filed a U.S. application. Ajisawa therefore asked Agata whether it was necessary to call this new art to the

attention of the PTO and was told by Agata that it was not necessary. Of course, this was bad advice because it was wrong advice, but the question for us, since he alone is charged with "inequitable conduct," is why he gave it and acted in accordance with it himself.

Answering PTO questions, Agata explained how he had been an employee of the Japanese patent office for 12 years and had resigned to take up his own practice in 1968 and, when asked to file U.S. applications, relied on U.S. attorneys' knowledge of U.S. practice and knew only what he had picked up incidentally. He said he had no knowledge of Rule 1.56. Asked why he advised his client it was not necessary to bring the newly found articles to the PTO's attention, he declared:

That he did not recommend citation of the articles to the United States Patent and Trademark Office because in Japanese Patent practice neither inventor(s), assignee(s), nor Patent Attorney(s) have any duty to bring any prior art which is uncovered after filing to the attention of the Japanese Patent Office, so he thought this was also applicable to U.S. Patent practice.

On the second request for information, Agata stated, *inter alia*, that

under the Japanese Patent Law, there is no provision which specifically stipulates that the applicant must bring to the Examiner's attention the prior art which was known before the application of the patent or which will be known after filing the application.

....

According to the Japanese Patent Practice, it is not obligatory to bring the {847 F.2d 807} newly found prior art after filing to the attention of the Japanese Patent Office and he thought that this was also applicable to foreign patent practice.

On the third round of questions, Agata's attention was called to the fact that he had admitted to the filing of a voluntary amendment deleting known compounds from the Japanese application and was asked why he had not done so in the U.S. application. In reply, he pointed out that the Japanese amendment was filed, on his client's instruction, June 29, 1977, which was *after the U.S. reissue application had been filed*. He further explained

That at the time he became aware of prior art disclosing compounds within the scope of the claims of U.S. application 434,252, i.e. about February or March 1975, said United States application was in process of examination by the Examiner and he thought that it was impossible to file a voluntary amendment deleting known compounds and considered that when such prior art was applied to said United States patent application by the Examiner or a third party, an amendment deleting known compounds should be filed in the United States Patent and Trademark Office;

that being what the practice was in Japan, as he also explained in detail. See T. Tenabe & H. Wegner, *Japanese Patent Law*, 58 J. Pat. Off. Soc'y 565, 584 (1976) ("Patent Fraud" in the American sense does not exist in Japan).

#### ISSUE

Was this reissue application properly rejected by the PTO "under 37 CFR 1.56(d)" because of a "violation by applicants' Japanese attorney, Akira Agata, of the duty of disclosure" of anticipatory prior art which became known to him during the prosecution of application Serial No. 434,252 for the patent sought to be reissued, which patent issued February 24, 1976?

#### OPINION

We first wish to make it clear that the decision herein is based on the particular and peculiar facts of this case with no intent whatsoever to create a precedent applicable to different fact situations. See *FMC Corp. v. Manitowoc Co.*, 835 F.2d 1411, 1417 n.12, 5 USPQ2d 1112, 1117 n.12 (Fed. Cir. 1987) *citing In re Ruscetta*, 255 F.2d 687, 689, 118 USPQ 101, 103 (CCPA 1958) (decisions should be construed in accordance with the precise issue before the court).

Secondly, though we are reviewing a rejection not made until June 19, 1984, we note that all of the acts relied on to support it took place much earlier, in the course of the year between February or March of 1975 and the issuance of appellants' patent, No. 3,940,422, on February 24, 1976. In the

intervening dozen years, the applicable rules of law and the practice pertaining to the disclosure of prior art to the PTO have undergone substantial development and change and, indeed, are still doing so. See 35 Pat. Trademark & Copyright J. (BNA) at 320, (Feb. 25, 1988) (proposed substitute for § 1.56). What was once simply called "Fraud on the patent office," at least in its violation of a duty to disclose aspect, now bears the name "inequitable conduct" and is governed by rules first promulgated on January 28, 1977, and amended in 1982, 1983, 1984, and 1985. We therefore deem it essential to consider this case in light of the situation as it existed when the acts deemed to bar this reissue took place. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1551, 220 USPQ 193, 201 (Fed. Cir. 1983) ("we are not at liberty . . . to apply the present standard retroactively"). For a review of the situation in 1976, see Tegtmeyer, *Fraud on the Patent and Trademark Office under Rule 56*, 58 J. Pat. Off. Soc'y 550 (1976). There was then a PTO rule designated 37 CFR 1.56 which was quite different from the present rule of the same number. It read in its entirety:

§ 1.56 Improper applications.

Any application signed or sworn to in blank, or without actual inspection by the applicant, and any application altered or partly filled in after being signed or sworn to, and also any application *fraudulently* filed or in connection with which any *fraud* is practiced or attempted on {847 F.2d 808} the Patent and Trademark Office, may be *stricken* from the files. [Emphasis ours.]

We are not here concerned with the first part of the rule, before the words "and also," dealing with execution and altering applications (though the PTO spent much time on that aspect in pursuing Mr. Daniel), but only with the "fraud" provision.

During the past decade, this simple rule has evolved into the present ten-paragraph provision which occupies nearly two pages of 37 CFR and is now entitled "*§ 1.56 Duty of disclosure; fraud; striking or rejection of applications.*" The PTO mischaracterizes it as a "codification" -- a word of very elastic meaning -- the fact being that it has inaugurated a whole new way of life in the prosecution of patent applications. The rule begins with a recital of "A duty of candor and good faith toward the" PTO which has effectively made applicants, their associates, and attorneys partners with the PTO examining corps in producing for PTO consideration the prior art which is needed to operate a reasonably effective examination system. As a part of this partnership arrangement came the enhanced "duty of disclosure" concept and provisions, violation of which has come to constitute, in the PTO, not "fraud" but "inequitable conduct," the penalty for which is, not "striking" of an application as in the above quoted old rule, but rejection of all claims under 35 U.S.C. § 131 and § 132, which is another innovation. Still another change is that such a rejection has been made appealable to the Board of Appeals and Interferences.

This court has had a seat on the stage during all of this evolution and has frequently been called upon to participate in the action. We are now doing so again.

It has become thoroughly established that inequitable conduct of the violation of duty of disclosure variety must be established by clear and convincing evidence. Indeed, the current Rule 1.56 so specifies in paragraph (d). What must be so established is (1) the "materiality" of the undisclosed, suppressed, or misrepresented prior art or statutory bar and (2) the intent of the person not disclosing to thereby deceive or mislead the PTO. In this case, materiality is not an issue because it is not contested that the Chemical Abstracts items disclosed to the PTO in the reissue application anticipate the original patent claims. We therefore have only intent to consider.

In *FMC Corp. v. Manitowoc Co.*, supra, 835 F.2d at 1415, 5 USPQ2d at 1115, in a careful summation of the subject, this court said:

"Inequitable conduct" is not, or should not be, a magic incantation to be asserted against every patentee. Nor is that allegation established upon a mere showing that art or information having some degree of materiality was not disclosed. To be guilty of inequitable conduct, *one must have intended to act inequitably*. Thus, one who alleges a "failure to disclose" form of inequitable conduct must offer clear and convincing proof of: . . . (3) failure of the applicant to disclose art or information *resulting from an intent to mislead the PTO*. That proof may be rebutted by a showing that: . . . (d) . . . applicant's failure to disclose art or information *did not result from an intent to mislead the PTO*. [Emphasis added.]

While that was said in the context of inter partes litigation on a patent, it applies equally to a dispute between applicants for reissue of a patent and a Special Program Examiner in the office of the Assistant Commissioner for Patents claiming fraud or inequitable conduct. Thus the question here is: Has the PTO established that Mr. Agata had an intent to mislead the PTO?

Upon consideration of all the evidence the PTO has produced as a result of its four and a half years of effort and inquiry, even if we assume a prima facie showing of intent on the part of Mr. Agata, the record as a whole overcomes that inference. Beyond question, there is no evidence of any *misstatement* in the prosecution of the U.S. application. There is no evidence of any deliberate scheming. After knowledge of the new prior art was acquired by Mr. Agata, all the evidence shows is that he communicated nothing to {847 F.2d 809} the U.S. attorney Mr. Daniel. His only sin was silence, and he had his reasons for it. When he finally came to comprehend the true situation respecting U.S. PTO practice, by which time the U.S. patent had issued, steps were taken to file a reissue application for the dual purpose of cancelling the anticipated claims and advising the PTO of the newly-found prior art. We see no inequitable conduct and no valid reason why the reissue should not issue.

This court and its predecessor have repeatedly pointed out that the reissue statute, 35 U.S.C. § 251, is remedial in nature, based on principles of equity and fairness, and should be liberally construed, *In re Weiler*, 790 F.2d 1576, 1579, 229 USPQ 673, 675 (Fed. Cir. 1986), and cases cited. In any given case, the statute should be so applied to the facts that justice will be done both to the patentee and the public, *Slimfold Mfg. Co. v. Kinkead Indus. Inc.*, 810 F.2d 1113, 1116, 1 USPQ2d 1563, 1566 (Fed. Cir. 1987), citing *In re Willingham*, 282 F.2d 353, 354-55, 127 USPQ 211, 214 (CCPA 1960).

The Solicitor's brief devotes only a page to the intent issue and in effect admits there is no direct evidence of intent to mislead, asking us to presume or infer intent from other showings such as Agata's knowledge of the materiality of the new references. He says "subjective good faith does not negate inequitable conduct," citing *Argus Chemical Corp. v. Fibre Glass-Evercoat Co.*, 759 F.2d 10, 14, 225 USPQ 1100, 1103 (Fed. Cir.), *cert. denied*, 474 U.S. 903, 106 S. Ct. 231, 88 L. Ed. 2d 230 (1985). Inequitable conduct, however, is the ultimate legal conclusion based on materiality and intent and we are concerned only with rebuttal of the charge of intent. *Argus* involved very different facts. The U.S. attorney handling the patent application knew of an actual § 102(b) "on sale" time bar and amended original claims which it would invalidate so that they would not read on it, without telling the PTO about the bar, on the tenuous "good faith" theory that only references which fully anticipated the claims had to be disclosed, despite our precedent to the contrary. Thus a threshold intent was established which was sufficient, under the circumstances, to find inequitable conduct. The Solicitor also speaks of "misrepresentations," but, as stated above, none are involved here because there were no representations at all.

In sum, the PTO's case on intent to mislead, as it was in the Examiner's Answer and consequently in the board opinion which adopts it, is that we should infer it from Agata's "gross negligence," whatever that may be taken to mean. Of course, as an *ideal* Japanese patent agent he should have known more about U.S. PTO rules and practice and developing case law, but we deal here with the realities of what actually happened. We think we should not infer merely from some vague thing called "gross negligence" an intent which it was the PTO's obligation to establish and especially that we should not infer it in light of detailed rules of procedure enacted long after the events in this case took place. We therefore hold intent has not been proved. What was said on the subject of inference from gross negligence in *FMC Corp. v. Manitowoc* has a bearing here, 835 F.2d at 1416, 5 USPQ2d at 1116:

An applicant who knew or should have known of the art or information, and of its materiality, is not automatically precluded thereby from an effort to convince the fact finder that the failure to disclose was nonetheless not due to an intent to mislead the PTO; i.e. that, in light of all the circumstances in the case, an inference of intent to mislead is not warranted. No single factor or combination of factors can be said always to *require* an inference to mislead; . . .

The opinion goes on to say the patentee may have a difficult time and that a mere denial of intent will not suffice and then proceeded to sustain the district court's findings of, inter alia, no intent. The district court had *refused* to *infer* intent.

On the whole record, we hold that the PTO's finding of the requisite intent is clearly erroneous and therefore the board's affirmance of the Special Program Examiner's final rejection of claims 8-10 is

reversed.

REVERSED.

## Dissent

Dissent by: DAVIS

{847 F.2d 810} DAVIS, Circuit Judge, dissenting.

I would affirm because, in my view, Mr. Agata was guilty at least of gross negligence and therefore of inequitable conduct toward the Patent and Trademark Office (PTO).

1. The record facts (unchallenged by the majority) show the following: Shortly after the original application was filed with the PTO (in January 1974), Mr. Daniel (the American patent attorney prosecuting the application before the PTO) wrote to Mr. Agata (the Japanese patent agent) two letters, each cautioning that a newly-found (but prior) disclosure of a compound within the scope of the application's claims would invalidate those claims. Such material prior art was disclosed in January 1975 and soon became known to one of the inventors (Ajisawa) who specifically asked Mr. Agata whether it was necessary to call that prior art to the attention of the PTO. Agata advised that it was not necessary to do so. At that time Agata affirmatively considered that prior art as material. The reasons later given by Mr. Agata were that (a) in Japan there is no such requirement to reveal prior art and (b) Agata's knowledge of U.S. patent practice was limited. He has also admitted, however, that for U.S. patent applications "he would rely on United States Attorneys for their knowledge of U.S. patent practice." Nevertheless he did not, at the time, contact Mr. Daniel for advice with respect to disclosure of this prior art (or even tell Daniel of the newly-found existence of this prior art). The patent issued in February 1976, and it was only thereafter that this prior art was disclosed to the PTO in connection with the reissue proceeding. Before the issuance of the patent, there was correspondence between Messrs. Daniel and Agata about voluntary amendments to the U.S. application's claims, and therefore Agata knew that such a voluntary amendment (correcting a claim that had been too broadly or inartfully drafted) was permissible in U.S. patent practice.

2. For me, Agata's conduct, in failing to take up the matter with the U.S. patent prosecutor, before the patent issued, amounted to gross negligence (at the very least). He was an experienced Japanese patent practitioner and he knew the newly-discovered prior art was material. He had been specifically asked by one of the inventors whether he should report the new disclosure to the PTO. He knew that his understanding of U. S. patent practice was limited. He knew he should rely on Mr. Daniel for knowledge of U.S. patent practice. He knew that voluntary amendments restricting over-broad claims (in the application) were allowable in U.S. patent practice, and he had been warned about the effect (during prosecution) of disclosure of compounds within the scope of the then claims. Nevertheless he did nothing, before the patent issued, to alert either Mr. Daniel or the PTO. The PTO considered all this to reveal gross negligence on Agata's part -- and I agree that it was so shown by clear and convincing evidence.

3. "Gross negligence" is one form of inequitable conduct specified in the July 1982 patent rule embodied in 37 C.F.R. § 1.56(d), and this court has accepted that foundation for showing the proper measure of intent, especially where, as here, there is a high level of materiality.<sup>1</sup> See *Specialty Composites v. Cabot Corp.*, 845 F.2d 981, slip op. at 25 (Fed. Cir. Apr. 27, 1988); *Akzo, N.V. v. E.I. DuPont de Nemours*, 810 F.2d 1148, 1153, 1 USPQ2d 1704, 1708 (Fed. Cir. 1987); *In re Jerabek*, 789 F.2d 886, 891, 229 USPQ 530, 533 (Fed. Cir. 1986); *J.P. Stevens & Co. v. Lex Tex Ltd.*, 747 F.2d 1553, 1560, 223 USPQ 1089, 1092 (Fed. Cir. 1984), *cert. denied*, 474 U.S. 822, 106 S. Ct. 73, 88 L. Ed. 2d 60 (1985); *Driscoll v. Cebalo*, 731 F.2d 878, 884-85, 221 USPQ 745, 751 (Fed. Cir. 1984); *American Hoist & Derrick Co. v. Sowa & Sons, Inc.*, 725 F.2d 1350, 1363, 220 USPQ 763, 773 (Fed. Cir.); *cert. denied*, 469 U.S. 821, 105 S. Ct. 95, 83 L. Ed. 2d 41 (1984).

4. The majority seems to suggest that in 1975-76 the requirements for finding inequitable conduct were stricter and did {847 F.2d 811} not encompass "gross negligence" (without more). However, the March 1977 version of 37 C.F.R. 1.56 expressly referred to "gross negligence" as a basis for a determination of inequitable conduct. In addition, our precedents reiterate that the later versions of Rule 56 generally embody the PTO policy as it earlier existed. See *In re Clark*, 522 F.2d 623, 627, 187 USPQ 209, 212-13 (CCPA 1975); *Driscoll v. Cebalo*, 731 F.2d at 884-85, 221 USPQ at 750-51, and cases cited; *Argus Chemical Corp. v. Fibre Glass-Evercoat Co.*, 759 F.2d 10, 13-14, 225 USPQ

1100, 1102 (Fed. Cir.), *cert. denied*, 474 U.S. 903, 106 S. Ct. 231, 88 L. Ed. 2d 230 (1985).<sup>2</sup> In particular, it was plain, in 1975-76 as today, that prior art of the high level of materiality of the prior art in this case should have been disclosed to the PTO.

5. Here, too, as in *Jerabek*, 789 F.2d at 892, 229 USPQ at 534, "balancing materiality and intent -- both properly found to have existed in high measure -- [I] must conclude that 'inequitable conduct' occurred through the gross negligence of [Mr. Agata] in failing to disclose to the PTO [or to U.S. counsel] a very significant reference."

### Footnotes

#### Footnotes for Dissent

1 In this case the Board said: "The materiality of the undisclosed prior art evidence in the present case was incontrovertible since lack of novelty is a bar to patentability in virtually every patent statute in the world." This factual finding must be upheld because it is not clearly erroneous. *In re Jerabek*, 789 F.2d 886, 889-90, 229 USPQ 530, 532-33 (Fed. Cir. 1986).

2 There has been some challenge to the PTO's conclusion that it was merely codifying prior practice (16 AIPLA Q.J. 13-15, 76-81, 134-38 (1988)) but we are bound -- until overruled by the court in banc -- by the holdings of our precedents. In any event, the 1977 regulation, almost contemporaneous with Agata's refusal to inform the PTO about the newly discovered prior art, explicitly included "gross negligence" as a significant component of inequitable conduct.

**IN RE ELMAR W. WEILER and RICHARD L. MANSELL**  
**790 F.2d 1576; 1986 U.S. App. LEXIS 20071; 229 U.S.P.Q. (BNA) 673**  
**Appeal No. 85-2085**  
**May 8, 1986**  
**UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT**  
**Markey, Chief Judge, Davis and Bissell, Circuit Judges.**

**Counsel**

William D. Stokes, of Alexandria, Virginia, argued for appellants.  
Richard E. Schafer, Associate Solicitor, U.S. Patent and Trademark Office, or Arlington, Virginia, argued for Appellee. With him on the brief were Joseph F. Nakamura, Solicitor and Fred E. McKelvey, Deputy Solicitor.

**Editorial Information: Prior History**

Appealed from: U.S. Patent and Trademark Office Board of Appeals.

**Opinion**

**Opinion by:** MARKEY

**{790 F.2d 1578} MARKEY, Chief Judge.**

Weiler and Mansell (Weiler) appeal from a decision of the United States Patent and Trademark Office Board of Appeals (board), App. No. 600-54 (Dec. 31, 1984), affirming the examiner's rejection of claims 13 and 19 in a reissue application filed under 35 U.S.C. § 251 (1982). We affirm.

*Background*

Weiler filed an application on May 8, 1980, containing 11 claims. During prosecution, the examiner held that the application contained "three independent and distinct inventions" and required restriction between Claims 1-7 (assay method), Claims 8 and 11 (an "organic compound" in class 260/343.42), and Claims 9 and 10 (a "protein compound" in class 260/121). Weiler elected to prosecute Claims 1-7. Those claims were allowed without amendment, and the application issued on December 15, 1981 as U.S. Patent No. 4,305,923 ('923 patent) for a "Method for Quantitative Analysis for Limonin".

*1. U.S. Patent No. 4,305,923*

The seven claims of the patent are independent claim 1 and dependent claims 2-7. Claim 1 reads:

1. A method for quantitative analysis of limonin which comprises reacting a known amount of limonin-specific antibodies, with a mixture of a known volume of sample containing an unknown amount of limonin and a known amount of a limonin-derivative labeled with an enzyme or with a radioactive isotope, determining the amount of labeled limonin-derivative which has reacted with said antibodies and calculating therefrom the unknown amount of limonin in said sample.

*2. The Reissue Application*

Weiler did not contest the examiner's requirement for restriction and did not file a divisional application, to assert the non-elected claims or any other claims.

On August 18, 1982, Weiler filed application Serial No. 408,497 to reissue the '923 patent. In his

Declaration, Weiler said the '923 patent was partly inoperative or invalid by reason of his having claimed less than he had a right to claim, and that that deficiency "exists because of errors which were made without deceptive intent on my part."

Weiler alleged "an extraordinary sequence of events which preceded and followed the inadvertent abandonment of original claims 8-11" which made him aware that the invention of the '923 patent was not adequately claimed. His Declaration set forth: (1) a June 23, 1981 letter from patent attorney Earl Tyner to Manzell (co-inventor of the '923 invention) confirming Manzell's authorization to file a divisional application on claims 8-11; (2) Tyner's July 2, 1981 letter to Bryan Burgess (Office of General Counsel, University of Florida), about filing a divisional application; and (3) a January 19, 1982 letter to Mansell from Arthur Yeager, a partner in Tyner's firm, stating that a divisional application had not been filed.

The Declaration further stated that "on being made aware of the failure to timely file the divisional application," *Mansell* consulted with patent attorney William D. Stokes (counsel of record here), who drafted a set of claims which, he said in the Declaration, "should have been made in the original application."

### 3. The Reissue Claims

The reissue application contained 20 claims. Claim 13 reads:

13. A method for developing citrus fruit strains low in limonin content, which method comprises identifying by the use of limonin-specific antibodies as a analytical reagent the limonin-low mutants in a breeding or cell culture program, and propagating said mutants.

Claim 19 reads:

19. A gamma globulin fraction comprising antibodies reactive with limonin, said antibodies being formed consequent {790 F.2d 1579} to injecting into an animal a limonin-protein conjugate.

Claims 1-12 and 20 were allowed by the examiner. Claim 2 was cancelled by Weiler. Claims 13-19 were rejected, and that rejection was appealed to the board.

### 4. The Board's Action

The board agreed with the examiner's view that "failure to timely file a divisional application including non-elected claims is a deliberate act and not error in the prosecution of the original patent" (citing *In re Orita*, 550 F.2d 1277(1), 193 U.S.P.Q. (BNA) 145(2) (CCPA 1977)). It sustained the rejection of claims 14-18 on that ground, i.e., because they are "directed to the same subject matter as the non-elected conjugate claims 9 and 10" of the original application. Claims 14-18 are not before us on appeal.

The board sustained the rejection of claims 13 and 19 on this specific ground:

Appeal claims 13 and 19 are directed to subject matter not claimed at all in the original application. As to them, the Examiner's reliance on the case of *In re Rowand et al.* is entirely correct and that decision is controlling. Here, as in that case, "there is nothing in the original patent evidencing that appellants intended to claim (this now claimed subject matter)" (526 F.2d 558(3), 560(4), 187 U.S.P.Q. (BNA) 487(5) at 489).

### Issue

Whether the board erred in sustaining the rejection of claims 13 and 19.

### OPINION



## Introduction

The starting place is the statute itself, 35 U.S.C. § 251:

Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Commissioner shall, on surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.

In enacting the statute, Congress provided a statutory basis for correction of "error". The statute is remedial in nature, based on fundamental principles of equity and fairness, and should be construed liberally. *In re Bennett*, 766 F.2d 524, 528, 226 U.S.P.Q. (BNA) 413, 416 (Fed. Cir. 1985) (in banc); *Ball Corp. v. United States*, 729 F.2d 1429, 1439 n.28, 221 U.S.P.Q. (BNA) 289, 296 n.28 (Fed. Cir. 1984); *In re Hay*, 534 F.2d 917(6), 919(7), 189 U.S.P.Q. (BNA) 790(8), 791 (CCPA 1976). Nonetheless, not every event or circumstance that might be labeled "error" is correctable by reissue.

### A. The Parties' Contentions

Weiler says the subject matter of neither claim 13 nor claim 19 constitutes "an independent and distinct invention" from that secured by the original patent, because both subject matters constituted part of the invention which was intended or sought to be secured by the original patent.

Pointing to the letters about a divisional application, on other claims, Weiler says his failure to claim the subject matter of claims 13 and 19 was not deliberate or purposeful, but was caused by the prosecuting attorney's error. He says that "but for the inventors' ignorance of patent drafting technique, their lack of knowledge of claiming technique, and their attorney's obvious lack of understanding of the invention, the subject matter of the part of the invention covered by claims 13 and 19 would have been included in the original patent."

The Solicitor's brief concedes that some minimal support for claims 13 and 19 appears in the patent's specification, but argues that "mere disclosure of this subject matter does not demonstrate an intent to {790 F.2d 1580} claim this subject matter." The Solicitor's brief also argues that "if a mistake was made [in not filing a divisional application], it is not the type of mistake which can be corrected by reissue," citing *In re Orita*, 550 F.2d 1277(9), 1281(10), 193 U.S.P.Q. (BNA) 145(11), 149 (CCPA 1977).<sup>1(12)</sup>

### B. The Board's Opinion

In its opinion, the board said, as above indicated, that the subject matter of claims 13 and 19 "was not *claimed at all* in the original application" (emphasis added), and that nothing in the patent evidenced an "intent to claim" that subject matter, citing *In re Rowand*, 526 F.2d 558(13), 560(14), 187 U.S.P.Q. (BNA) 487(15), 489 (CCPA 1975), as controlling authority.

This court reviews decisions, not the mere language of an opinion. When that language indicates an erroneous basis for the decision, the decision will be reversed, but that is not the case here. The board's language, while infelicitous, simply meant that Weiler's failure to have ever claimed, broadly or narrowly or otherwise, the subject matter of claims 13 and 19, and his failure to show an "intent to claim" that subject matter, indicated absence of the statutorily required "error."

The board's language reflected its well founded recognition that Weiler was seeking to claim subject matter entirely distinct from anything anywhere earlier claimed or attempted or intended to be claimed, and was not seeking to obtain a broadened or narrowed claim to subject matter claimed in the patent proffered for surrender. In dealing with that more common circumstance, one of our predecessor courts said "the whole purpose of the [reissue] statute, so far as claims are concerned, is to permit

limitations to be added to claims that are too broad or to be taken from claims that are too narrow." *In re Handel*, 50 C.C.P.A. 918(16), 312 F.2d 943(17), 948(18), 136 U.S.P.Q. (BNA) 460(19), 464 (CCPA 1963).

### C. Disclosure

Weiler argues, on the basis of loose language which, taken out of context, would appear to say that one looks only to see whether the subject matter of a reissue claim appears in the disclosure, and, if it does, a reissue applicant must be granted allowance of that claim. See D. Chisum, *Patents*, § 15.03[3] at 15-53 (1985); I. Kayton, *Kayton on Patents*, § 22-64 (1985). But the question of support in the disclosure is a § 112 inquiry. If there be no such support, the inquiry ends there, and reissue cannot be obtained. Thus, all consideration of § 251 must await that threshold § 112 determination. In the present case, as above indicated, there is some minimal support for the subject matter of claims 13 and 19.

When, unlike the present case, a reissue applicant seeks to obtain a broadened version of a claim in the patent, one may look to see whether the disclosure "reasonably conveys to one skilled in the art that the inventor had possession of the broad invention at the time the original application was filed." *In re Peters*, 723 F.2d 891, 894, 221 U.S.P.Q. (BNA) 952, 954 (Fed. Cir. 1984). That language speaks to the reason why the inventor failed to claim more broadly an invention he had claimed in the patent. It does not speak to the present case, in which Weiler did not claim the subject matter of the reissue claims "at all," to use the board's phrase. The language referring to the "disclosure" in *Peters*, and in other cases dealing with reissue, is directed ultimately to the question of error. One cannot assert error in failing to claim that which was not disclosed at all, or that which was not so disclosed as to indicate that the inventor was possessed of the invention as it is being claimed in the reissue application.

Weiler's argument that the subject matter of claims 13 and 19 does not constitute "an independent and distinct invention" {790 F.2d 1581} merely because that subject matter can be found somewhere in the overall disclosure of the '923 patent is meaningless. As above indicated, the subject matter must have been disclosed, § 112, or there is no basis for discussing whether the invention being claimed on reissue is independent or distinct. Moreover, § 251 authorizes reissue for "the" invention disclosed in the original patent, not for just "any" and "every" invention for which one may find some support in the disclosure of the original patent.

The subject matter of claims 13 and 19 are clearly independent of and distinct from each other, from that of elected claims 1-7, from that of non-elected organic compound claims 8 and 11, and from that of non-elected protein compound claims 9 and 10. Weiler would thus have had no right to insert and present claims 13 and 19 in the original application after the examiner's requirement for restriction.

Here too, the question redounds to one of error, for when an applicant makes some disclosure, as Weiler did, of as many as five distinct inventions, claims one, and ignores the rest, it is difficult to find error in the failure to claim those ignored on the sole basis that they were disclosed. To so hold would render meaningless the statutory requirement that an applicant point out and distinctly claim subject matter he regards as his invention. 35 U.S.C. § 112, 2d para. 2(20)

### D. "Intent to Claim"

Language appearing first in the opinion in *U.S. Industrial Chemicals, Inc. v. Carbide & Carbon Chemicals Corp.*, 315 U.S. 668, 676, 53 U.S.P.Q. (BNA) 6, 9-10, 86 L. Ed. 1105, 62 S. Ct. 839 (1942), has been picked up and has metamorphosed into a requirement that an applicant show his original "intent to claim" the subject matter of the reissue claim sought. The phrase "intent to claim" does not appear in the statute. It is but judicial shorthand, signifying a means of measuring whether the statutorily required error is present. Clearly, a showing that an applicant had an intent to claim matter he did not claim can go a long way to support a finding that error occurred; and, conversely, a showing that an applicant never had any such intent makes a finding of error extremely difficult if not impossible.

References to "intent to claim" in our cases, though occasionally including § 112 considerations, resolve ultimately into the question of error. "Determining what protection [an inventor] intended to secure by [an] original patent for the purposes of § 251 is an essentially factual inquiry confined to the *objective* intent manifested by the original patent." *In re Rowand*, 526 F.2d 558(21), 560(22), 187 U.S.P.Q. (BNA) 487(23), 489 (CCPA 1975) (emphasis in original). As explained in a later decision, *Rowand's* test of "intent to claim" was not one of "intent" per se, but looked to "objective indicia of intent." *In re Mead*, 581 F.2d 251(24), 256(25), 198 U.S.P.Q. (BNA) 412(26), 417 (CCPA 1978). The court in *Mead* analogized that evidence of "intent" to the written description requirement of § 112, first paragraph, i.e., "a written description of the invention, and of the manner and process of making and using it." See also *In re Peters*, 723 F.2d 891, 894, 221 U.S.P.Q. (BNA) 952, 954 (Fed. Cir. 1984). It is true that absence of compliance with § 112 will foreclose a finding of "intent" and preclude grant of the reissue, but, as indicated above, that absence dooms the application in any event. The converse is not true. Compliance with § 112 does not alone establish "intent to claim" and does {790 F.2d 1582} not alone establish error in a failure to claim.<sup>3(27)</sup>

This court has recently moved the "intent to claim" approach toward closer conformity with the statute, describing it as merely one factor "that sheds light upon whether the claims of the reissue application are directed to the same invention as the original patent *and the reissue would correct an inadvertent error in the original patent.*" *In re Hounsfeld*, 699 F.2d 1320, 1323, 216 U.S.P.Q. (BNA) 1045, 1048 (Fed. Cir. 1982) (emphasis added).

#### E. "Error"

Thus, we arrive at the central question in this appeal, which is not whether there is disclosure, but whether Weiler has established "error" which can be remedied by reissue. The reissue statute was not enacted as a panacea for all patent prosecution problems, nor as a grant to the patentee of a second opportunity to prosecute *de novo* his original application.

The language of *U.S. Industrial Chemicals, Inc. v. Carbide & Carbon Chemicals Corp.*, 315 U.S. at 676, 53 U.S.P.Q. (BNA) at 9-10, is relevant here:

It is not enough that an invention *might have been claimed* in the original patent because it was suggested or indicated in the specification. It must appear from the face of the instrument that what is covered by the reissue was intended to have been *covered and secured* by the original. [Emphasis added.]

Weiler and the Solicitor argue as though the "error" to be corrected by reissue were a subjective error. It is not. We do not here deal with "deceptive intention."

Though the term "error" is to be interpreted liberally, *In re Wesseler*, 367 F.2d 838(28), 84, 152 U.S.P.Q. (BNA) at 339, 348 (CCPA 1966), Congress did not intend to alter the test of "inadvertence, accident, or mistake" established in relation to the pre-1952 statutes. *In re Wadlinger*, 496 F.2d 1200(29), 1207(30), 181 U.S.P.Q. (BNA) 826(31), 831 (CCPA 1974). See *In re Mead*, 581 F.2d 251(32), 257(33), 198 U.S.P.Q. (BNA) 412(34), 418 (CCPA 1978) ("conscious choice" not to file continuing application not "error"); *In re Clark*, 522 F.2d 623(35), 626(36), 187 U.S.P.Q. (BNA) 209(37), 212 (CCPA 1975) (dereliction in duty of candor not "error"); *In re Byers*, 43 C.C.P.A. 803(38), 230 F.2d 451(39), 454(40), 109 U.S.P.Q. (BNA) 53(41) (CCPA 1956) (deliberate amendment of claim not "error"). See also *In re Petrow*, 56 C.C.P.A. 710(42), 402 F.2d 485(43), 159 U.S.P.Q. (BNA) 449(44) (CCPA 1968) (cancellation of claim in original application was "error"); *In re Willingham*, 48 C.C.P.A. 727(45), 282 F.2d 353(46), 127 U.S.P.Q. (BNA) 211(47) (CCPA 1960) (cancellation of claim was "error").

As above indicated, the discussions in the briefs concerning the failure to assert the non-elected claims in a divisional application are irrelevant. Those claims are not on appeal and were drawn to subject matter distinct from that of claims 13 and 19. Though Weiler *might have* filed a divisional

application containing claims 13 and 19, there is nothing of record remotely indicating that Weiler or his counsel or anyone else ever thought of doing so, or ever intended doing so, or failed to do so only through error.

Significantly, Weiler accepted issuance of the '923 patent with its claims to a single elected invention. By acquiescing in the examiner's restriction requirement, and failing to file divisional applications on the subject matter of non-elected claims, Weiler foreclosed (because that was not error) his right to claim that subject matter. If it were not error to forego divisional applications on subject matter to which claims had been made in the original application, it cannot on the present record have been error to forego divisional applications on subject matter to which claims had never been made. Nor has Weiler made any {790 F.2d 1583} showing on which error could be found as the cause of his failure to claim the subject matter of claims 13 and 19. 4(48)

The board's notation that the subject matter of claims 13 and 19 was "not claimed at all" in the original application, and its finding that nothing in the original patent evidences Weiler's "intent to claim" that subject matter, reflect non-statutory language used by courts and others to support and convey the concept that an inventor's failure to claim particular subject matter was not the result of the "error" required by § 251. Having made that notation and finding, the board should have stated the resulting basis (no error) for its decision. That it did not do so does not require reversal in this case, in which the record clearly supports the notation and finding, Weiler has not shown that either was clearly erroneous, and Weiler has shown nothing in the record that would have required the board to determine that his failure to claim the subject matter of claims 13 and 19 was the result of error.

AFFIRMED.

### Footnotes

#### Footnotes for Opinion

1 Because the rejection of claims 14-18 is not appealed, the parties' discussion of the reasons why Weiler failed to file divisional applications on the subject matter of those claims, Weiler's evidence consisting of letters about divisional applications on non-elected claims 8-11, and the Solicitor's reliance on *Orita*, are irrelevant.

2 I. Kayton, *Kayton on Patents*, § 22-64 (1985) ("the predecessor to our present statute required that a reissue application be for 'the *same* invention' rather than for 'the *invention disclosed*' in the original patent . . . Now it is only necessary to compare the reissue *claims* with the disclosure in the parent patent for the purpose of determining whether they are supported as required by 35 USC § 112" (emphasis in original)). As indicated in the text, compliance with § 112 is a threshold consideration, but such compliance does not establish error in a failure to claim every invention disclosed.

3 One commentator has recently stated: "The intent test and the *U.S. Industrial Chemicals* statement [see text *infra*] are perhaps best understood as expressions of the 'description of the invention' requirement, which the Court of Customs and Patent Appeals recognizes as distinct from the enablement requirement." D. Chisum, *Patents*, § 15.03[3] at 15-53 (1985). The commentator could not have meant that compliance with § 112's enablement requirement is sufficient in itself to warrant an automatic finding of "intent" and a resulting reissue, in disregard of § 251's requirement to show *error*.

4 Weiler's reliance on allegations of the inventors' ignorance of drafting and claiming technique and counsel's ignorance of the invention is unavailing. Those allegations could be frequently made, and, if accepted as establishing error, would require the grant of reissues on anything and everything mentioned in a disclosure. Weiler supplies no facts indicating how the ignorance relied on caused any error as the basis of his failure to claim the subject matter of claims 13 and 19. As indicated in the text § 251 does not authorize a patentee to re-present his application. Insight resulting from hindsight on the part of new counsel does not, in every case, establish error.